

- VOLUME F -

IN THE UNITED STATES DISTRICT COURT  
IN AND FOR THE DISTRICT OF DELAWARE

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ARTHROCARE CORPORATION, : CIVIL ACTION  
Plaintiff :  
vs. :  
SMITH & NEPHEW, INC., :  
Defendant : NO. 01-504 (SLR)

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Wilmington, Delaware  
Wednesday, May 7, 2003  
9:32 o'clock, a.m.

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BEFORE: HONORABLE SUE L. ROBINSON, Chief Judge, and a jury

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APPEARANCES:

MORRIS, NICHOLS, ARSHT & TUNNELL  
BY: JACK B. BLUMENFELD, ESQ. and  
KAREN JACOBS LOUDEN, ESQ.

-and-

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PROCEEDINGS

(Proceedings commenced in the courtroom,  
beginning at 9:32 a.m., and the following occurred without  
the presence of the jury.)

THE COURT: All right. I understand we had an  
issue. We don't have that issue any more. But do we have  
any others before we bring the jury in?

MS. BOYD: No, your Honor.

THE COURT: All right. Terrific.

MR. BLUMENFELD: Your Honor, we don't have any  
issues, but Dr. Goldberg is back today. I think we've  
agreed on an order. He'll be resuming the stand today.

Smith & Nephew has been kind enough to agree  
that he can be in the courtroom while other witnesses are  
testifying today, which is -- I just wanted to alert your  
Honor to that.

THE COURT: Okay. Great. Thank you very much.  
(Pause.)  
(At this point the jury entered the courtroom  
and took their seats in the box.)

THE COURT: Good morning, ladies and gentlemen.  
We should proceed. I'm not quite sure where we are. Oh,

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APPEARANCES (Continued):

WEIL, GOTSHAL & MANGES  
BY: JARED BOBROW, ESQ.  
TIMOTHY DeMAST, ESQ. and  
PERRY R. CLARK, ESQ.  
(Redwood Shores, California)

Counsel for Plaintiff

FISH & RICHARDSON P.C.  
BY: WILLIAM J. MARSDEN, JR., ESQ.,  
KEITH A. WALTER, ESQ. and  
EUGENE B. JOSWICK, ESQ.

-and-

FISH & RICHARDSON  
BY: MARK J. HEBERT, ESQ.,  
(Boston, Massachusetts)

-and-

FISH & RICHARDSON  
BY: KURTIS D. MacFERRIN, ESQ. and  
KAREN I. BOYD, ESQ.  
(Redwood City, California)

Counsel for Defendant

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we have a witness on the stand.

MR. MacFERRIN: That's correct.

THE COURT: If she could come forward please,  
I'd appreciate it.

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DEFENDANT'S TESTIMONY  
CONTINUED...

... KATE KNUDSEN, having been  
previously duly sworn as a witness,  
was examined and testified as  
follows ...

DIRECT EXAMINATION  
CONTINUED

BY MR. MacFERRIN:

Q. Good morning, Mrs. Knudsen.

A. Good morning.

Q. You realize you're still under oath?

A. Yes.

Q. I would like to pick up where we left off yesterday  
and ask you about one other feature of the Saphyre  
design that you worked on. And that feature is a fluid  
supply. Does the Saphyre probe do the fluid supply?

A. No, it does not provide fluid.

Q. Does the Saphyre electrosurgical system include a

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1 were used in angioplasty means have the purpose and  
 2 function of limiting current to each electrode.  
 3 Similarly, that need was seen in arthroscopy applications,  
 4 so we just used the idea because the end need was similar.  
 5 "Question: And what is that end need?  
 6 "Answer: The end need in angioplasty  
 7 application is to work on the tissue inside the artery.  
 8 The end need in arthroscopic application is work in the  
 9 tissue of the joint. So we are working on tissues. The  
 10 end need is similar, so extending the ballasting idea  
 11 from angioplasty to arthroscopy seemed like the extension,  
 12 the natural extension."  
 13 MR. JOHNSTON: That is all we have. Thank  
 14 you very much, ladies and gentlemen.  
 15 THE COURT: All right. Ladies and gentlemen,  
 16 let's take a 15-minute afternoon break and then we'll  
 17 conclude with whatever testimony that counsel have.  
 18 (At this point the jury was excused for a short  
 19 recess.)  
 20 THE COURT: All right. 15 minutes.  
 21 (Short recess taken.)  
 22 ---  
 23  
 24  
 25

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1  
 2 (Court resumed after the recess.)  
 3  
 4 THE COURT: Can we bring our jury in?  
 5 MR. MARSDEN: I'm not sure what your preference  
 6 is in admitting the exhibits outside the jury or outside  
 7 the presence of the jury or in front of the jury. I moved  
 8 some exhibits that Mr. Blumenfeld didn't have an  
 9 opportunity to review. He has reviewed them and does  
 10 not have an objection.  
 11 THE COURT: Let's bring the jury in because if  
 12 we're going to finish early, this is a long day for them  
 13 and we can do that at the end of the day.  
 14 MR. MARSDEN: We can do that outside the  
 15 presence of the jury?  
 16 THE COURT: Yes. I don't think your reading  
 17 off numbers is going to make a big impression on them.  
 18 (At this point the jury entered the courtroom  
 19 and took their seats in the box.)  
 20 THE COURT: Mr. Marsden?  
 21 MR. MARSDEN: Thank you, your Honor.  
 22 Ladies and gentlemen of the jury, we next call  
 23 Dr. Kenneth B. Taylor.  
 24 ---  
 25

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1 DEFENDANT'S TESTIMONY CONTINUED  
 2 ... KENNETH BOYLE TAYLOR, having  
 3 been duly sworn as a witness, was examined  
 4 and testified as follows ...  
 5 MR. MARSDEN: Ladies and gentlemen of the jury,  
 6 Dr. Taylor is not a medical doctor, but he has a Ph.D. in  
 7 biomedical engineering. We are calling him as an expert  
 8 in the design and use of electrosurgical systems. He will  
 9 be offering opinions on the issues of infringement and  
 10 invalidity and he'll be explaining the basis for his  
 11 opinions.  
 12 DIRECT EXAMINATION  
 13 BY MR. MARSDEN:  
 14 Q. Good afternoon, Dr. Taylor.  
 15 A. Good afternoon.  
 16 Q. Could you introduce yourself to the jury, please?  
 17 A. Sure. Hi. High name is Ken Taylor. Good to meet  
 18 you all.  
 19 Q. Dr. Taylor, where do you live?  
 20 A. I live in Broomfield, Colorado.  
 21 Q. Are you married?  
 22 A. Yes, I am.  
 23 Q. Do you have any children?  
 24 A. I have one son.  
 25 Q. How long have you been married?

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1 A. I've been married 30 years.  
 2 Q. How old is your son?  
 3 A. He's 23.  
 4 Q. Do you have any experience or training in  
 5 electrosurgery?  
 6 A. One might say so, yes.  
 7 Q. Have you prepared a resume that outlines your  
 8 educational and work experience?  
 9 A. Yes, I have.  
 10 Q. Could I ask you to turn to DTX-418 in the binder  
 11 that you have in front of you?  
 12 A. Yes.  
 13 Q. Does that show your experience or training in  
 14 electrosurgery?  
 15 A. Yes, it does.  
 16 Q. Can you describe your educational background for the  
 17 jury?  
 18 A. Sure. I have a B.S. in electrical engineering from  
 19 the University of Connecticut. I have a Master's degree  
 20 in biomedical engineering as well as a Ph.D. in biomedical  
 21 engineering, also from the University of Connecticut.  
 22 And I have an MBA from Rennselear Polytechnic Institute.  
 23 Q. Did you work while you were pursuing your graduate  
 24 degrees?  
 25 A. Yes. Once I got my B.S. degree, I worked

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1 continuously.  
 2 Q. Where did you work while you were getting your  
 3 graduate degrees?  
 4 A. I started working after my Bachelor's degree at St.  
 5 Francis Hospital in Connecticut. I was the Manager. At  
 6 some point I was the Manager of the Research Laboratory  
 7 as well as a perfusionist. A perfusionist is a person  
 8 that runs a heart/lung machine during open-heart surgery.  
 9 Q. Did you have any exposure to electrosurgical systems  
 10 during that job at St. Francis?  
 11 A. Yes, I did. As Manager of the Research Laboratory  
 12 there, we did a number of different types of animal  
 13 surgery for clinical practice as well as for testing  
 14 various devices and we had an old, what's known as a  
 15 Bovie unit, that we used during the course of those  
 16 surgeries for cutting and coagulation.  
 17 Q. Did you work at any other companies or locations  
 18 while you were pursuing your graduate degrees?  
 19 A. Yes. When I left the hospital, I went to work for  
 20 United Technologies, which was a company that's in East  
 21 Hartford, Connecticut.  
 22 Q. Did your work involve any medical research?  
 23 A. Actually, it did. A lot of you know United  
 24 Technologies is a company that makes things like  
 25 elevators, air-conditioners and such. They also have

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1 a research center that on occasion does some  
 2 philanthropic projects and I developed an automated  
 3 gait analysis laboratory for Children's Hospital in  
 4 Hartford during the course of my tenure at that job.  
 5 And as a matter of fact, during the course of  
 6 this trial, there's been a conference, automated gait  
 7 analysis, which is being partially sponsored by A. I.  
 8 DuPont Hospital, which is the hospital that we consulted  
 9 with after we had built the Gait Lab for the Children's  
 10 Hospital.  
 11 Q. And when you say gait, is that gate like a fence or  
 12 is that a different kind of gate?  
 13 A. Walking analysis. Gait Analysis Lab is designed  
 14 to diagnose walking disorders, particularly in children,  
 15 children with cerebral palsy and such.  
 16 Q. Have you done any teaching in the field of  
 17 electrosurgery?  
 18 A. Yes, I have. I've taught courses in introduction  
 19 to biomedical engineering at the University of Connecticut  
 20 as well as Trinity College, Hartford Graduate Center.  
 21 Those courses involve teaching by low electric surgery.  
 22 Q. Do you have any work experience in the field of  
 23 electrosurgery?  
 24 A. Yes, I have. I've got a number of different job  
 25 opportunities where I worked with electrosurgery.

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1 First off, when I worked at Pfizer, I did  
 2 work at Pfizer for about three years, running a group  
 3 that was involved with technology assessment as well as  
 4 a group that did technical resource types of activities  
 5 and sponsored research project that involved  
 6 electrosurgery.  
 7 I was also a Vice President of R&D for  
 8 Valleylab and developed a number of electrosurgery systems,  
 9 generators, including the generator that is on the table  
 10 there, Force FX and also other devices related to that.  
 11 And my most recent position, we worked on -- and developed  
 12 a device that incorporates an electrosurgery generator  
 13 within it.  
 14 Q. Thank you.  
 15 Can you describe for the jury what Valleylab  
 16 is?  
 17 A. Valley -- Valleylab is a company that basically has  
 18 two product lines. One of them is electrosurgery systems  
 19 and the other product line is ultrasurgical aspirators.  
 20 It focuses on tissue ablation, using those types of systems.  
 21 Q. And what was your position at Valleylab?  
 22 A. I was the Vice President of Research and Development  
 23 there.  
 24 Q. How long did you hold that position?  
 25 A. Five years.

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1 Q. During your work at Valleylab, did you have -- use or  
 2 evaluate any electrosurgical devices?  
 3 A. Yes. A fair number of them. Our own products as  
 4 well as competitive products.  
 5 Q. Dr. Taylor, are you a physician?  
 6 A. No, I am not.  
 7 Q. Are you a surgeon?  
 8 A. No, I'm not.  
 9 Q. In the course of your work experience, have you had an  
 10 opportunity to observe electrosurgery?  
 11 A. Probably observed the use of electrosurgery in well  
 12 over 3,000 operations.  
 13 Q. Do you have any understanding as to whether Dr.  
 14 Goldberg is a surgeon?  
 15 A. My understanding is he's a radiologist; he's not a  
 16 surgeon.  
 17 Q. Where did you work next after Valleylab?  
 18 A. I worked for a company called Medlogix Global  
 19 Corporation. It's a company that -- a startup company  
 20 that focused on tissue adhesives.  
 21 Q. Okay. And did you -- what was your next position  
 22 where you worked with electrosurgical devices?  
 23 A. I worked most recently worked at a company called  
 24 Colorado Medtech. And Colorado Medtech is a company  
 25 that does outsource product developing, manufacturing.

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1 We basically develop products for other companies and  
 2 manufacture products for other companies and during the  
 3 course of my tenure there, we have worked on at least  
 4 one project that incorporates electrosurgery generator.  
 5 Q. Are you still employed by Colorado Medtech?  
 6 A. No. We sold my division of the company at the end  
 7 of January.  
 8 Q. By whom are you currently employed?  
 9 A. I'm employed by myself. I have a company called  
 10 Taylor Medical Technology Consulting.  
 11 Q. What is the business of Taylor Medical Technology and  
 12 Consulting?  
 13 A. My business is to do medical device technology  
 14 planning and business development for small medical device  
 15 companies.  
 16 Q. Do you have any patents or publications in the field  
 17 of electrosurgery?  
 18 A. Yes, I have two patents. In electrosurgery. I have  
 19 a total of five patents.  
 20 Q. And have you published in the field of electrosurgery?  
 21 A. Yes. I have a number of papers in that area.  
 22 Q. Are those publications listed in your resume?  
 23 A. Yes, they are.  
 24 MR. MARSDEN: Your Honor, I move the admission  
 25 of DTX-418, Dr. Taylor's resume.

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1 MR. BOBROW: No objection, your Honor.  
 2 THE COURT: Thank you.  
 3 \*\*\* (Defendant's Exhibit No. 418 was received into  
 4 evidence.)  
 5 BY MR. MARSDEN:  
 6 Q. When did you first become involved in this case, Dr.  
 7 Taylor?  
 8 A. It was about a year ago.  
 9 Q. Do you recall how you were contacted?  
 10 A. Yes. Kurtis MacFerrin called me up and asked to meet  
 11 with me.  
 12 Q. What were you asked to do?  
 13 A. He asked me to review the patents in suit, '536,  
 14 the '882 and the '592 patents, to basically analyze them,  
 15 to take a look at the prior art, to take a look at the  
 16 devices that are in question here and to make a  
 17 determination as to whether or not the devices infringe --  
 18 infringed, whether or not the patents were valid.  
 19 Q. And what did you do to determine whether or not  
 20 the patents are infringed and whether the patents are  
 21 valid.  
 22 A. Well, first, obviously, I read the patents several  
 23 times. I read their file wrapper, so I guess what we  
 24 would call file histories?  
 25 I looked at prior art publications and patents.

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1 I studied the devices. When I say I studied the devices,  
 2 basically I received products from Smith & Nephew. That  
 3 included the instruction sleeves. I -- those products  
 4 included the generator.  
 5 I also looked at the design history files for  
 6 the products. At least parts of them, not the whole file.  
 7 And I reviewed a whole host of depositions from a variety  
 8 of people, both at Smith & Nephew and ArthroCare,  
 9 including the deposition for -- for Mr. Eggers, the  
 10 deposition for Dr. Thapliyal, Mrs. Knudsen's deposition,  
 11 Mrs. Drucker's deposition, and a long list of others.  
 12 Q. Did you review --  
 13 A. I also went to Smith & Nephew's bioscope lab and  
 14 had an opportunity to use the Control RF and Saphyre and  
 15 the ElectroBlade on a cadaver shoulder. That was fun.  
 16 I enjoyed that.  
 17 Q. Did you also review Knudsen's deposition testimony?  
 18 A. Yes, I did.  
 19 Q. Are you being compensated for your time in this  
 20 case?  
 21 A. Yes, I am.  
 22 Q. At what rate are you being compensated?  
 23 A. I am being compensated at my standard, what -- time,  
 24 my standard consulting rate of \$150 an hour.  
 25 Q. Have you ever served as an expert in litigation

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1 before?  
 2 A. No, I haven't.  
 3 Q. As a result of the study that you performed, have  
 4 you reached any opinions regarding infringement and  
 5 validity?  
 6 A. Yes, I have.  
 7 Q. What are those opinions?  
 8 A. My opinion is that the products, the accused  
 9 products, the Saphyre, the ElectroBlade and the Control  
 10 RF, do not infringe the ArthroCare patents. And also  
 11 that the ArthroCare patents are invalid.  
 12 Q. Okay. Let's turn first to the issue of  
 13 noninfringement and we'll take patents one at a time, if  
 14 that makes sense to you.  
 15 A. That's fine.  
 16 Q. Okay. Let's start with the '536 patent, Dr. Taylor.  
 17 Can you describe for the jury what the '536  
 18 patent is about?  
 19 A. The '536 patent is what -- what I call and what we  
 20 call an utility patent. It describes a product or an  
 21 apparatus that is an electrosurgical system that contains  
 22 or has an electrosurgical probe which has an electrically  
 23 conductive fluid supply.  
 24 Those are the essential parts of it.  
 25 Q. How do you know that the system claimed in the '536

1 patent includes an electrosurgical -- I'm sorry -- an  
 2 electrically conductive fluid supply?  
 3 A. Well, if you go look at the actual patent itself,  
 4 it pretty much states that in the claims. If you look at  
 5 the figures, at least some of the figures in the patent,  
 6 it pretty much states that.  
 7 And there are some other aspects that includes.  
 8 Q. Did you consider the Court's claim construction on  
 9 that issue?  
 10 A. Oh, yes, I certainly did.  
 11 Q. Have you prepared any graphics to help explain to  
 12 the jury how you reached your conclusions in connection  
 13 with the '536 patent?  
 14 A. Yes, I have.  
 15 Q. All right.  
 16 MR. MARSDEN: Gary, could we have DDTX-406,  
 17 please?  
 18 BY MR. MARSDEN:  
 19 Q. I think you answered earlier that one of the ways  
 20 that you determined that an electrically conducting fluid  
 21 supply was required by the claims of the '536 patent was  
 22 by looking at the claims themselves?  
 23 A. Yes.  
 24 Q. Could you use this graphic to explain to the jury  
 25 how you reached this conclusion?

1 A. Sure. If you look at the top there, you've got  
 2 an electrosurgical system, which is -- which has been  
 3 highlighted, comprising, among other things, down the  
 4 bottom here, an electrically conducting fluid supply, so  
 5 that's in the claim. And then if you go over to Figure 1,  
 6 you see that there's an IV bag (indicating). You actually  
 7 have the text of the claim, it's more evident, but there's  
 8 an IV bag that goes by a tube into the actual device.  
 9 Q. And there's this word comprising that you've  
 10 highlighted on this slide. Does that have any special  
 11 meaning in the field of patent law?  
 12 A. Yes, it does, and actually you guys explained that  
 13 to me very well. Basically, it says that the system has  
 14 to include these elements and it just lists the elements  
 15 here.  
 16 Q. Okay.  
 17 A. It has to contain those elements.  
 18 Q. It's like including?  
 19 A. Yes. It has to include those elements.  
 20 Q. Do you have other slides that you prepared?  
 21 A. Yes.  
 22 The next, Gary, I won't call you Chris --  
 23 Gary, the next one, please.  
 24 Here's a series of four figures which show the  
 25 electrically conductive fluid supply coming in from a

1 number of different perspectives.  
 2 And figure -- in Figure 2A, the fluid is being  
 3 supplied through the center of the device and that's shown  
 4 there.  
 5 ---  
 6 A. (Continuing) Figure 6, the fluid supply is coming in  
 7 from the bottom and flowing in that direction.  
 8 Figure 7 is a different embodiment. You have  
 9 the return electrode and fluid supply are one part of the  
 10 probe, a separate element of the probe and the active  
 11 electrode is over here. The fluid supply is being  
 12 supplied through the return electrode in this secondary  
 13 shaft, if you will.

14 ---  
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1  
 2 A. (Continuing) And in the case of Figure 8, the fluid  
 3 supply is on the outside of the structure there.  
 4 So we've got essentially four different ways to  
 5 get it there. One is through the center of the probe, one  
 6 is through the bottom of the probe, if you will, one is  
 7 through a separate return electrode and fluid supply and  
 8 the other is on the outside of the shaft.  
 9 Q. If I could just direct your attention to Figure 7  
 10 again, why is this not a separate fluid supply -- I'm  
 11 sorry. Why is this not a separate fluid supply system  
 12 apart from the electrode -- electrosurgical system?  
 13 A. Well, because if you go back to the original claim,  
 14 the claim requires that you have a return electrode as  
 15 well as an electrically conductive fluid supply. In this  
 16 particular case, the return electrode is actually separate  
 17 from the active electrode shaft. But it does contain the  
 18 electrically conducting fluid supply.  
 19 Q. And where exactly is the return electrode in the  
 20 embodiment or the example given in Figure 7?  
 21 A. Figure 7, the return electrode is right there.  
 22 Q. Do you consider that to be part of the  
 23 electrosurgical system?  
 24 A. Yes, I do.  
 25 Q. Were you just in the courtroom when the testimony

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1 of Dr. Thapliyal was read?  
 2 A. Yes, I was.  
 3 Q. Did you hear Dr. Thapliyal describe the differences  
 4 between the '909 patent and the '536 patent that we've  
 5 been discussing?  
 6 A. Yes, I did.  
 7 Q. Do you recall what the difference was that he called  
 8 out in his testimony?  
 9 A. I believe the difference was that the '506 patent  
 10 includes an electrically conductive fluid supply.  
 11 Q. You said you considered the Court's claim  
 12 construction in evaluating infringement of the '536  
 13 patent; is that correct?  
 14 A. That's correct.  
 15 MR. MARSDEN: Could we put up the Court's  
 16 claim construction, PTX-365 and go to Page 14, please?  
 17 BY MR. MARSDEN:  
 18 Q. Dr. Taylor, did you use this claim construction  
 19 in reaching your conclusions of the no infringement of  
 20 the --  
 21 A. Yes.  
 22 Q. Would this definition help you in reaching that?  
 23 A. Yes.  
 24 Q. How did it assist you?  
 25 A. Well, as shown there, the term system shall be

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1 construed to mean an assemblage or combination of things  
 2 or parts forming an unitary whole, so therefore it means  
 3 that all the things that are in that system or that  
 4 Claim 1 have to be present in the electrosurgical system  
 5 in order for it to be consistent with the claim.  
 6 Q. Okay. Now, there are particular claims of the ' 536  
 7 patent that have been asserted against the products that  
 8 Smith & Nephew makes; correct?  
 9 A. Correct.  
 10 Q. Have you formed an opinion as to whether the Smith &  
 11 Nephew Saphyre infringes Claims 46, 47 and 56 of the 536  
 12 patent?  
 13 A. Yes, I have.  
 14 Q. What is your opinion?  
 15 A. My opinion is they do not -- those products do not  
 16 infringe those claims.  
 17 Q. Why not?  
 18 A. Well, I did an analysis of the claims, those three  
 19 claims, and in order to do an analysis of those claims,  
 20 you have to go back to the independent claim those  
 21 claims reference, which is Claim 45.  
 22 Q. Did you analyze the products to determine whether  
 23 they had a -- a -- an electrically conductive fluid  
 24 supply?  
 25 A. Yes, I did. And they do not.

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1 Q. Can you tell the jury how you do an infringement  
 2 analysis when evaluating a patent claim?  
 3 A. Essentially, what you do is you look at all the  
 4 elements of the claims to determine whether or not the  
 5 product that you are evaluating contains all the elements  
 6 of those claims. And that's what I did.  
 7 Q. And what happens if one of the elements is missing?  
 8 A. If one of the elements is missing, this is like  
 9 baseball. We have to have a batting average of a thousand  
 10 in order to win. If one of the elements is missing, then  
 11 the product does not infringe.  
 12 Q. Okay. Do you have a slide to help describe for the  
 13 jury the particular claims that are asserted in the '536  
 14 patent?  
 15 A. Yes, I do.  
 16 MR. MARSDEN: Gary, could we call up DDTX-409,  
 17 please?  
 18 BY MR. MARSDEN:  
 19 Q. And, Dr. Taylor, which claims are asserted against  
 20 the Smith & Nephew products?  
 21 A. Claims 46, 47 and 56, as shown on the right-hand  
 22 column there.  
 23 Q. Are those claims independent claims or dependent  
 24 claims?  
 25 A. Those are dependent claims.

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1 Q. Can you describe for the jury what the difference is  
 2 between an independent claim and a dependent claim?  
 3 A. Sure. A dependent claim depends upon another claim  
 4 in order for it to be active. If you take a look at  
 5 Claim 46, for example, it says an electrosurgical system  
 6 as in Claim 45. If you look at Claim 47, it says an  
 7 electrosurgical system as in Claim 46. Therefore, it  
 8 depends on Claim 46.  
 9 If you look at 56, it says the electrosurgical  
 10 system of Claim 45. Therefore, it depends on Claim 45.  
 11 Q. What does that mean in practical terms in terms of  
 12 how you evaluate whether there's infringement?  
 13 A. What it means is, practically speaking, you have to  
 14 take a look first at Claim 45 to see whether or not the  
 15 product contains all the elements and infringes Claim 45.  
 16 If it doesn't infringe Claim 45, then it can't infringe,  
 17 in this case, 46 or 56, and also 47 due to the fact that  
 18 47 is dependent on 46.  
 19 Q. So that means that you had to look at Claim 45 even  
 20 though Claim 45 is not asserted against these products;  
 21 correct?  
 22 A. That's correct.  
 23 Q. Are all of the elements of independent Claim 45  
 24 found in the accused Smith & Nephew products?  
 25 A. No, they're not. They're missing -- okay. The

1 product is missing, electrically conducting fluid supply.  
 2 Q. Have you prepared any slides to assist you in  
 3 illustrating that to the jury?  
 4 A. Yes, I have.  
 5 MR. MARSDEN: Gary, could we pull up DDTX-408,  
 6 please?  
 7 BY MR. MARSDEN:  
 8 Q. Can you use this slide, Dr. Taylor, to explain your  
 9 opinion?  
 10 A. Yes.  
 11 As you see on the right-hand side, there's the  
 12 claim, Claim 45, the independent Claim 45. Then on the  
 13 left-hand side, what I'm showing is what the claim system  
 14 must include. And as I mentioned previously, the claim,  
 15 the products, the Saphyre, the Control RF and the  
 16 ElectroBlade, do not have an electrically conducting  
 17 fluid supply. And since all of the '536 claims require or  
 18 are dependent upon, if you will, Claim 45, which requires  
 19 an electrically conducting fluid supply, therefore none of  
 20 those products infringe.  
 21 Q. And did you look at the Smith & Nephew products and  
 22 how they are used in determining whether or not there was  
 23 an electrically conducting fluid supply as claimed in the  
 24 '536 patent?  
 25 A. Yes, I did.

1 Q. Have you prepared another slide to demonstrate that?  
 2 A. Yes.  
 3 MR. MARSDEN: Could we call up DDTX-410, please,  
 4 Gary?  
 5 BY MR. MARSDEN:  
 6 Q. Can you use this slide to describe to the jury your  
 7 opinion that the '536 patent does not infringe?  
 8 A. Yes. This overhead shows the various components,  
 9 actually that Mr. Sparks was demonstrating yesterday, but  
 10 what you have here is on the left-hand side, more or less,  
 11 you've got the fluid supply, electrically conductive  
 12 fluid supply, which is an IV bag going through the fluid  
 13 system, eventually ending up in a cannula that goes into  
 14 the patient.  
 15 You've got a light source that powers the --  
 16 the arthroscope and eventually the image of the  
 17 arthroscope is shown on a TV monitor.  
 18 And then you have the RF generator and  
 19 whichever Smith & Nephew probe we're talking about, which  
 20 goes into a separate port. Therefore, when you take a  
 21 look at this overall arthroscopy sweet system, the  
 22 electrically conducting fluid supply is separate from the  
 23 RF probes.  
 24 Q. Where is the electrosurgery system in this figure?  
 25 A. The electrosurgery system is the RF generator and

1 the probe (indicating).  
 2 Q. So essentially the right-hand side?  
 3 A. The right-hand side. That's correct.  
 4 Q. And where is the electrically conducting fluid  
 5 supply system?  
 6 A. The electrically conducting fluid supply is this IV  
 7 bag, fluid management system, the box there, and the tube  
 8 that's going into the cannula.  
 9 Q. Now, I think you may have used the expression an  
 10 arthroscopy suite or system in describing what you've  
 11 drawn here in this figure.  
 12 Explain how, is the '536 patent directed  
 13 towards an arthroscopy system?  
 14 A. No.  
 15 Q. What is the claim term that the Judge has construed?  
 16 I'm sorry. What is the term that you were considering in  
 17 determining infringement of the '536 patent?  
 18 A. An electrosurgical system.  
 19 Q. An electrosurgical system -- can it be part of a  
 20 larger arthroscopy system?  
 21 A. It's can be part of one, yes.  
 22 ---  
 23 Q. Were you here when Dr. Choti testified earlier this  
 24 week?  
 25 A. Yes, I was.

1 Q. Is Dr. Choti a surgeon?  
 2 A. Yes, he is.  
 3 Q. Do you recall whether Dr. Choti opined on the  
 4 infringement of the '536 patent?  
 5 A. Yes.  
 6 ---  
 7 Q. And what do you recall that Dr. Choti's opinion was?  
 8 A. He agreed with me.  
 9 MR. BOBROW: Your Honor, I object. It's beyond  
 10 the scope of his report, what Dr. Choti did and said, what  
 11 he opined on, et cetera is beyond the scope.  
 12 THE COURT: Is this what was presented here in  
 13 court or presented through reports?  
 14 MR. MARSDEN: It was simply the testimony that  
 15 was given from the stand by Dr. Choti, your Honor, and  
 16 we're not going to go any further with it.  
 17 THE COURT: I will allow it.  
 18 BY MR. MARSDEN:  
 19 Q. Thank you, Dr. Taylor.  
 20 I'd like to turn next to the '882 patent.  
 21 Can you describe for the jury what the '882  
 22 patent is all about?  
 23 A. The '882 patent is a method patent and it's basically  
 24 a method for describing how to carry out a particular  
 25 process. That's what a method patent is. And it's a

1 method basically for applying electrosurgical energy to a  
 2 point on the body or place on the body using an  
 3 electrosurgical probe. General description.  
 4 Q. I think we've put up on the screen JTX-2, which is  
 5 the '882 patent. Would that assist you in providing your  
 6 testimony on the '882 patent?  
 7 A. That basically describes it pretty well right there.  
 8 Q. Okay. And what we've put up on the screen is Claim 1  
 9 of the '882 patent; correct?  
 10 A. Correct.  
 11 Q. Is Claim 1 of the '882 patent asserted against the  
 12 Smith & Nephew products?  
 13 A. No, it is not.  
 14 Q. Okay. Why did you look at Claim 1?  
 15 A. Can you repeat the question?  
 16 Q. Sure. Why did you look at Claim 1 if it's not one  
 17 of the asserted claims?  
 18 A. Oh. It's the -- the dependent claims are asserted  
 19 against these products referenced Claim 1.  
 20 Q. So this is a little bit like Claim 45 was in the  
 21 '536 patent?  
 22 A. That's correct.  
 23 Q. Okay. Now, I believe Mr. Bobrow a little bit  
 24 earlier was questioning a witness about whether or not  
 25 the ElectroBlade has two electrodes or maybe three

1 electrodes.  
 2 Do you recall that?  
 3 A. Yes, I do.  
 4 Q. And that was in connection with the '882 patent?  
 5 A. That's correct.  
 6 Q. The '882 patent, is it even asserted against the  
 7 ElectroBlade products?  
 8 A. According to my understanding, it is not.  
 9 Q. Okay. What products is the '882 patent asserted  
 10 against?  
 11 A. It's asserted against the Saphyre and the Control  
 12 RF.  
 13 Q. What claims are asserted against the Saphyre?  
 14 A. The Saphyre has Claim 13, 17 and 54.  
 15 Q. And how about -- is it also asserted against Control  
 16 RF?  
 17 A. Yes. And Control RF, it's only 17 and 54.  
 18 Q. Are those asserted claims independent claims or  
 19 dependent claims?  
 20 A. Those are dependent claims.  
 21 Q. And how do you know that?  
 22 A. If you actually show me the claim, I can show you.  
 23 But they're -- all three of them are dependent upon  
 24 Claim 1.  
 25 MR. MARSDEN: Gary, can we go to the page

1 where we have Claims 13 and 17?  
 2 BY MR. MARSDEN:  
 3 Q. How do you know that claim 13 is a dependent claim?  
 4 A. If you look at the claim language here, it starts  
 5 off as similar to what was happening in the prior patent.  
 6 The method of Claim 1.  
 7 Q. All right. And how about Claim 17?  
 8 A. Similarly starts off as the method of Claim 1.  
 9 Q. And, finally, Claim 54.  
 10 A. Also the method of Claim 1.  
 11 Q. So how do you determine whether any of these  
 12 dependent claims is infringed?  
 13 A. You have to go back and take a hard look at Claim 1.  
 14 Q. Okay. Now, turning back to Claim 1, you've heard  
 15 some testimony, at least some reference during the course  
 16 of this trial to a certificate of correction.  
 17 A. That's correct.  
 18 Q. And is it your understanding that that dispute  
 19 relates to Claim 1 of the '882 patent?  
 20 A. Yes.  
 21 Q. Do you have an understanding of how many electrodes  
 22 Claim 1 required when it was allowed and published by the  
 23 Patent Office?  
 24 A. As originally published, it had four electrodes.  
 25 Q. And do you understand that there has been a

1 certificate of correction filed that would reduce that  
 2 number of electrodes to two?  
 3 A. Yes, I do.  
 4 Q. In conducting your infringement analysis of the  
 5 '882 patent, did you make any assumptions regarding the  
 6 certificate of correction?  
 7 A. I made an assumption that the certificate of  
 8 correction was invalid and conducted my analysis, assuming  
 9 that there were four electrodes.  
 10 Q. Okay. And you understand that the issue of whether  
 11 or not the certificate of correction is invalid will be  
 12 something that will be decided by the Court or the jury  
 13 in this case?  
 14 A. Yes, I understand.  
 15 Q. But for purposes of your infringement analysis you  
 16 assumed that it was invalid and that the claim, therefore,  
 17 required four electrodes as originally published?  
 18 A. That's correct.  
 19 Q. And have you -- with that assumption, have you formed  
 20 an opinion as to whether the Saphyre product infringes  
 21 Claims 13, 17 and 54 of the '882 patent?  
 22 A. Yes, I have.  
 23 Q. What is that opinion?  
 24 A. It does not infringe.  
 25 Q. Why not?



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1 A. It doesn't infringe because it doesn't have four  
 2 electrodes.  
 3 Q. How many electrodes does it have?  
 4 A. It has two.  
 5 Q. Again, using the same assumption about the  
 6 certificate of correction, have you reached a conclusion  
 7 as to whether the Control RF product infringes Claims 17  
 8 and 54 of the '882 patent?  
 9 A. Yes, I have.  
 10 Q. What is that opinion?  
 11 A. That it does not infringe.  
 12 Q. Why not?  
 13 A. It only has two electrodes instead of the four  
 14 required by the patent, or the claim.  
 15 Q. Okay. I think we're ready to move on to the '592  
 16 patent.  
 17 A. All right.  
 18 Q. Can you describe briefly for the jury what the '592  
 19 patent is about?  
 20 A. Once again, the -- the '592 patent is a method  
 21 patent. It's a -- basically, a patent that describes the  
 22 process for doing something. And it's a method patents  
 23 applying electrical energy to a target site on the body  
 24 while you're spacing away or not allowing the contact,  
 25 the return electrode to the body.

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1 Q. I'm sorry. Before I launch into the '592, I did  
 2 want to ask you one other question about the '882. Does  
 3 Dr. Goldberg dispute that the Saphyre and the Control RF  
 4 have only two electrodes?  
 5 A. I don't believe so, no.  
 6 Q. So that your real dispute over the '882 patent in  
 7 infringement is over whether or not the certificate of  
 8 correction is valid or not?  
 9 A. That's correct.  
 10 Q. And if it is valid, then it would require only two;  
 11 is that right?  
 12 A. Yes. However, there is, I think there's an issue in  
 13 that. If it only has two, then there would be a lot of  
 14 other products that infringe.  
 15 Q. Okay. Well, we'll talk about that when we get to  
 16 the invalidity portion of the case.  
 17 A. Okay.  
 18 Q. Probably tomorrow, at the pace we're going.  
 19 Let's turn back now to the '592 patent.  
 20 Have you prepared a slide to assist you in  
 21 explaining to the jury the opinions you've reached on  
 22 the '592 patent?  
 23 A. Yes, I have.  
 24 MR. MARSDEN: Could we call up DDTX-450, please?  
 25

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1 BY MR. MARSDEN:  
 2 Q. Can you tell the jury which claims of the '592  
 3 patent are asserted against the Smith & Nephew products?  
 4 A. Well, there are two sets of claims. One set is  
 5 shown here on the right, right-hand side, which are  
 6 Claims 3, 4, 11 and 21. And as shown here, they're all  
 7 dependent on Claim 1.  
 8 Q. Okay. Now, in this case, has ArthroCare also  
 9 asserted the independent Claim 1?  
 10 A. I don't believe so.  
 11 Q. All right.  
 12 A. I could be wrong. I have to admit, there have been  
 13 so many claim changes during the course of this particular  
 14 case that it's hard to keep track.  
 15 Q. Okay. In any event, as you know from the testimony  
 16 on the '882 and the '536, you need to look at Claim 1 in  
 17 any event; correct?  
 18 A. Right. You do.  
 19 Q. All right. And have you reviewed Claim 1 and the  
 20 dependent claims? First of all, can you tell the jury  
 21 again how you know Claims 3, 4, 11 and 21 are dependent  
 22 claims?  
 23 A. Once again, they start off with the method of Claim  
 24 1 in both Claims 3, 4, 11 and 21.  
 25 Q. And how did you go about analyzing whether Smith &

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1 Nephew's products infringed any of these asserted claims?  
 2 A. Once again, I started off with the independent  
 3 claim and looked at whether or not the Smith & Nephew  
 4 products meet all of the elements of the independent  
 5 Claim 1 and it does not or they do not.  
 6 Q. What element did they not meet?  
 7 A. They do not meet the highlighted element, which is  
 8 positioning a return electrode within the electrically  
 9 conducting fluid such that the return electrode is not  
 10 in contact with the body structure.  
 11 Q. Did you also consider the Court's claim construction  
 12 in evaluating whether or not the '592 patent is infringed?  
 13 A. Yes, I did.  
 14 MR. MARSDEN: Gary, can we call up the Court's  
 15 claim construction, please, and specifically the Court's  
 16 claim construction of these terms. And that's PTX-675 at  
 17 Paragraph 4, I believe.  
 18 BY MR. MARSDEN:  
 19 Q. Did you use the Court's definition as set forth here  
 20 in PTX-975 in determining whether or not the accused  
 21 products infringe the '592 patent?  
 22 A. Yes, I did. And basically I looked at the  
 23 highlighted sentence there: Claim limitation. The return  
 24 electrode is not in contact with the body structure is  
 25 clear -- the return electrode is not to contact the body

1 at all during the performance of the claimed method.  
 2 And my interpretation and analysis would  
 3 indicate that the products in suit here do contact the  
 4 body during the course of the claim method.  
 5 Q. How did you determine that?  
 6 A. Based on the video, actually, based on my own  
 7 personal experience, but also on the videos, training  
 8 videos that were produced to me.  
 9 Q. What do you mean by your own personal experience?  
 10 A. Well, I had the opportunity to play with, I shouldn't  
 11 say play -- for an engineer, it's play. Experiments with  
 12 the cadaver shoulders at Smith & Nephew and had an  
 13 opportunity to use the devices in a cadaver shoulder, and  
 14 it was obvious that it would be very difficult to perform  
 15 these procedures without contacting, having the return  
 16 electrode contact the body structures at some point  
 17 during the course of the procedure.  
 18 Q. Did you also review videos that Smith & Nephew has  
 19 prepared to train its sales force?  
 20 A. Yes, I did. I looked at the training videos and  
 21 those training videos actually are conducted by people  
 22 that know what they're doing in terms of arthroscopy.  
 23 And there -- it was obvious that during the course of  
 24 those training videos, that the return electrode was  
 25 contacting tissue during the course of the procedure.

1 Q. Now, I believe through the course of the trial we've  
 2 actually seen several of those videos and I believe we've  
 3 already seen videos of the Saphyre and the ElectroBlade  
 4 in operation.  
 5 Do you recall that?  
 6 A. Yes, I do.  
 7 Q. But do you know whether the jury has seen a video  
 8 yet of the Control RF product in operation?  
 9 A. To my knowledge, they have not.  
 10 Q. Okay. And did you consider the video or a video of  
 11 the Control RF product in operation in determining whether  
 12 or not there was infringement of the claims of the '592  
 13 patent?  
 14 A. Yes, I did.  
 15 Q. Okay. And do you have a clip to show the jury?  
 16 A. Yes.  
 17 Q. Okay. Was this a video that was prepared again by  
 18 Smith & Nephew to train its sales force on how this  
 19 product would be used?  
 20 A. Yes, it was.  
 21 Q. Okay.  
 22 MR. MARSDEN: Gary, can we play DTX-897,  
 23 please?  
 24 BY MR. MARSDEN:  
 25 Q. Dr. Taylor, if you would go ahead and describe for

1 the jury what we're seeing.  
 2 A. Okay.  
 3 (Pause.)  
 4 (Video played.)  
 5 THE WITNESS: What you can see here is the  
 6 Control RF, the active electrode is somewhat buried in  
 7 the tissue, but the return electrode is obviously  
 8 touching -- touching tissue at various points during the  
 9 procedure. Actually, it's obscured here, but -- in  
 10 essence, the return electrode is contacting tissue during  
 11 a large portion of the procedure, right there (indicating).  
 12 MR. MARSDEN: Could I approach, your Honor?  
 13 THE COURT: Yes, you may.  
 14 BY MR. MARSDEN:  
 15 Q. Let me hand you, Dr. Taylor, the Control RF product  
 16 that was marked earlier in this case. I wonder if you  
 17 could remind the jury where the return electrode is on  
 18 that device (handing exhibit to the witness).  
 19 A. Sure. A little difficult to see, but the tip of my  
 20 finger is the start of the return electrode and it extends  
 21 up to the tip of this white structure here (indicating).  
 22 So it's a fairly large electrode relative to the active  
 23 electrodes, which are very tiny.  
 24 Q. Okay.  
 25 MR. MARSDEN: You can stop the video. Thank

1 you.  
 2 MR. MARSDEN: Your Honor, I move the admission  
 3 of DTX-897, the video that was just played.  
 4 MR. BOBROW: No objection.  
 5 THE COURT: All right. Thank you.  
 6 \*\*\* (Defendant's Exhibit No. 897 was received into  
 7 evidence.)  
 8 BY MR. MARSDEN:  
 9 Q. Dr. Taylor, if we can go back to the claims, we  
 10 talked about Claim 1 and the dependent claims that depend  
 11 from Claim 1; correct?  
 12 A. Yes.  
 13 Q. Did you prepare a slide to show the other claims of  
 14 the '592 that are asserted?  
 15 A. Yes, I did.  
 16 MR. MARSDEN: Could we call that up, please,  
 17 Gary? Okay.  
 18 BY MR. MARSDEN:  
 19 Q. And this is headed ArthroCare also asserts Claims  
 20 23, 26, 27, 32 and 42 of the '592 patent; correct?  
 21 A. That's correct.  
 22 Q. Okay. Are these claims also asserted against the  
 23 Smith & Nephew Saphyre ElectroBlade and Control RF  
 24 products?  
 25 A. Yes, they are.

1 Q. Can you describe to the jury how this set of claims  
2 works?  
3 A. Once again, on the right-hand side, right column,  
4 we have Claims 26, 27, 32 and 42. As you can see, they  
5 all start off with the method of Claim 23 at the beginning  
6 of each claim. On the other side we have Claim 23.  
7 So it requires, in order to analyze it, that  
8 you examine whether or not the products infringe Claim 23.  
9 Q. Have you analyzed whether the three accused products  
10 infringe Claim 23?  
11 A. Yes, I did.  
12 Q. And did you determine whether all of the elements  
13 that are required by Claim 23 are present in the accused  
14 devices?  
15 A. No, they're not. The -- the accused devices do not  
16 meet the second element there, the one that's highlighted,  
17 saying spacing a return electrode away from the body  
18 structure.  
19 Q. And did you, again, use the Court's claim  
20 construction in reaching that conclusion?  
21 A. Yes, I did.  
22 Q. Did you rely on the videos that we've seen here in  
23 court in reaching that conclusion?  
24 A. Yes.  
25 Q. And did you also rely on your own experimentation

1 with the devices?  
2 A. Yes.  
3 Q. In summary, then, Dr. Taylor, have you formed an  
4 opinion as to whether the Saphyre, ElectroBlade and  
5 Control RF products infringe Claims 1, 3, 4, 11, 21, 23,  
6 26, 27, 32 and 42 of the '592 patent?  
7 A. I've reached an opinion.  
8 Q. What is your opinion?  
9 A. They do not infringe.  
10 Q. Do you recall whether Dr. Choti expressed an opinion  
11 on the '592 patent with respect to infringement?  
12 A. He agreed with me.  
13 MR. MARSDEN: Your Honor, that concludes our  
14 presentation on noninfringement for today. It might be a  
15 logical breaking point.  
16 THE COURT: All right. Members of the jury,  
17 we will conclude for the day.  
18 We kept you late today. We're going to let you  
19 come in later tomorrow because we've got some business we  
20 have to take care of, so if you will report -- and I think  
21 I'm going to make it at 10:30 tomorrow morning.  
22 In the meantime, however, you're not to discuss  
23 the case among yourselves or with anyone else. You're not  
24 to read or listen to anything touching on the case or  
25 perform any independent investigation.

1 Have a safe trip home, a wonderful evening and  
2 we'll see you tomorrow morning at 10:30.  
3 (At this point the jury was excused for the  
4 evening recess, and the following occurred without the  
5 presence of the jury.)  
6 THE COURT: All right. I have a plea at 4:30,  
7 so we're not going to do anything yet this afternoon.  
8 We'll meet tomorrow morning at 9:30, go over these  
9 demonstratives and the other evidentiary issues and charge.  
10 If you can hang around for just a few minutes, I will have  
11 my Clerk copy my first draft of the jury instructions so  
12 you have the evening to look over them.  
13 Oh, we need a verdict form. Take a look at  
14 the jury instructions and then prepare a verdict form,  
15 depending on what you think about what's going on in the  
16 case at this point. All right?  
17 Thank you.  
18 (Court recessed at 4:23 p.m., to reconvene on  
19 Thursday, May 8, 2003, at 9:30 a.m.)  
20 ---  
21  
22  
23  
24  
25

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- VOLUME G -

IN THE UNITED STATES DISTRICT COURT

IN AND FOR THE DISTRICT OF DELAWARE

ARTHROCARE CORPORATION,

Plaintiff

vs.

SMITH & NEPHEW, INC.,

Defendant

NO. 01-504 (SLR)

Wilmington, Delaware

Thursday, May 8, 2003

9:03 o'clock, a.m.

BEFORE: HONORABLE SUE L. ROBINSON, Chief Judge, and a jury

APPEARANCES:

MORRIS, NICHOLS, ARSHT & TUNNELL

BY: JACK B. BLUMENFELD, ESQ. and

KAREN JACOBS-LOUDEN, ESQ.

-and-

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APPEARANCES (Continued):

WEIL, GOTSHAL & MANGES

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TIMOTHY DeMASI, ESQ. and

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KEITH A. WALTER, ESQ. and

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-and-

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BY: MARK J. HEBERT, ESQ.,

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-and-

FISH & RICHARDSON

BY: KURTIS D. MacFERRIN, ESQ. and

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(Redwood City, California)

Counsel for Defendant

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PROCEEDINGS

(Proceedings commenced in the courtroom, beginning at 9:03 a.m., and the following occurred without the presence of the jury.)

THE COURT: All right. Generally, how I go through the jury instructions is basically page by page. I will holler out the page. If there is an objection, a correction, a typographical error, whatever, you can holler out. If I don't hear anything I will assume there is nothing to be corrected or changed or amended.

We will start with Page 2, the introduction.

Page 3, the jurors' duties.

Page 4, evidence defined.

Page 5, more evidence defined.

Page 6, consideration of evidence.

Page 7, circumstantial evidence and direct.

And I have got money out there for someone who gives me a different example some day, because I am so sick of this example. Think about it.

Page 8, credibility of witnesses.

Page 9, more credibility of witnesses.

Page 10, expert witnesses.

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Page 11, deposition testimony.

Page 12, number of witnesses.

Page 13, demonstrative exhibits.

Page 14, burdens of proof.

MS. BOYD: Your Honor, Smith & Nephew would like to request that the last sentence of the paragraph regarding clear and convincing evidence be deleted, this sentence read this burden remains with Smith & Nephew throughout the case, it never changes or shifts to ArthroCare.

This is in addition to the Delaware Model Instruction, and we would ask that it be deleted. In the alternative, we would ask that a parallel statement be added to the end of the preponderance of the evidence paragraph.

MS. JACOBS-LOUDEN: Your Honor, this is a correct statement of the law. We cited case law for it. It has appeared in other instructions before this Court. The modern rules, of course, haven't been amended since 1993. So it is not surprising that there would be some additions since the 1993 edition.

But it is what the law is, and we think it is a correct statement that would be helpful to the jury.

THE COURT: well, is it not also true that your burden on infringement remains with you throughout

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1 I'm going to correct it, he didn't -- I mean he corrected  
 2 it and he didn't have ordinary skill.  
 3 So I think it's unfair to have us judge it one  
 4 way when it was done in another way. So without knowing  
 5 the history of this, I'm not confident, regardless of what  
 6 the technical standard is, I'm not sure whether it should  
 7 be applied in this case, depending on the facts.  
 8 MS. JACOBS-LOUDEN: But I think what would be  
 9 unfair is if Mr. Raffle would be questioned, well, wouldn't  
 10 one reading this think X? Wouldn't one reading this think  
 11 Y? He prosecuted the patent. He can give what information  
 12 he can about the prosecution of the patent, but to start  
 13 using him to make an argument about what one would  
 14 understand reading this would be inappropriate.  
 15 MR. MACFERRIN: Your Honor, Mr. Raffle submitted  
 16 a declaration earlier in this case about these very alleged  
 17 errors saying they were clerical, typographical errors.  
 18 THE COURT: And I think everyone is agreeing  
 19 that you can ask him what he did. I think the issue is  
 20 whether you can say, kind of make him more than a fact  
 21 witness, more of an expert witness, wouldn't one of  
 22 ordinary skill in the art understand X Y and Z? That's  
 23 not appropriate, I don't think.  
 24 MR. MACFERRIN: I don't think that necessarily  
 25 pertains to the demonstrative issue.

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1 THE COURT: No, no.  
 2 MR. MACFERRIN: Just having a slide.  
 3 MS. JACOBS-LOUDEN: The demonstratives we  
 4 provided do raise this issue. There were slides that say  
 5 that one could think this isn't an obvious error. One  
 6 could think the claims could be changed this way.  
 7 MR. BLUMENFELD: Your Honor, the  
 8 demonstratives -- and here is the first one. It's No. 411,  
 9 and the heading of it is, they show a change to the claim  
 10 and they say, the heading is Alleged Active Electrode  
 11 Error Fails The Test, Part 2. Even if active electrode  
 12 is an obvious error, it's not obvious how it should be  
 13 corrected. Other changes could have been made.  
 14 MR. MACFERRIN: We agree we will not use that  
 15 slide, your Honor.  
 16 MR. BLUMENFELD: If they're not going to use  
 17 that, they won't be able to use the other ones that follow  
 18 on it that say the same thing.  
 19 MR. MACFERRIN: Well, there is slides, your  
 20 Honor, which merely shows the changes that were made to  
 21 the claim by the certificate of correction.  
 22 MR. BLUMENFELD: That ne, we don't have a  
 23 problem if they want to use that, but then they have  
 24 another slide that says here is what the legal test is.  
 25 The alleged error fails the test, part one, part one

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1 again, part two, part three. So if they're just going  
 2 to use the change, then I don't think we have an issue.  
 3 But if they're going to put slides up with the prosecuting  
 4 attorney, say here is the test and you failed, I don't  
 5 think they should be able to do that.  
 6 THE COURT: Yes. It seems to me that in this  
 7 case, both sides have missed the boat on important issues  
 8 because you weren't forthcoming in the first instance and  
 9 didn't let you get evidence in in the second instance, so  
 10 my warning to you is you better be forthcoming because  
 11 surprises, I'm not good at surprises. If you're trying  
 12 to get in evidence that is inappropriate or that was not  
 13 appropriately discovered, it's not going to come in and  
 14 you are not going to look good in the eyes of the jury  
 15 and you are not going to look good in the eyes of the  
 16 Court.  
 17 So maybe you need to hash this out. There  
 18 will be no argumentative demonstratives of the kind that  
 19 Mr. Blumenfeld has brought to my attention. All right?  
 20 That's not how we do things here.  
 21 All right. Let's take a few minutes. The  
 22 jury will be here at 10:30 and I want to get started on it.  
 23 Oh, verdict form. We still need something to  
 24 work from on a disk which would be helpful, and you still  
 25 haven't told me when you think this might go to a jury.

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1 Just the best estimate. It's not --  
 2 MS. BOYD: Well, that actually relates to  
 3 another issue that I wanted to raise with the Court.  
 4 Assuming that we do go to the jury, the jury starts its  
 5 charge at 2:30 on Friday afternoon.  
 6 THE COURT: No.  
 7 MS. BOYD: No?  
 8 THE COURT: No, it won't start at 2:30 Friday  
 9 afternoon. I mean the point is, I mean the way I had  
 10 given you time, it should make us be finishing up on  
 11 Friday morning, so the jury gets it well before the end  
 12 of the day on Friday.  
 13 MS. BOYD: Okay, your Honor.  
 14 THE COURT: Are you keeping track of your time,  
 15 everybody? And you still have inequitable conduct that is  
 16 included in that time?  
 17 MS. BOYD: There is, there is some confusion  
 18 about how details of time are being allocated with  
 19 deposition designations, but there is a running total that  
 20 we have been informed of.  
 21 THE COURT: All right.  
 22 MR. BOBROW: Your Honor, do you have an estimate  
 23 now of what the time is for both sides?  
 24 THE COURT: I'm sure Francesca does. Why don't  
 25 you talk to her about it because the time I gave you was

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1 for inequitable conduct as well. And this case was  
2 supposed to be done by 3:00, everything. That means in my  
3 mind if you have an inequitable conduct case, the jury  
4 needs to get it well before 3:00. Otherwise, theoretically  
5 you don't have time left.

6 MS. BOYD: Mr. Blumenfeld has proposed or  
7 ArthroCare has proposed to Smith & Nephew that the  
8 inequitable conduct case be addressed while the jury is  
9 deliberating, so that would be, I guess, late Friday  
10 morning or early Friday afternoon.

11 Will that work with the Court's schedule?

12 THE COURT: Yes, as long as you are within  
13 your time. I'm not putting in extra time. What I'm doing  
14 is putting in my trial time, which is your trial time. So  
15 you need to work it out. And work out, before you put on  
16 and use your last bit of time with these witnesses that  
17 you proposed to put on, you better have a clear idea of  
18 what you want left for inequitable conduct. All right?

19 Okay. Thank you, counsel.

20 MR. BLUMENFELD: Your Honor?

21 THE COURT: Yes.

22 MR. BLUMENFELD: Just to make clear, the 16  
23 hours we got I assume includes closing arguments.

24 THE COURT: Yes, it includes everything. And  
25 the more time -- I mean it doesn't include -- I have

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1 given you some time on this, not the evidentiary issues  
2 but the jury instruction charge conference is on my time,  
3 but all the evidentiary issues you've been having is your  
4 time. That's your trial time that you are using on that  
5 kind of discussion because you haven't been able to work  
6 it out or you haven't given the other party enough notice  
7 to work it out.

8 So keep that in mind when Francesca talks to  
9 you about how much time, little time you have left.

10 (Court recessed at 10:24 a.m.)

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1  
2 (Court resumed after the recess, and the  
3 following occurred without the presence of the jury.)  
4

5 THE COURT: I did want to note for the record  
6 before we started that I am going to give Smith & Nephew a  
7 half-hour because, quite frankly Mr. Hebert was much too  
8 patient with some of the plaintiff's witnesses, who did  
9 not answer questions directly and clearly. And we had to  
10 go over the same questions time and again.

11 So for that reason, they get another half-hour.

12 All right. Let's bring the jury in.

13 MR. MARSDEN: Thank you, your Honor. While we  
14 are bringing the jury in, can I move those five exhibits.

15 THE COURT: Yes.

16 MR. MARSDEN: PX-478, PX-672, DTX-912, DTX-121,  
17 DTX-600, and DTX-791.

18 THE COURT: Any objection to those exhibits?

19 MR. BLUMENFELD: No, your Honor.

20 THE COURT: Thank you.

21 \*\*\* (Above-referenced exhibits were received into  
22 evidence.)

23 (At this point the jury entered the courtroom  
24 and took their seats in the box.)

25 THE COURT: Mr. Marsden, you may proceed.

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1 MR. MARSDEN: Thank you, your Honor. Good  
2 morning, ladies and gentlemen of the jury.

3 ---

4 DEFENDANT'S TESTIMONY

5 CONTINUED  
6

7 ... KENNETH TAYLOR, having been  
8 previously duly sworn as a witness, was  
9 resumed and testified further as follows ...

10 DIRECT EXAMINATION

11 BY MR. MARSDEN:

12 Q. Good morning, Dr. Taylor.

13 A. Good morning.

14 Q. Dr. Taylor, before we move to the issue of invalidity,  
15 I wanted to touch on a couple of cleanup matters related to  
16 the noninfringement opinions you provided yesterday.  
17 Yesterday, I asked you whether you considered or used the  
18 Court's claim constructions in reaching your opinions on  
19 noninfringement.

20 Do you recall that?

21 A. Yes, I do.

22 Q. Just to clarify, when did the Court provide its  
23 claim constructions to the parties?

24 A. In about a month.

25 Q. Did you review the Court's claim constructions?

1 A. Yes, I did.  
 2 Q. Did you consider them in offering the opinions you  
 3 have offered here in court?  
 4 A. Yes, I have.  
 5 Q. Do you believe the opinions you have offered here  
 6 in court are consistent with the Court's claim  
 7 constructions?  
 8 A. Yes.  
 9 Q. Turning to another brief cleanup issue on  
 10 noninfringement, yesterday, when we were discussing the  
 11 '592 patent, the not touching the body patent, you  
 12 discussed I believe having the opportunity to use the  
 13 probes in a cadaver's shoulder?  
 14 A. Yes.  
 15 Q. I think you used the word procedure when you  
 16 described that. What did you mean by procedure?  
 17 A. I meant that I was performing the method that was  
 18 similar to the steps in the claim.  
 19 Q. What is the method of '592, what are those steps?  
 20 A. Summarily speaking, you position an active  
 21 electrode either touching the tissue or in proximity to  
 22 the tissue.  
 23 Q. That's step one?  
 24 A. That's step one. And step two is you position the  
 25 return electrode, so it's not touching the tissue -- not

1 touching the body, I should say. That's step two.  
 2 And step three is you apply the energy to  
 3 the active electrode.  
 4 Q. How do you know that those are the three steps of  
 5 the '592 method?  
 6 A. That's basically what is in the claims.  
 7 Q. Has the Court provided us any additional guidance  
 8 since yesterday about the meaning of those claim terms?  
 9 A. Yes.  
 10 MR. MARSDEN: Gary, can we put up the Court's  
 11 jury instruction on this?  
 12 MR. BOBROW: Your Honor, I don't believe this  
 13 is your jury instruction, in the sense that I thought  
 14 those were still under consideration. I don't know that  
 15 it is appropriate to show that though this witness.  
 16 THE COURT: My jury instruction is going to  
 17 be consistent with my memorandum opinion. So none of  
 18 this should be different. If this is consistent with my  
 19 memorandum opinion, then this is fine.  
 20 MR. MARSDEN: Thank you, your Honor.  
 21 Gary, if you could zoom in on Paragraph No. 3...  
 22 BY MR. MARSDEN:  
 23 Q. Dr. Taylor, I believe we discussed the first sentence  
 24 of this paragraph several times during the course of the  
 25 trial?

1 A. That's correct.  
 2 Q. Not touching, not contacting the body at all. Do  
 3 the additional sentences that appear in Paragraph 3 change  
 4 your opinion regarding whether or not there is infringement  
 5 of the '592 patent?  
 6 A. No, it does not. It basically strengthens my  
 7 opinion.  
 8 Q. Why does it strengthen your opinion?  
 9 A. Well, I think I meant makes it abundantly clear  
 10 that the claim construction doesn't have any time  
 11 limitations. That's number one. That's in the second  
 12 sentence, the claimed method does not contain any time  
 13 limitations.  
 14 And the last sentence says that the claimed  
 15 method is performed when each of the three steps has  
 16 been completed. So I think that also strengthens my  
 17 position.  
 18 Q. Thank you very much.  
 19 MR. MARSDEN: Ladies and gentlemen of the jury,  
 20 we are now going to turn to the issue of invalidity. I  
 21 will apologize in advance that we are going to be moving  
 22 through this very quickly. You will have these  
 23 references with you in the jury room for your deliberations.  
 24 Fortunately, many of the arguments relate to pictures or  
 25 figures that are in the patents. So I think you will be

1 able to find them relatively easily when you are in the  
 2 jury room.  
 3 But I do apologize in advance, because we have  
 4 time limits and we are going to move through this material  
 5 quite quickly this morning with Dr. Taylor.  
 6 BY MR. MARSDEN:  
 7 Q. Dr. Taylor, now turning to this question of  
 8 invalidity of the asserted claims, do you have an opinion  
 9 as to whether the asserted claims of the ArthroCare patents  
 10 are invalid?  
 11 A. Yes, I do.  
 12 Q. What is your opinion?  
 13 A. My opinion is that the claims are invalid.  
 14 Q. What is the basis for your opinion?  
 15 A. The basis for my opinion is that there is prior art  
 16 or prior information that was published prior to these  
 17 patents that contains all the essential elements of the  
 18 claims.  
 19 Q. Does that mean someone else did it first?  
 20 A. Yes. That's another way of putting it.  
 21 Q. I think we also heard the term anticipation in  
 22 this trial. Is that another word for this?  
 23 A. That is another way of putting that. The prior  
 24 art anticipates the claims that are asserted.  
 25 Q. How do you determine for purposes of validity

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1 whether someone else did it first?

2 A. Essentially, you -- I guess you can consider it to

3 be an infringement analysis in reverse. Yesterday, I

4 went through all the different elements of each of the

5 claims, and described how the Smith & Nephew products did

6 not infringe. In essence, what I did is an analysis in

7 reverse, by the fact that I looked at all the different

8 prior art to see whether or not the prior art taught the

9 various elements of the claims that are being asserted.

10 Q. Did you consider what level of proof is required

11 to prove anticipation?

12 A. Yes. I was looking for proof in the prior art that

13 the prior art actually taught all the essential elements

14 in a very highly probable, very clear and convincing

15 manner, so it would be evident to me, someone that is

16 skilled in the art, and evident to almost anybody that

17 the prior art taught that essential element.

18 Q. You mentioned there are several references that you

19 relied on. What are those references?

20 A. Actually, those references are shown right there on

21 that board. There are six references?

22 If you take a look, since it is a timeline as

23 well as a pictorial of the various references, you will

24 see that the earliest date of the ArthroCare invention is

25 around 1993. Then there are six references going back

1 the board. Typically what we are doing is showing on the

2 left-hand side the claims, and then the articles or

3 patents that are applied on the right-hand side of the

4 board. In this case, it is the Elsasser and Roos article,

5 the Roos '198 patent, the Doss '007 patent and the Pao

6 '499 patent.

7 Q. Let's start with the Elsasser and Roos article then.

8 If you could turn to DTX-59-A and 59-B in your notebook,

9 can you identify those for the record?

10 A. Okay. DTX-59A is the original German publication.

11 DTX-59B is the English translation of that publication.

12 MR. MARSDEN: Your Honor, I move the admission

13 of DTX-59-A and 59-B.

14 MR. BOBROW: No objection.

15 THE COURT: Thank you.

16 \*\*\* (Defendant's Exhibits No. DTX-59-A and 59-B

17 was received into evidence.)

18 BY MR. MARSDEN:

19 Q. Can you tell the jury first just generally what the

20 Elsasser and Roos article describes and have you prepared

21 a slide for this?

22 A. Yes, I have.

23 Gary, can I have that slide?

24 The Elsasser and Roos article describes a

25 bipolar electrosurgical device for the treatment of

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1 in time. Dr. Manwaring's patent, which is in 1992, the

2 '138 patent. 1987, the Pao '499 patent. 1985, the

3 Slager articles. 1983, the Doss '007 patent. 1983 the

4 Roos '198 patent. And 1976 the Elsasser and Roos articles.

5 Q. Let's turn first to your analysis of the '536, the

6 fluid supply patent. Can you first, maybe Ms. Prescott

7 can assist us here. Do you have a board to discuss the

8 '536 patent claims?

9 A. Yes. That is the first board on the right of the

10 board I just referenced.

11 Q. With reference to that board can you remind the jury

12 which claims are at issue in the '536 patent?

13 A. Yes. The claims that are at issue in the '536

14 patent are the dependent Claims 46, 47 and 56. As I

15 mentioned yesterday, in order to analyze those claims,

16 you have to first analyze the independent claim, which is

17 Claim 45.

18 Q. Let's start with Claim 45, then. Have you formed

19 an opinion as to the validity of Claim 45?

20 A. Yes, I have.

21 Q. What is that opinion?

22 A. My opinion is that Claim 45 is invalid.

23 Q. What is the basis for your opinion?

24 A. The basis for my opinion is that I analyzed the

25 prior art, the four articles that are referenced there on

1 prostate and bladder tissue, commonly known as the

2 procedure of a T-U-R-P or a TURP.

3 Q. Now, have you performed an element-by-element

4 comparison of the teachings of the Elsasser and Roos

5 article to the asserted claims of the '536 patent?

6 A. Yes.

7 Q. Have you prepared any slides to assist you in

8 illustrating to the jury what that analysis was?

9 A. Yes, I do. There is a series of slides.

10 Gary, if you can go to the next one?

11 Essentially what I did here, as I mentioned

12 before, I started with the independent Claim 45. The way

13 these things are laid out, on the left-hand side of the

14 screen we have the claim, and we will highlight the

15 particular element that I was analyzing for that

16 particular slide.

17 On the right-hand side we will have a figure, a

18 generally some text that is in the actual article, and

19 generally at the top of that column will be the actual

20 location of that text.

21 So in this case, the element that is being

22 analyzed is the high-frequency power supply. The article

23 specifically mentioned we connected the cutting loop and

24 the neutral electrode to a high frequency surgical unit.

25 That element is satisfied.



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1 Q. Before you go any further, Dr. Taylor...

2 MR. MARSDEN: Let me just tell the jury that  
3 these slides that you are seeing are demonstrative  
4 evidence and you will not have those in the jury room.  
5 If there is any information on these slides that you think  
6 is important or want to make a note of, you might want to  
7 do it as we go you. You will have the Elsasser and Roos  
8 article, but not these slides in the jury room.

9 THE WITNESS: Actually, before I go through  
10 the next sequence, the resectroscope consists of four  
11 elements. There is an outer sheath which is generally  
12 where the irrigation comes in. There is a telescope.  
13 Mr. Sparks showed you an arthroscope. Basically the  
14 telescope is a longer version of that. It is an  
15 endoscope.

16 There is a working element which is actually  
17 used to remove the cutting electrode, so it actually uses  
18 the working element, sort of a pistol grip mechanism, you  
19 move your thumb up and down, and that moves the electrode.  
20 And the electrode is shown right there, right at the tip.

21 So we can go to the next overhead.

22 The next element there is an electrosurgical  
23 probe comprising a shaft having a proximal and distal end.  
24 That is highlighted there. The article specifically  
25 mentions using a conventional resectroscope, which is what

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1 I just described to you.

2 BY MR. MARSDEN:

3 Q. Just to complete the process here --

4 A. Katie -- I am sorry, I ignored her. She is actually  
5 doing the checkmark, so you understand that each of the  
6 elements have been identified in the article, or patent.

7 Q. Thank you.

8 A. So in this case, this element has been satisfied by  
9 this reference as part, this part of the article.

10 Next, please.

11 The next settlement is an electrode terminal  
12 disposed near the distal end. That is satisfied by the  
13 resectroscope's cutting loop.

14 Q. It is there?

15 A. Right there, right.

16 So that element is satisfied.

17 Next. A connector near the proximal end of  
18 the shaft electrically coupling the electrode terminal to  
19 the electrosurgical power supply. Actually, there is two  
20 connectors, the one that is shown is right there. There  
21 is another one that you can't see that would be right  
22 about there.

23 So that element is satisfied.

24 Next.

25 The next element is a return electrode

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1 electrically coupled to the electrosurgical supply. The  
2 return electrode is this little metal band here, and we  
3 have already mentioned that is coupled to the high-  
4 frequency surgical unit. So that element is satisfied.

5 Next.

6 The last element is an electrically conducting  
7 fluid supply directed at the target tissue, which allows  
8 current flow path between the return electrode and the  
9 electrode terminal. The article specifically has quotes  
10 in it that indicates that that is the case. So that  
11 element is satisfied.

12 Q. On Claim 45, to sum up, do you have an opinion as  
13 to whether Claim 45 of the '536 patent is anticipated by  
14 the Elsasser and Roos article?

15 A. Yes, I have an opinion, and it is anticipated.

16 Q. Can you move onto the next claim, please?

17 Next.

18 The next claim is a dependent claim, as I  
19 mentioned before. It requires that it satisfies all the  
20 elements of Claim 45. And additionally, the return  
21 electrode forms a portion of the electrosurgical shaft.  
22 And that is the case, given the text there, indicating  
23 that the neutral electrode, which is another word for  
24 return electrode, is incorporated into the end of the  
25 resectroscope shaft. So that element is satisfied.

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1 Q. Do you have an opinion as to whether Claim 46 of  
2 '536 patent is anticipated by the Elsasser and Roos  
3 article?

4 A. Yes, I do, and it is anticipated.

5 Q. Did you consider the Elsasser and Roos article in  
6 connection with any other claims of the '536 patent?

7 A. Yes. The next claim is Claim 47. Next, please.

8 Q. That is Claim 56; correct?

9 A. I am sorry. 56.

10 And this claim, you have to have all the  
11 elements of Claim 45, plus you have to satisfy one of the  
12 target roots, which is body locations there, including  
13 the abdominal cavity, thoracic cavity, et cetera. The  
14 resectroscope is used in resections of the prostate or  
15 bladder, which is in the abdominal cavity.

16 Q. Do you have an opinion as to whether Claim 56 of  
17 the '536 patent is anticipated by the Elsasser and Roos  
18 article?

19 A. Yes, I do. And it is.

20 Q. Thank you. We skipped over Claim 47. Are there  
21 other references that you discuss that anticipate Claim  
22 47?

23 A. Yes, there are.

24 Q. I think you have said you also relied on the Roos  
25 '198 patent; is that correct?

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1 A. That's correct.  
 2 Q. First of all, can you turn in your book to DTX-11  
 3 and identify that, please?  
 4 A. DTX-11 is the Roos '198 patent.  
 5 MR. MARSDEN: Your Honor, I move the admission  
 6 of DTX-11.  
 7 MR. BOBROW: No objection.  
 8 THE COURT: Thank you.  
 9 \*\*\* (Defendant's Exhibit No. 11 was received into  
 10 evidence.)  
 11 BY MR. MARSDEN:  
 12 Q. Dr. Taylor, have you prepared a slide to tell the  
 13 jury what the Roos '198 patent is about?  
 14 A. Yes, I have.  
 15 Gary? Thank you.  
 16 The Roos '198 patent basically follows up on  
 17 the work that Doctors Elsasser and Roos did in their  
 18 article and it's a bipolar electrosurgical device for the  
 19 treatment of prostate and bladder tissue, commonly known  
 20 as TURP.  
 21 Q. What does TURP stand for?  
 22 A. Transurethral resection of the prostate.  
 23 Q. Have you done an element-by-element comparison of  
 24 the teachings of the Roos '198 with the claims of the  
 25 '536 patent?

1 Claim 1, as described here in this text.  
 2 So that element is satisfied.  
 3 Next.  
 4 It requires a return electrode electrically  
 5 coupled to the generator. We already described that. The  
 6 return electrode, or the neutral electrode is indicated by  
 7 this yellow area. So that element is satisfied.  
 8 Next.  
 9 It also requires an electrically conducting  
 10 fluid supply, directed to the target site and generating  
 11 current, flow path between the active and return electrode.  
 12 That is diagrammatically shown here in Figures 7 and 8 and  
 13 also specifically called out in Claim 1, basically the  
 14 last line in Claim 1. So that element is satisfied.  
 15 Q. Just to pause on this one for a moment, that  
 16 language that is quoted below the drawing comes from Claim  
 17 1 of the Roos '198 patent?  
 18 A. That's correct.  
 19 Q. That is where you found support for the electrically  
 20 conducted fluid limitation?  
 21 A. Yes.  
 22 Q. To sum up, on Claim 45, do you have an opinion, Dr.  
 23 Taylor, as to whether Claim 45 of the '536 patent is  
 24 anticipated by the Roos '198 patent?  
 25 A. Yes, I do. And it is.

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1 A. Yes, I have.  
 2 Q. Have you prepared some slides to illustrate that?  
 3 A. Yes, I have. Gary?  
 4 Thank you.  
 5 Using the same format that we have used in  
 6 prior slides, a high-frequency power supply is indicated  
 7 in the patent. Column 7, Lines 5 through 7. It  
 8 basically says the device is connected to a high-frequency  
 9 generator, which is not shown in these figures. So that  
 10 element is satisfied.  
 11 Next.  
 12 The next element is an electrosurgical probe  
 13 having a shaft, a proximal and distal end. That is  
 14 diagrammatically shown in Figures 7 and 8. That element  
 15 is satisfied.  
 16 Next. The next element is an electrode terminal  
 17 disposed near the distal end. The electrical terminal is  
 18 basically the cutting loop. That is described in Column 6,  
 19 Lines 67 and 68 and also in these figures. So that element  
 20 is satisfied.  
 21 Next.  
 22 A connector, requires a connector, coupling  
 23 the shaft to the electrosurgical power supply.  
 24 And that element is satisfied by Figure 7 and  
 25 the text in Column 7, Lines 1 through 5. And also in

1 ---  
 2 Q. Did you look at the '198 patent to see if the '536  
 3 patent is anticipated by the Roos '198 patent?  
 4 A. Yes, I did. That's indicated in the next overhead.  
 5 Claims 46 is anticipated. Claim 46 requires all the  
 6 elements of Claim 45. Additionally, the return electrode  
 7 forms a portion of the shaft of the probe and, as I  
 8 previously indicated, my Figure 7 and Figure 8, that is  
 9 the case. So that element is satisfied.  
 10 Q. Do you have an opinion as to whether Claim 46 of  
 11 the '536 patent is anticipated by the Roos '198 patent?  
 12 A. Yes, I do. And it is.  
 13 Q. Did you look at any other claims of the '536?  
 14 A. Yes, and the next overhead shows that. Claim 47  
 15 requires all the elements of Claim 46, which is dependent  
 16 on Claim 45, and requires that you have an insulating  
 17 member circumscribing the electrode. Insulating member  
 18 is shown there. That is identified as 35.  
 19 And is there an overhead? The next one, Gary?  
 20 Go back. Go back. Sorry.  
 21 It also requires that return electrode is  
 22 sufficiently spaced from the electrode terminal, between  
 23 the return electrode and the patient's tissue. That's the  
 24 case. So all the elements are satisfied.  
 25 Q. Do you have an opinion as to whether Claim 47 of

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1 the '536 patent is anticipated by the Roos '198 patent?  
 2 A. Yes, I do. And it is.  
 3 Q. Did you look at any other claims of the '536?  
 4 A. Yes, and I guess I already tipped my hand here. I  
 5 looked at Claim 56 and Claim 56 requires all the elements  
 6 of Claim 45 and, in addition, it has to have a target site  
 7 at the various locations indicated -- abdominal cavity,  
 8 thoracic cavity, et cetera. Once again, this device is to  
 9 be used for the resection of bladder and prostate tissue,  
 10 and, therefore, satisfies that element.  
 11 Q. Thank you, sir.  
 12 Do you have an opinion as to whether Claim 56  
 13 of the '536 patent is anticipated by the Roos '198 patent?  
 14 A. Yes, I do, and it is.  
 15 Q. I believe you also considered the Doss '007 in  
 16 connection with the '536 patent; is that correct?  
 17 A. That's correct.  
 18 Q. Can you turn to DTX-17 in your book, please, and  
 19 identify that?  
 20 A. DTX-17 is a patent, the Doss '007 patent.  
 21 MR. MARSDEN: We move the admission of DTX-17,  
 22 please.  
 23 MR. BOBROW: No objection.  
 24 THE COURT: Thank you.  
 25 THE DEPUTY CLERK: So marked.

1 through 31. Therefore, that element is satisfied.  
 2 Next.  
 3 The next element is an electrode terminal  
 4 disposed near the distal end. And this is the active  
 5 electrode or electrical terminal. It's described by the  
 6 text indicated there and is shown in the red there. So  
 7 that element is satisfied.  
 8 Also, requires a connector connecting the  
 9 electrode terminal to the electrosurgical power supply.  
 10 The text indicated in Column 3, Lines 30 through 34,  
 11 indicates that that is the case. So that element is  
 12 satisfied.  
 13 Next.  
 14 Requires a return electrode electrically  
 15 coupled to the electrosurgical power supply. This diagram  
 16 shows the return electrode indicated highlighted in yellow.  
 17 And it's specifically referenced in the text in Column 5,  
 18 Lines 27 through 31. Therefore, that element is satisfied.  
 19 Next.  
 20 The last element is an electrically conducting  
 21 fluid supply for generating a current flow path between the  
 22 return electrode and the electrode terminal.  
 23 The blue indicates the flow of saline solution  
 24 into the device. The text reference is here, Column 3,  
 25 Lines 48 through 54. So that element is satisfied.

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1 \*\*\* (Defendant's Exhibit No. 17 was received into  
 2 evidence.).  
 3 BY MR. MARSDEN:  
 4 Q. Dr. Taylor, had you prepared a graphic to describe  
 5 what the Doss '007 is about?  
 6 A. Yes, I have. Thank you, Gary.  
 7 The Doss '007 patent is a bipolar  
 8 electrosurgical probe which includes an integrated supply  
 9 of saline for the treatment of corneal tissue.  
 10 Q. Have you done an element-by-element comparison of  
 11 the teachings of the Doss '007 patent to the claims of  
 12 the '536 patent?  
 13 A. Yes I have.  
 14 Q. Have you prepared slides to illustrate your opinions?  
 15 A. Yes, I have. And, once again, looking at the claims  
 16 of the patent, Claim 45 requires as one of the elements a  
 17 high-frequency power supply. Column 3, Lines 29 to 38,  
 18 specifically mentions a high-frequency power supply.  
 19 Q. So that is element satisfied?  
 20 A. That element is satisfied, sir.  
 21 Moving to the next overhead, this element  
 22 requires an electrosurgical probe, having a shaft having  
 23 a proximal end and distal end. As you can see, there  
 24 is a shaft, there is a distal and a proximal end. And  
 25 that is described by the text, Column 5, Lines 27 to

1 Q. Before you leave this, so the record is clear, was  
 2 this coloring in the original figures?  
 3 A. No, it was not. It was coloring that was added by  
 4 me.  
 5 Q. Was that to illustrate?  
 6 A. That was basically to illustrate -- we tried to be  
 7 consistent, so blue is water. I guess blue looks like  
 8 water; right? So that's what we used here.  
 9 Q. Do you have an opinion, then, as to whether Claim 45  
 10 of the '536 patent is anticipated by the Doss '007 patent?  
 11 A. Yes, I do. And it is.  
 12 Q. Did you consider the Doss reference in connection  
 13 with any other claims of the '536 patent?  
 14 A. Yes, and the next overhead shows that.  
 15 Basically, Claim 46, as I indicated before,  
 16 requires that you have all the elements of Claim 45 and  
 17 also that the return electrode forms a portion of the  
 18 shaft of the electrosurgical probe. And that is indicated  
 19 in Column 5, Lines 27 through 31. So that element is  
 20 satisfied.  
 21 Q. Do you have an opinion as to whether Claim 46 of  
 22 the '536 patent is anticipated by the Doss '007 patent?  
 23 A. Yes, I do. And it is.  
 24 Q. And did you look at any other claims of the '536?  
 25 A. Yes. The next overhead shows Claim 47 which, once

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1 again, requires that all the elements of Claim 46 and all  
 2 the elements of Claim 45 are also satisfied. And further  
 3 that you have an insulating member circumscribing the  
 4 return electrode, and that insulating member is the housing  
 5 here which is shown in blew.  
 6 Q. We just violating our color-coding?  
 7 A. Yes, we did. I'm wrong. Sorry.  
 8 I think the next one, next overhead shows the  
 9 return electrode once again in yellow. And so the elements  
 10 of this claim are also satisfied.  
 11 Q. Do you have an opinion as to whether Claim 47 of  
 12 the '536 patent is anticipated by the Doss '007 patent?  
 13 A. Yes, I do. And it is.  
 14 Q. Did you look at any other claims of the '536?  
 15 A. Yes, I did.  
 16 And the next overhead. Oops.  
 17 Q. Actually, maybe that is it on Doss.  
 18 A. That may be it on Doss. I'm sorry.  
 19 Q. Sorry. Okay. You mentioned also the Paul (phonetic)  
 20 or Pao '449 patent. Did you consider that in your  
 21 analysis of the '536 patent?  
 22 A. Yes, I did.  
 23 Q. Can you turn to -- find the right exhibit number.  
 24 I'm ahead of myself.  
 25 A. I think it's DTX-21.

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1 Q. Yes. DTX-21 in your notebook. Can you identify  
 2 that, please?  
 3 A. Yes. This is the Pao '449 patent.  
 4 MR. MARSDEN: Move the admission of DTX-21,  
 5 your Honor.  
 6 MR. BOBROW: No objection.  
 7 THE COURT: Thank you.  
 8 \*\*\* (Defendant's Exhibit No. 21 was received into  
 9 evidence.)  
 10 BY MR. MARSDEN:  
 11 Q. Have you prepared a summary slide? Can you describe  
 12 to the jury the Pao '449 patent?  
 13 A. Yes. The Pao '499 patent describes a bipolar  
 14 electrosurgical probe with an integrated saline supply  
 15 for the treatment of eyes, ears, noses and other  
 16 microsurgical applications.  
 17 Q. Have you prepared or did you conduct an element-by-  
 18 element comparison of the teachings of the Pao '499 patent  
 19 with the claims of the '536 patent?  
 20 A. Yes, I have.  
 21 Q. Did you prepare slides to illustrate that?  
 22 A. Yes, the next one starts off the sequence. Once  
 23 again, the high-frequency power supply is referenced in  
 24 the Pao patent in Columns 7, Lines 35/36, basically  
 25 saying connected to the output of a high-frequency

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1 bipolar power supply. So that element is anticipated r  
 2 satisfied. Sorry.  
 3 The next element is electrosurgical probe  
 4 comprising a shaft having a proximal end and a distal  
 5 end. This is the distal end. I guess you consider the  
 6 handle to be the proximal end and that specifically  
 7 references in Column 7, Lines 6 to 9 and 13 to 30. So  
 8 that element is satisfied.  
 9 The next element is an electrode terminal  
 10 disposed near the distal end. That is the active  
 11 electrode shown in red here and described in the text in  
 12 Column 7, Lines 15 to 19. So that element is satisfied.  
 13 Next element is a connector near the proximal  
 14 end of the shaft. Connector is shown in green here.  
 15 Those little two pins. Referred to in the text, Column  
 16 7, Lines 13 to 19. And that is satisfied.  
 17 Next.  
 18 The return electrode is shown in yellow. It's  
 19 the outer electrode. And the text reference is Column 7,  
 20 Lines 13 to 19 and 25 to 37. So that element is satisfied.  
 21 And, lastly, an electrically conducting fluid  
 22 supply. The fluid supply comes in through this connector  
 23 and flows down the lumen of the inner electrode of the  
 24 active electrode, that is described in this text reference.  
 25 So that element is satisfied.

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1 Q. Is that also described in the text as an electrolytic  
 2 irrigating fluid such as saline?  
 3 A. Yes, it is.  
 4 Q. Do you then have an opinion as to whether Claim 45  
 5 of the '536 patent is anticipated by the Pao '499 patent?  
 6 A. Yes, I have an opinion. And it is anticipated.  
 7 Q. Did you compare the Pao '499 patent teachings to any  
 8 claims of the '536 patent?  
 9 A. Yes, I did. Next slide, please.  
 10 Claim 46 requires all the elements of Claim 45  
 11 along with return electrode forms a portion of the shaft.  
 12 And, as I previously indicated, that is the case of the  
 13 return electrode, as shown here in yellow.  
 14 Q. So did you have an opinion as to whether Claim 46  
 15 of the '536 patent is anticipated by the Pao '499 patent?  
 16 A. Yes, I have. And it is.  
 17 Q. Did you consider any other claims?  
 18 A. Yes.  
 19 Next overhead, please.  
 20 Claim 56 requires the elements of Claim 45,  
 21 along with one of the body parts indicated in the list  
 22 here, and this particular patent specifically mentions  
 23 nasal passages and ear canals. So that element is  
 24 satisfied.  
 25 Q. So do you have an opinion as to whether Claim 56 of

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1 the '536 patent is anticipated by the Pao '499 patent?  
 2 A. Yes, I do. And it is.  
 3 Q. I think that concludes our discussion of the '536  
 4 patent.  
 5 A. I believe so.  
 6 Q. Okay. Can we turn now --  
 7 A. I think we've done pretty well.  
 8 Q. We'll turn now to the '882 patent. And did you  
 9 prepare a board for the '882 patent?  
 10 A. Yes, I did.  
 11 Q. This is the compilation of multi-electrode patent?  
 12 A. Yes.  
 13 Q. First, with reference to the board, can you remind  
 14 the jury which claims you analyzed for the '882 patent?  
 15 A. Well, the asserted claims are Claims 13, 17 and 54,  
 16 but they require that you further analyze or consider  
 17 first Claim 1. So I basically considered four claims.  
 18 Q. Do you have any opinion as to whether the asserted  
 19 claims of the '882 patent are invalid?  
 20 A. Yes, I do.  
 21 Q. What is that opinion?  
 22 A. That opinion is they're invalid.  
 23 Q. What is the basis for your opinion?  
 24 A. My basis for the opinion is there are two  
 25 references, the Slager article and the Manwaring '138

1 electrode in close proximity to the target site in the  
 2 presence of an electrically conducting fluid.  
 3 Electrically conducting fluid is here, the tissue is here.  
 4 The active electrode has been positioned close to the  
 5 target site and the last step is applying a high-frequency  
 6 voltage between the electrode terminal and the return  
 7 electrode in such a manner you vaporize the fluid and  
 8 that you induce a spark, discharge of energy to the  
 9 target site. And that is indicated here by the cross-  
 10 hatched yellow. So all the elements of this have been  
 11 satisfied.  
 12 Q. Did you also hear Dr. Manwaring's testimony about  
 13 this element when he was here testifying earlier this  
 14 week?  
 15 A. Yes, I did.  
 16 Q. Does that support your conclusion?  
 17 A. Yes, it does.  
 18 Q. Do you have an opinion of whether Claim 1 of the  
 19 '882 patent is anticipated by the Manwaring '138 patent?  
 20 A. Yes, my opinion is that it is.  
 21 Q. You also mentioned I think that this is a monopolar  
 22 device?  
 23 A. Right.  
 24 Q. Were you here when Mr. Eggers testified about this  
 25 claim?

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1 patent, that anticipates those claims.  
 2 Q. Were you here earlier this week when Dr. Manwaring  
 3 testified?  
 4 A. Yes.  
 5 Q. Did you hear Dr. Manwaring's testimony that the '138  
 6 patent discloses all the limitations of Claims 1, 13, and  
 7 54 of the '882 patent?  
 8 A. Yes, I did.  
 9 Q. Do you agree with his analysis?  
 10 A. Yes, I do.  
 11 Q. Have you made your own element-by-element analysis?  
 12 A. Yes, I have.  
 13 Q. Have you prepared slides to illustrate that?  
 14 A. Yes. And, Gary, the next sequence.  
 15 Here we have what we call a rainbow slide, and  
 16 it basically shows, this is the method patent. I hope  
 17 everyone realizes this is a method patent. It basically  
 18 outlines the steps required to perform the method, and  
 19 the first step is providing an electrode terminal, which  
 20 is shown here in red, and a return electrode electrically  
 21 coupled to a high-frequency voltage source. Dr. Manwaring  
 22 specifically mentioned in his testimony that the return  
 23 electrode is on the outside of the patient. This is  
 24 monopolar electrosurgery. So that is step number one.  
 25 Step number two is positioning the active

1 A. Yes.  
 2 Q. And did you hear his testimony that this claim would  
 3 cover a monopolar device?  
 4 A. Yes.  
 5 Q. Did you consider the Manwaring '138 patent in  
 6 connection with any other claims of the '882 patent?  
 7 A. Yes. Can we go to the next slide?  
 8 Claim 13 requires that you practice the steps  
 9 of Claim 1, but also that a portion of the energy is  
 10 induced basically in the form of protons.  
 11 Dr. Manwaring basically mentioned that when you  
 12 have RF sparking, which is actually referenced in the text  
 13 in Column 6, Lines 50 to 63, that you generate protons as  
 14 well as other photons.  
 15 Q. Do you have an opinion as to whether Claim 13 of the  
 16 '882 patent is anticipated by the Manwaring '138 patent?  
 17 A. Yes, I do and it is.  
 18 Q. Did you consider any other claims of the '882 patent?  
 19 A. Yes. Next, please.  
 20 Claim 54 requires method of claims, Claim 1,  
 21 and further basically suctioning fluid from the target site  
 22 or having a suction lumen to be able to do that.  
 23 The text in the patent Column 7, Lines 26 to  
 24 31, indicates that there is an embodiment of his invention  
 25 that does that.

1 MR. MARSDEN: I'm sorry. Could you all see  
2 that, the bottom of the slide?  
3 JUROR NO. 4: Yes.  
4 BY MR. MARSDEN:  
5 Q. Is that here in the text?  
6 A. Yes.  
7 Q. Do you have an opinion as to whether Claim 54 of the  
8 '882 patent is anticipated by the Manwaring '138 patent?  
9 A. Yes, I do and it is.  
10 Q. I think you indicated you also considered another  
11 reference in connection with the '882 patent; is that  
12 correct?  
13 A. That's right. Excuse me. That's correct.  
14 Q. Could you first turn to DTX-65 in your notebook and  
15 identify that, please?  
16 A. DTX-65 is an article written by Slager regarding  
17 vaporization of tissue by spark.  
18 MR. MARSDEN: Move the admission of DTX-65.  
19 MR. BOBROW: No objection.  
20 THE COURT: Thank you.  
21 THE DEPUTY CLERK: So marked.  
22 \*\*\* (Defendant's Exhibit No. 65 was received into  
23 evidence.)  
24 BY MR. MARSDEN:  
25 Q. Have you prepared a summary slide to described what

1 electrode with that surface area, immersed in saline. So  
2 that element is satisfied.  
3 The next element is applying high-frequency  
4 voltage to vaporize the fluid and to induce the discharge  
5 of energy and sparking. And that is very aptly described  
6 in this particular diagram. We have the electrode, we have  
7 steam, we have spark, we've got tissue. So that element is  
8 satisfied.  
9 BY MR. MARSDEN:  
10 Q. I'm sorry. Before you leave that slide, do you have  
11 an opinion as to whether Claim 1 of the '882 patent is  
12 anticipated by the Slager article?  
13 A. Yes, I do. And it is.  
14 Gary, the next slide. Sorry.  
15 The next claim is Claim 13. This claim  
16 requires practice, method of Claim 1 and also, you have  
17 protons. And, as I described in the prior reference,  
18 sparks generate protons and this article specifically  
19 mentions sparks jumping. I should say sparks in aqueous  
20 solution, making protons.  
21 Q. Do you have an opinion, then, as to whether Claim 13  
22 of the '882 patent is anticipated by the Slager article?  
23 A. Yes, I do. And it is.  
24 Q. Did you consider any other claims of the '882 patent?  
25 A. Yes. Next.

1 the Slager article teaches?  
2 A. Yes, I have.  
3 Q. Gary is improvising here for us.  
4 A. Okay. Basically, this article describes an  
5 electrosurgical probe for vaporizing arterial tissue.  
6 Q. Have you performed an element -- thank you, Gary.  
7 Have you performed an element-by-element  
8 analysis of the teachings of the Slager -- comparing the  
9 teachings of the Slager article to the claims of the '882  
10 patent?  
11 A. Yes, I have.  
12 Q. Have you prepared some slides to illustrate your  
13 opinions?  
14 A. Yes, I have.  
15 MR. MARSDEN: Give Gary a second here.  
16 THE WITNESS: Okay. Once again, the very  
17 steps for performing this, this method were outlined on  
18 the left and the first step is providing an electrode  
19 terminal, shown here, coupled to a generator. And that  
20 is shown by the diagram as well as the text here. So this  
21 element or step is satisfied.  
22 Next one is positioning the electrode terminal  
23 in close proximity to the target site in the presence of  
24 an electrically conducting fluid. That is described in  
25 the article at Pages 1383 and 1384. Basically, the spark

1 Claim 17 requires practicing the method of  
2 Claim 1, additionally having at least 200 volts, high-  
3 frequency voltage. The reference on Page 1383  
4 specifically mentions 1200 volts at that frequency. So  
5 that element is satisfied.  
6 Q. Do you have an opinion as whether Claim 17 of the  
7 '882 patent is anticipated by the Slager article?  
8 A. Yes, I do. And it is.  
9 Q. Did you consider any other claims of the '882 patent?  
10 A. Yes. Next.  
11 Claim 54 requires the method of Claim 1 as  
12 well as basically having the ability to suction at the  
13 target site. And the reference in page 1386 specifically  
14 mentions being able to suction the gas bubbles. So that  
15 element is satisfied.  
16 Q. Thank you. Dr. Taylor, do you have an opinion as  
17 to whether Claim 54 of the '882 patent is anticipated by  
18 the Slager article?  
19 A. Yes, I do. And it is.  
20 Q. Did you hear any testimony here at trial, during  
21 trial, that supports or confirms your opinions of  
22 anticipation of the claims of the '882 patent?  
23 A. Yes.  
24 Q. Did you see DTX-600, the manual of operations for  
25 System 970 during this trial?

1 A. Oh, yes. It's not here, is it?

2 Q. I think we can call it up for you.

3 MR. MARSDEN: Gary, can you call up DTX-600  
4 please?

5 MR. BOBROW: Your Honor, before we get into  
6 this, I believe this is beyond the scope. I don't believe  
7 there is any opinion that this witness has offered in his  
8 expert report about the relationship between claims and  
9 the 970 operator's manual.

10 MR. MARSDEN: Your Honor, his expert report  
11 referred to the 510-K which included the manual and, of  
12 course, also reserved the right to address any evidence  
13 as it came up at trial. But he expressly referred to the  
14 510-K in his expert report and the 510-K has included, as  
15 part of the submission, this manual.

16 THE COURT: Well, I guess the point is if the  
17 analysis he intend to give today wasn't included in his  
18 report, it doesn't come in today.

19 MR. MARSDEN: Your Honor, I believe it is. I  
20 can hand up his report.

21 (Documents passed forward.)

22 MR. BOBROW: What page?

23 MS. MacFERRIN: Page 11.

24 MR. BOBROW: Your Honor, there is a reference  
25 there to the 970, but this is the question of enablement.

1 It has nothing to do with the question of anticipation.  
2 Right now, what the witness is trying to do is show that  
3 this is in some way anticipated, not on a question of  
4 enablement. I believe it's clearly beyond the scope.

5 MR. MARSDEN: We will be relying on it for  
6 both issues and we will be address the nonenablement issue  
7 next.

8 THE COURT: I don't see that it's -- I don't  
9 see in the report if it's limited to enablement. So I'll  
10 allow the testimony.

11 MR. MARSDEN: Thank you, your Honor.  
12 Gary, could you pull up Page 14, please?

13 ---  
14  
15  
16  
17  
18  
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21  
22  
23  
24  
25

1

2 BY MR. MARSDEN:

3 Q. Were you in court when I asked Mr. Baker about this  
4 description of the principle of operation of the System  
5 970?

6 A. Yes, I was.

7 MR. MARSDEN: If you could blow up the first  
8 paragraph, please, Gary...

9 BY MR. MARSDEN:

10 Q. Do you have any opinion as to whether ArthroCare's  
11 description of the mode of operation or the principle of  
12 operation of its System 970 is consistent with the  
13 opinion that you have offered here in court in this  
14 morning?

15 A. Yes. Essentially, the opinion that I have, I think  
16 what is confirmed here in the text, is that the system  
17 operates in the same manner as a conventional  
18 electrosurgical system, use of arcing and such, that is  
19 described by what is known as prior art, stuff that has  
20 been known for a long time.

21 Q. Thank you, Dr. Taylor. Do you have any other  
22 opinions regarding the validity of the '882 other than  
23 anticipation, which we have discussed?

24 A. When you say other opinions, could you be more  
25 specific?

1 Q. Right. Do you have any other basis for believing  
2 that the Claims of the '882 patent are invalid?

3 A. I am sorry, I am blanking on this.

4 Q. Sure.

5 A. When you say other opinions, do you mean other facts?

6 Q. Do you understand that ArthroCare contends that what  
7 is taught in the '882 patent is a new phenomenon?

8 A. I see what you mean. No, it is not a new phenomenon.  
9 It's been anticipated, it's been described in the prior  
10 art.

11 Q. If, in fact, it is a new phenomenon, do you believe  
12 there is an additional basis for the '882 patent to be  
13 found invalid?

14 A. Yes. One of the concerns I have -- I think I  
15 expressed this yesterday -- is that if the '882 patent is  
16 found to be invalid, then a large number of the devices  
17 that I have developed and, for that matter, a large number  
18 of the devices that have been developed in electrosurgery  
19 will infringe, because of the fact that what they are  
20 claiming is extremely broad.

21 Q. Does the '882 patent teach anything about how to  
22 achieve a new phenomenon that is different than the  
23 principle of operation of conventional electrosurgical  
24 devices?

25 A. No, it doesn't. I was perplexed and, frankly, am

1 still perplexed about the overall phenomenon of Coblation.

2 Q. And is that defense also sometimes called  
3 nonenablement?

4 A. Yes, it is.

5 Q. Do you have an opinion as to whether the claims of  
6 the '882 patent are enabled to the extent it claims a new  
7 phenomenon?

8 A. Yes, I have an opinion.

9 Q. What is that opinion?

10 A. That it is not.

11 Q. Thank you.

12 Let's turn, then, to the '592 patent, the last  
13 of the three patents.

14 Can you first locate the '592 patent in your  
15 binder?

16 I misspoke. I got ahead of myself. Have you  
17 prepared a board for the '592 patent?

18 A. Yes, I have.

19 Q. And first, can you remind the jury what claims are  
20 at issue in connection with the '592 patent?

21 A. Yes. There are actually two sets of claims. The  
22 first set is shown on the board. It's on the easel. The  
23 second set Katie is holding. The first set, the  
24 independent claim is Claim 1 and the dependent claims are  
25 3, 4, 11 and 21. The second set of claims, the independent

1 element is satisfied.

2 As I mentioned, it has to be done in the  
3 presence of electrically conductive fluid. And the inlet  
4 for that fluid is shown here. The fluid path is shown in  
5 the blue. So that element is satisfied.

6 The next element or next step is positioning  
7 a return electrode such that a return electrode is not in  
8 contact with the body structure, and generate a current  
9 flow path between the active electrode and electrode  
10 terminal and the return electrode. The return electrode  
11 is shown here in the yellow, as you can see, the eye is  
12 down here. It is not in contact with the eye. That is  
13 described in the text, in Column 5, Lines 27 to 31, and  
14 also Column 3.

15 Q. You see a series of these illustrations. Can you  
16 tell us what the relationship is of Figure 7 and Figure 8  
17 is?

18 A. Sure. Figure 7 is a side view, sort of a  
19 cross-sectional side-view, of the device. And you see  
20 here the active electrode, the return electrode, fluid  
21 inlet path -- actually, the fluid inlet path goes this way  
22 and comes out that way. And then Figure 8 is an end view,  
23 if you will, of the probe, and it shows, you go from  
24 outside to in. The housing, insulation, lumen, return  
25 electrode, insulation, active electrode, and then the

1 claim is Claim 23. The dependent claims are 26, 27, 32  
2 and 42.

3 Q. Let's start with the first set of claims first.  
4 Have you performed any analysis or reached any conclusions  
5 as to whether those claims are valid?

6 A. Yes, I have.

7 Q. What is your opinion?

8 A. My opinion is they are not.

9 Q. Why not?

10 A. They are anticipated in this first set of claims by  
11 Doss '007, and as indicated there.

12 Q. Have you prepared a series of -- first of all, have  
13 you done an element-by-element comparison of the teachings  
14 of the Doss '007 patent to the asserted claims we have up  
15 on the board of the '592 patent?

16 A. Yes, I have.

17 Q. Have you prepared some slides to illustrate that?

18 A. Yes.

19 Gary.

20 This particular patent, Claim 1, also has three  
21 steps. The first step is positioning an electrode terminal  
22 into at least close proximity with the target site. The  
23 Doss '007 patent, the active electrode is shown in the red  
24 here, described in the text there. This has to be done in  
25 the presence of electrically conductive fluid. So that

1 lumen for that.

2 Q. Thank you. Can you proceed, please?

3 So moving on, that step of the method is  
4 satisfied.

5 Lastly, you have to apply a high-frequency  
6 voltage to the electrode terminal between the electrode  
7 terminal and return electrode to generate a current flow  
8 path. And that is specifically mentioned in Column 3 and  
9 Column 5. That basically describes that reference. So  
10 that element is satisfied.

11 Q. Do you have an opinion, then, as to whether Claim 1  
12 of the '592 patent is anticipated by the teachings of the  
13 Doss '007 patent?

14 A. Yes, I do. And it is.

15 Q. Did you compare the Doss '007 patent to any other  
16 claims?

17 A. Yes.

18 Next.

19 Claim 3 requires the method of Claim 1, and  
20 additionally, immersing the target site within a volume  
21 of electrically conductive fluid.

22 As I mentioned, the fluid flow path is here.  
23 Basically, there is a dam that prevents the fluid from  
24 leaking out past the cornea.

25 The cornea is immersed in electrically



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Page 1331

1 conductive fluid. And that is satisfied.

2 Q. Do you have an opinion as to whether Claim 3 of the  
3 '592 patent suspect anticipated by the teachings of the  
4 Doss '007 patent?

5 A. Yes, I do. And it is.

6 Q. Did you look at other claims?

7 A. Next, Gary.

8 The next claim is Claim 4, which requires the  
9 method of Claim 1, and additionally delivering electrically  
10 conductive fluid to the target site. I think I have already  
11 described that that is satisfied.

12 Q. Do you have an opinion as to whether Claim 4 of the  
13 '592 patent is anticipated by the Doss '007 patent?

14 A. Yes, it is.

15 Q. Did you look at other claims?

16 A. Next. Claim 11 requires the method of Claim 1.

17 Additionally, that the electrically conductive fluid be  
18 isotonic saline. There is a reference in the text, Column  
19 3, Lines 65 and 66, that basically says the fluid should  
20 be preferably isotonic saline.

21 Q. Do you have an opinion as to whether Claim 11 of  
22 the '592 is anticipated by the Doss '007 patent?

23 A. Yes, I do. And it is.

24 Q. Did you look at any other claims of the '592 patent  
25 in connection with Doss?

1 Q. Did you do an element-by-element comparison of the  
2 teachings of the Slager article to the additional asserted  
3 claims of the '592 patent?

4 A. Yes, I did.

5 Q. Did you prepare some slides to show that?

6 A. Yes. As I mentioned before, the dependent claims,  
7 26, 27, 32 and 42 are dependent on Claim 23. So I  
8 started with Claim 23. And Claim 23 requires contacting,  
9 as its first step, contacting an active electrode with  
10 the body structure in the presence of electrically  
11 conductive fluid. That is shown here in the diagram.  
12 It's on Page 1383 of the article.

13 Next.

14 Q. Is that element satisfied?

15 A. Yes. I am sorry. That element was satisfied.  
16 Actually, it gets satisfied here.

17 Part of the remainder of that element is in  
18 the presence of electrically conductive fluid. On Page  
19 1383 the article mentions it's immersed in saline solution.  
20 The rest is the return electrode away from the body  
21 structure in the presence of electrically conductive  
22 fluid. The article specifically mentions that the  
23 electrode is immersed in saline solution. So that element  
24 is satisfied.

25 Next. Maybe you can highlight the last

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1 A. Yes.

2 Next.

3 That is Claim 21, which requires the method of  
4 Claim 1 and additionally that the voltage be in the range  
5 of 500 to 1400 volts peak to peak.

6 And Column 3, Lines 34 to 38, specifically  
7 mention voltage of 20 to 200 volts RMS. The conversion  
8 factor on a waveform for both RMS and peak to peak is  
9 2.83. When you do the arithmetic, it's 560 volts max.  
10 So that claim is satisfied.

11 Q. Do you have an opinion as to whether Claim 21 of  
12 the '592 patent is anticipated by the Doss '007 patent?

13 A. Yes, I do. And it is.

14 Q. Are we done with this board?

15 A. I think we are done with this set of claims, yes.

16 Q. We will move to the last board, please.

17 Did you perform an analysis of whether the  
18 additional claims, asserted claims of the '592 patent,  
19 are valid?

20 A. Yes, I have.

21 Q. What is your conclusion?

22 A. My conclusion is they are not.

23 Q. Why not?

24 A. Based on the prior art of the Slager article, they  
25 are not. They are anticipated.

1 paragraph there on the left-hand side. Regardless, the  
2 next step is applying a high-frequency voltage between the  
3 active electrode and the return electrode such that the  
4 electrical current flows from the active to the return  
5 electrode, using the electrically conductive path. That  
6 is shown here diagrammatically with the electrode and the  
7 steam layer and so forth.

8 So that element is satisfied.

9 Q. Do you have an opinion as to whether Claim 23 of the  
10 '592 is anticipated by the teachings of the Slager article?

11 A. Yes, I do. And it is.

12 Q. Let's move on. Did you consider additional claims  
13 that are dependent on Claim 23?

14 A. Yes. And if we go to Claim 26, and this claim  
15 requires the method of Claim 23 and, in addition, immersing  
16 the target site within a volume of electrically conductive  
17 fluid, so forth and so on, it is indicated on the left-  
18 hand side. The article describes on Page 1383 that the  
19 aortic segment and return electrode were immersed in  
20 saline solution, and sparking occurred. So that element  
21 is satisfied.

22 Q. Do you have an opinion as to whether Claim 26 of the  
23 '592 patent is anticipated by the teachings of the Slager  
24 article?

25 A. Yes, I do, and it is.

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1 Q. Can you continue?

2 A. The next claim is Claim 27. Claim 27 requires the  
3 method of Claim 23. Additionally, delivering the  
4 electrically conductive fluid to the target site. And  
5 that had to happen, as referenced on Page 1383 of the  
6 article.

7 Q. Do you have an opinion as to whether Claim 27 of the  
8 '592 is anticipated by the teachings of the Slager article?

9 A. Yes, I do. And it is.

10 Q. Did you consider other claims?

11 A. Yes. Claim 32 requires the method of Claim 23 and,  
12 additionally, that the electrically conductive fluid  
13 consists of isotonic saline. The article specifically  
14 references on Page 1383 return electrode immersed in  
15 saline, 0.9 percent. That is the definition of isotonic  
16 saline.

17 Q. Do you have an opinion as to whether Claim 32 of the  
18 '592 is anticipated by the Slager article?

19 A. Yes, I do. And it is.

20 Q. And did you consider Claim 42 of the '592 patent?

21 A. Yes, I did. Claim 42 requires the method of Claim  
22 23, wherein the voltage is in the range of 500 to 1400  
23 volts peak to peak. And at Page 1383 of the Slager  
24 article, they specifically mention that the voltage is  
25 1200 volts peak to peak. So that is satisfied.

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1 Q. Thank you, Dr. Taylor.

2 So do you have an opinion as to whether Claim  
3 42 of the '592 patent is anticipated by the Slager article?

4 A. Yes, I do. And it is.

5 MR. MARSDEN: Thank you very much, Dr. Taylor.  
6 I have no further questions.

7 THE COURT: All right. Why don't we take a  
8 15-minute break before we go into cross-examination?

9 (At this point the jury then left the  
10 courtroom.)

11 (Short recess taken.)  
12 ---  
13  
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22  
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25

1

2 (Court resumed after the recess, and the  
3 following occurred without the presence of the jury.)  
4

5 THE COURT: Let's bring the jury in.

6 MR. MARSDEN: Your Honor, while we are waiting  
7 for the jury, we have made a request to the other side,  
8 but we will make it directly to the Court. Now that these  
9 prior-art references have been admitted, there are only  
10 six of them, they are about a quarter of an inch, we would  
11 like permission to add them to the jurors' binders so they  
12 have the patents and the six references.

13 THE COURT: No, I don't think we will do that.  
14 Thank you. They will have them in the jury room.

15 MR. MARSDEN: I thought for the convenience,  
16 and the jury understanding they weren't there. There is  
17 no argument.

18 THE COURT: I have never done that.

19 MR. HEBERT: Your Honor, if we have another  
20 minute...

21 There is an issue with Mr. Raffle's testimony,  
22 which will be the next witness.

23 THE COURT: I don't think we do.

24 MR. HEBERT: Okay.

25 THE COURT: The jurors' lunches are here, so

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1 we can take an early lunch and discuss Mr. Raffle as soon  
2 as this witness is done.

3 MR. HEBERT: I think it is only a two-minute  
4 issue, your Honor.

5 (At this point the jury entered the courtroom  
6 and took their seats in the box.)

7 THE COURT: All right. Mr. Bobrow.

8 MR. BOBROW: Thank you, your Honor. Good  
9 morning, ladies and gentlemen.

10 CROSS-EXAMINATION

11 BY MR. BOBROW:

12 Q. Good morning, Dr. Taylor.

13 A. Good morning.

14 Q. Let me ask you, first of all, a couple of questions  
15 about the re-examination of the '536 patent. You are  
16 aware that the '536 patent is in re-examination right now; is  
17 that right?

18 A. Yes.

19 Q. And you are aware that the Patent Office has issued  
20 a notice of intent to issue a re-examination certificate.  
21 Is that true?

22 A. Yes.

23 Q. And you are aware, are you not, that in connection  
24 with that re-examination proceeding, that the Patent Office  
25 considered the Roos '198 patent?

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1 A. Yes.  
 2 Q. And you read in the file wrapper for the  
 3 re-examination proceeding that there was a board that was  
 4 convened, that three examiners looked at the Roos '198  
 5 patent; correct?  
 6 A. Yes.  
 7 Q. And notwithstanding that, the Patent Office issued  
 8 a notice of intent to issue a re-examination certificate,  
 9 confirming the patentability of the '536 patent over the  
 10 Roos '198 patent; is that right?  
 11 A. I am aware of the notice of intent to issue -- what  
 12 did you call it again?  
 13 Q. A re-examination certificate?  
 14 A. A re-examination certificate. I also understand --  
 15 and you can correct me if I am wrong -- it's not over  
 16 until it's over. And the certificate hasn't been issued  
 17 yet.  
 18 Q. The certificate has not been issued yet. But you  
 19 are aware that the Patent Office wrote in an office action  
 20 that the claims of the '536 are patentable over the Roos  
 21 '198 patent, and that that was an office action that was --  
 22 was the result of a board of three examiners that had  
 23 convened to look at the issue; correct?  
 24 A. I am aware of that.  
 25 MR. BOBROW: May I approach, your Honor?

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1 THE COURT: Yes, you may.  
 2 BY MR. BOBROW:  
 3 Q. I have handed you PX-7. And PX-7 is the file  
 4 history for the re-examination of the '536 patent. You  
 5 have looked at at least portions of PX-7 before, have you  
 6 not?  
 7 A. I have looked at the file history of '536, which is  
 8 this document. Is that what you are saying?  
 9 Q. You have looked at the file history for the  
 10 re-examination of the '536?  
 11 A. Some parts of the file history of the '536 patent.  
 12 Q. Including parts of the re-examination; is that right?  
 13 A. Including parts of the re-examination, yes.  
 14 Q. And you considered that information in connection  
 15 with forming your opinions and giving your testimony;  
 16 correct?  
 17 A. I did.  
 18 MR. BOBROW: Your Honor, at this time I move  
 19 PX-7 into evidence.  
 20 MR. MARSDEN: No objection, your Honor.  
 21 \*\*\* (Plaintiff's Exhibit No. 7 was received into  
 22 evidence.)  
 23 BY MR. BOBROW:  
 24 Q. Now, I would like to shift gears a little bit. I  
 25 wanted to ask you some questions about electrically

1 conducting fluids. All right?  
 2 A. Yes.  
 3 Q. Now, one fluid that is an electrically conducting  
 4 fluid is saline; correct?  
 5 A. Yes.  
 6 Q. And another one is Ringer's lactate; correct?  
 7 A. Or lactate of Ringer's, yes.  
 8 Q. Now, there are also fluids that are used in  
 9 electrosurgery that are electrically nonconducting fluids;  
 10 correct?  
 11 A. Yes.  
 12 Q. And glycine is one of those electrically  
 13 nonconducting fluids; correct?  
 14 A. Yes.  
 15 Q. And although glycine is called an electrically  
 16 nonconducting fluid, it nonetheless does conduct  
 17 electricity, does it not?  
 18 A. Yes.  
 19 Q. And, in fact, glycine is a fluid that is commonly  
 20 used in a procedure that you called a T-U-R-P procedure;  
 21 correct?  
 22 A. It's commonly used. It's not the only fluid. But,  
 23 yes, yes, it's commonly used.  
 24 Q. In fact, glycine conventionally has been used by  
 25 doctors for the T-U-R procedure in the prostate; right?

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1 A. Can you repeat the question again?  
 2 Q. Yes. I was saying that glycine conventionally has  
 3 been the fluid that doctors have used in performing a  
 4 TURP procedure, using electrosurgery?  
 5 A. Yes.  
 6 Q. Now, you had mentioned before that in using an  
 7 electrically nonconductive fluid like glycine it will  
 8 nonetheless conduct electricity when you put an  
 9 electrosurgical instrument into that glycine; right?  
 10 A. Yes.  
 11 Q. Now, you had said on direct examination, you had  
 12 mentioned a patent to reduce, the Roos '198 patent. Do  
 13 you recall that?  
 14 A. Yes.  
 15 Q. Now, the Roos '198 patent described a device or  
 16 devices that were to be used in TURP procedures; is that  
 17 right?  
 18 A. Yes. However, you have to keep in mind that when  
 19 you reference TURP procedures, the way it's most often  
 20 done is with a monopolar electrosurgical probe, and the  
 21 Roos patent is a bipolar electrosurgical probe, and it  
 22 does make a difference.  
 23 ---  
 24  
 25

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1  
2 Q. Well, the Roos patent doesn't just talk about bipolar  
3 probes, does it?  
4 A. But the configurations we were describing in my direct  
5 testimony were bipolar.  
6 Q. That wasn't the question I asked you.  
7 A. I just wanted to explain.  
8 Q. Fair enough. The Roos '198 patent also discusses  
9 monopolar uses for TRUP procedures; is that correct?  
10 A. Yes, it does. Sorry.  
11 MR. BOBROW: Why don't we put DTX-11 on the  
12 screen, please? DTX-11 is the '198 patent. And let's go  
13 to Column 1.  
14 BY MR. BOBROW:  
15 Q. DTX-11 is also in your binder if you care to look at  
16 it, but in Column 1 of the '198 patent, if you take a look  
17 at around Line 35 when it's discussing the background of  
18 the invention...  
19 A. This binder? I'm sorry. Okay. Yes. Column 1.  
20 Q. And if you take a look at Line 35, it references a  
21 neutral electrode applied externally to the patient's  
22 body.  
23 Do you see that?  
24 A. Yes.  
25 Q. And so by reference to a neutral electrode applied

1 electrically nonconductive fluid from the electrode to  
2 the metal parts of the electrode; right?  
3 A. Yes.  
4 Q. All right. Now, in describing in the rest of the  
5 patent, it describes some bipolar devices; correct?  
6 A. Yes.  
7 Q. And during your direct examination, you showed one  
8 of those devices; correct?  
9 A. Yes.  
10 Q. Now, in the '198 patent, the '198 patent never uses  
11 the word saline, does it?  
12 A. Couldn't find it, no, it does not.  
13 Q. It doesn't use the word Ringer's lactate or lactated  
14 Ringers, does it?  
15 A. It does not.  
16 Q. And in describing the fluid that is used with the  
17 bipolar embodiments, it uses, the phrase at Column 4, Line  
18 54 is calling it a washing liquid; right?  
19 A. Line 54, you said?  
20 Q. Yes, at Column 4.  
21 A. Okay. Yes, it does say washing liquid.  
22 Q. It doesn't call it saline, it doesn't call it  
23 lactated Ringer's; correct?  
24 A. No.  
25 Q. All right. In fact, wouldn't you agree with me that

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1 externally to the patient's body, here in this paragraph  
2 it's describing monopolar electrosurgery; correct?  
3 A. Yes.  
4 Q. And if you go down further to about Lines 52 through  
5 56, there is a discussion there about washing water.  
6 Do you see that? It's Line 54 refers to washing  
7 water.  
8 A. Yes.  
9 Q. Now, it mentions here that there is some current  
10 flows from the cutting loop via the washing water directly  
11 to the metal parts of the endoscope shaft located in the  
12 washing water flow and from there to the engaging tissue.  
13 Do you see that?  
14 A. Yes.  
15 Q. Now, given that this is a monopolar electrosurgical  
16 setup, you would agree with me, would you not, that the  
17 washing water that is being described here is either  
18 glycine or some other electrically nonconducting fluid;  
19 correct?  
20 A. Yes, it is.  
21 Q. You have no reason to think it's not, do you? That's  
22 how the monopolar procedures are done; correct?  
23 A. Glycine, Glanitol (phonetic), something that you  
24 would expect to be electrically nonconductive.  
25 Q. And it says there is some current flow in that

1 in this '198 patent to Roos, there is really no difference  
2 between the way that Mr. Roos talked about the washing  
3 liquid that was used in the monopolar case versus the  
4 bipolar case. He describes them as washing water or  
5 washing liquid; right?  
6 A. That's correct.  
7 Q. Now, if you would, please, take a look at Figure 5  
8 of the '198 patent.  
9 MR. BOBROW: If you can highlight that,  
10 Chris...  
11 BY MR. BOBROW:  
12 Q. And Figure 5 is a depiction of one of the bipolar  
13 probes that is described here in this Roos '198 patent;  
14 correct?  
15 A. Yes, it's one of the embodiments. Yes.  
16 Q. And as you look up there, you can see there is what  
17 he calls a neutral electrode 11 and also number 12 he  
18 calls the treatment electrode; right?  
19 A. That's correct.  
20 Q. Now, there is, what I'm circling there with this  
21 light pen is the return electrode; correct?  
22 A. And I also he calls it the neutral electrode in the  
23 patent, but, yes.  
24 Q. Now, if you take a look at Column 6 at Lines 51 to  
25 53 of the Roos '198 patent, he talks about the neutral

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1 electrode in this embodiment, doesn't he?  
 2 A. Hold on a second. I'm sorry. Which lines again?  
 3 Q. This is at Column 6, Lines 51 to 53.  
 4 A. Yes.  
 5 Q. And it says there that the neutral electrode 11 in  
 6 the form of the steel band rests on the tissue in large  
 7 area form so that good electrical contact is insured.  
 8 Do you see what I'm referring to there?  
 9 A. Yes, I do.  
 10 Q. Now, wouldn't you agree with me, sir, that if there  
 11 were electrically conducting fluid that was filling the  
 12 environment where the active electrode is and the return  
 13 electrode is, you wouldn't need to have tissue contact  
 14 to insure good electrical contact between the active  
 15 electrode and the return electrode. That would be  
 16 provided by the saline or the Ringer's lactate or the  
 17 other electrically conducting fluid; right?  
 18 A. From the specific embodiment, your interpretation  
 19 is correct. However, this is not the embodiment that I  
 20 talked about and it's not an embodiment that I described.  
 21 Q. But for the embodiment I described, that's correct?  
 22 A. Yes.  
 23 Q. Now, why don't we take a look at the embodiment we  
 24 did talk about which is Figures 7 and 8 were the ones you  
 25 had up?

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1 A. That's correct.  
 2 MR. BOBROW: So perhaps we can highlight those.  
 3 BY MR. BOBROW:  
 4 Q. I'm sorry. Dr. Taylor, are you there?  
 5 A. Yes, I am.  
 6 Q. Thank you. Now, Figures 7 and 8 you had testified  
 7 about a little bit earlier and, as I see it there, there  
 8 is a ring or a band that is called 11.  
 9 Do you see that?  
 10 A. Yes.  
 11 Q. And that's what Mr. Roos is calling the return  
 12 electrode here; correct?  
 13 A. Yes.  
 14 Q. All right. Or neutral, I guess. But that's what  
 15 you are saying is the return electrode for purposes of  
 16 these claims?  
 17 A. Right.  
 18 Q. And as I was looking at what you had checked off  
 19 earlier, for Claim 47 in the Roos '198 patent, it appears  
 20 that your testimony was that this embodiment of the Roos  
 21 '198 patent satisfies Claims 47; right?  
 22 A. Yes.  
 23 Q. And specifically, you offered the opinion that this  
 24 embodiment satisfied this language that says that the  
 25 return electrode is sufficiently spaced from the electrode

1 terminal to minimize direct contact between the return  
 2 electrode and the patient's tissue.  
 3 Do you see that?  
 4 A. Yes.  
 5 Q. And that's your testimony, even though the return  
 6 electrode completely surrounds the probe shaft; right?  
 7 A. Yes.  
 8 Q. It's exposed for 360 degrees of that shaft; right?  
 9 A. Yes.  
 10 Q. And it's not spaced very far away from the active  
 11 electrode, is it? It would be spaced a small distance;  
 12 right?  
 13 A. No.  
 14 Q. How far away would it be spaced?  
 15 A. Well, if you look at a standard resectoscope -- and  
 16 I happen to know that in the Roos article what they did  
 17 is they modified a Carl Storts (phonetic) resectoscope,  
 18 the cutting loop which is indicated by 12 can move out  
 19 about -- about an inch and could be retracted almost to  
 20 the lip there, the plastic insulating member which is  
 21 indicated by 35. So it has the ability to move in and  
 22 out. So an inch is pretty far for an electrode.  
 23 Q. So the loop isn't also positioned an inch away from  
 24 the return electrode?  
 25 A. It's not always, but it can be.

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1 Q. What you do is you retract the treatment electrode  
 2 back in towards the return electrode; correct?  
 3 A. Yes, you do.  
 4 Q. That's the technique. It extends out and you pull  
 5 it back towards the return electrode; right?  
 6 A. Right.  
 7 Q. And in the TRUP procedure, I take it that this device  
 8 here is traveling a fairly tight, a tight lumen, as it  
 9 were; right? It goes up to the urethra, doesn't it?  
 10 That's the passageway into the body, isn't it?  
 11 A. Oh, I see. I'm sorry. I thought you were back at  
 12 the electrode again. Yes, the device does go into the  
 13 urethra and it also can be used for treating the bladder,  
 14 in which case the neutral electrical would be almost  
 15 entirely or it could be almost entirely inside the  
 16 bladder. The bladder, in order to operate on the bladder,  
 17 you have to distend it, which means you put fluid into it  
 18 and make it large. And the bladder distended is, oh, about  
 19 the size of my fist. I guess it depends on how big your  
 20 bladder is. But when you have the instrument all the way  
 21 in the bladder, the return electrode is entirely, entirely  
 22 engulfed by fluid.  
 23 Q. Right. And in the conventional monopolar way, that  
 24 would be in a glycine solution; right?  
 25 A. That's correct. But, in this particular case, that's

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1 not what they used.  
 2 Q. Right. All right. Instead, they used washing  
 3 liquid; right?  
 4 A. Yes.  
 5 Q. That's what the patent says?  
 6 A. Yes.  
 7 Q. Now, let's take a look at Figure 1 of this patent.  
 8 And Figure 1 is describing another bipolar embodiment of  
 9 Roos, is it not?  
 10 A. Yes, it is.  
 11 Q. And there is a little hook there. That's the  
 12 treatment electrode; right?  
 13 A. Yes.  
 14 Q. And here, there is a return electrode also; right?  
 15 Or a neutral electrode as he calls it?  
 16 A. Yes.  
 17 Q. And that neutral electrode is within that endoscope.  
 18 It's covered up by some sort of insulation there, isn't it?  
 19 A. Yes.  
 20 Q. So the neutral electrode is located within the  
 21 endoscope; right?  
 22 A. In this case, it is.  
 23 Q. Now, let's go to Claim 1 of the Roos '198 patent.  
 24 And do you see that, sir?  
 25 A. I've got it right here.

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1 Q. Right. And this claim, Claim 1, actually has as a  
 2 limitation that the return electrode is or it says the  
 3 neutral electrode is located within said endoscope body.  
 4 Do you see that? That's at about line --  
 5 A. I know it's here. What line is it?  
 6 Q. About Line 58.  
 7 A. Yes. I'm sorry. Yes, I've got it.  
 8 Q. And you would agree with me that Claim 1 as it's  
 9 written here actually covers the embodiment we were just  
 10 looking at, Figure 1?  
 11 A. It covers Figure 1. It covers 7 and 8, too.  
 12 Q. Let's take it in pieces.  
 13 A. Okay.  
 14 Q. First, you would agree with me this covers Claim 1?  
 15 A. Yes.  
 16 Q. And your testimony is that Claim 1 covers also  
 17 Figures 7 and 8?  
 18 A. Covers Figures 7 and 8. And I think it actually  
 19 covers Figure 5, too, but I had to go back and look.  
 20 Q. Now, first of all, would you agree with me that, in  
 21 the Roos '198 patent, there isn't any discussion or  
 22 suggestion that the fluid that is used with Figure 1,  
 23 that device is any different than the fluid that is used  
 24 with any of the other devices? Would you agree with me  
 25 on that?

1 A. I don't believe there is any differentiation of the  
 2 fluid.  
 3 Q. Right. So the way that the fluid is described in  
 4 this reference, same fluid for Figure 1, Figure 2, Figure  
 5 7, Figure 8; correct?  
 6 A. That's correct.  
 7 Q. All right. Now, I believe you testified here just  
 8 now that you believe that this claim, Claim 1, also covers  
 9 Figures 7 and 8; is that correct?  
 10 A. That's correct.  
 11 MR. BOBROW: Now, why don't we put Figures 7  
 12 and 8 up on the board?  
 13 BY MR. BOBROW:  
 14 Q. Now, for Figures 7 and 8 to fall within the scope of  
 15 Claim 1, this neutral electrode, right there, right here,  
 16 would have to be located within the endoscope body;  
 17 correct?  
 18 A. That's correct.  
 19 Q. And you recall that I took your deposition probably  
 20 about two months ago; right?  
 21 A. Oh, yes. That was fun.  
 22 Q. And back at that time, when I did take your  
 23 deposition, I asked you about this issue, didn't I?  
 24 A. Yes, you did.  
 25 Q. And I asked you whether or not, back at that time,

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1 whether or not you agreed with me that Claim 1 didn't  
 2 cover Figures 7 and 8; correct?  
 3 A. Yes.  
 4 Q. And you were under oath at that time; right?  
 5 A. Sure was.  
 6 Q. Just like now?  
 7 A. Yes.  
 8 Q. And back at that time, you had also studied the  
 9 Roos '198 patent before you testified?  
 10 A. Yes.  
 11 Q. The Roos '198 patent wasn't something I'd showed  
 12 you that day and asked you questions about?  
 13 A. I studied it intensely.  
 14 Q. Right. And when I asked you for the first time  
 15 about whether or not Claim 1 covered Figures 7 and 8, you  
 16 told me under oath, you didn't?  
 17 A. That's right.  
 18 Q. You remember that very well?  
 19 A. That's right. Because I corrected it.  
 20 Q. Right. You corrected it after lunch, didn't you?  
 21 A. Yes, I did.  
 22 Q. You corrected it after you had lunch with Smith &  
 23 Nephew's lawyers?  
 24 A. I actually corrected it because I looked at the  
 25 diagram again.

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1 Q. Please answer my question.  
 2 A. I did have conversation after lunch, yes, and with  
 3 lunch.  
 4 Q. And that was Mr. MacFerrin, Smith & Nephew's attorney?  
 5 A. Yes.  
 6 Q. And Mr. MacFerrin, during your deposition, was also  
 7 acting as your lawyer; right?  
 8 A. Yes.  
 9 Q. You were represented by the very same lawyers that  
 10 are representing Smith & Nephew here in court today; isn't  
 11 that right?  
 12 A. Yes.  
 13 Q. And you had been retained or you had retained that  
 14 firm and you considered there to be an attorney/client  
 15 privilege between discussions that you had with Smith &  
 16 Nephew's lawyers; correct?  
 17 A. Yes.  
 18 Q. And I asked you some questions during the  
 19 deposition and you refused to answer some of them based  
 20 upon the fact there was an attorney/client relationship?  
 21 MR. MARSDEN: Objection. This is improper  
 22 questioning about assertions of the attorney-client  
 23 privilege.  
 24 THE COURT: Where are we going with this, Mr.  
 25 Bobrow?

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1 MR. BOBROW: I believe it goes to the  
 2 credibility of the advise of the witness.  
 3 THE COURT: Because he didn't answer questions  
 4 at a deposition?  
 5 MR. BOBROW: Based upon his relationship with  
 6 the Smith & Nephew's lawyers.  
 7 MR. MARSDEN: Based upon privilege.  
 8 THE COURT: And what was the last question that  
 9 you asked?  
 10 MR. BOBROW: The last question I believe was  
 11 that he had refused to answer questions I had asked him at  
 12 the deposition based upon the attorney/client relationship  
 13 that he had with his lawyers.  
 14 THE COURT: All right. That's an appropriate  
 15 question, but then you need to move on.  
 16 THE WITNESS: Where were we?  
 17 BY MR. BOBROW:  
 18 Q. I just asked the question, you refused to answer  
 19 some questions that I asked you during your deposition  
 20 based upon the attorney/client relationship with the same  
 21 lawyers that are representing you as Smith & Nephew?  
 22 A. Yes.  
 23 Q. And you're not paying and haven't paid the Smith &  
 24 Nephew's lawyers any money for their services, have you?  
 25 A. No, I have not.

1 Q. You understand that the time that they've spent with  
 2 you has been reimbursed or compensated by Smith & Nephew;  
 3 right?  
 4 A. I certainly understand they're being reimbursed by  
 5 Smith & Nephew.  
 6 Q. Now, not only did you testify when I asked you in  
 7 your deposition that these Figures 7 and 8 aren't covered  
 8 by Claim 1 the first time I asked you, but after lunch,  
 9 you did come in and you said your testimony was now  
 10 different, that you believed it was covered by Claim 1;  
 11 right?  
 12 A. I made a mistake, yes, and I corrected it.  
 13 Q. And isn't it true also that Smith & Nephew's lawyer  
 14 during that lunch break pointed out that mistake to you?  
 15 A. Yes, he did.  
 16 Q. Right. And during that lunch, Mr. MacFerrin was  
 17 the one who said, Hey, I think that this was wrong with  
 18 respect to Figure 7, it is covered by Claim 1 and let's  
 19 go through it; right?  
 20 A. I don't think it was exactly that way. I think  
 21 basically he asked me to refer back to my report, remember  
 22 what I said in my report.  
 23 Q. Well, let's look at that because in your report,  
 24 you also talked about whether Claim 1 covers Figure 7;  
 25 correct?

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1 A. Yes.  
 2 Q. And in your report, you addressed the question of  
 3 whether or not this neutral electrode, right here, and  
 4 right here, whether that neutral electrode is an electrode  
 5 that is within the endoscope body; correct?  
 6 A. Yes.  
 7 Q. And that was a report that you prepared prior to  
 8 the deposition back in I believe it was late March; right?  
 9 A. Are you referring to the report or the deposition?  
 10 Q. I'm sorry that I was unclear. Let me try to restate  
 11 it. The report that you prepared where you discuss Figure  
 12 7, that report was prepared before I took your deposition;  
 13 right?  
 14 A. Yes.  
 15 Q. All right. And even before I took your deposition,  
 16 you also signed a declaration about your report, didn't  
 17 you?  
 18 A. Oh, yes. Yes.  
 19 Q. And you declared under the penalties of perjury that  
 20 you believed what you said in your report was true?  
 21 A. Right.  
 22 Q. And that was a report that you had prepared prior to  
 23 your deposition; right?  
 24 A. Right.  
 25 Q. And, obviously, prior to the lunch that you had with

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1 Mr. MacFerrin during the middle of the deposition; correct?  
 2 A. Correct.  
 3 Q. All right. Now, I have your report in that white  
 4 binder, and I direct your attention, please, to Page 18  
 5 of your report. This is your expert report of February  
 6 17, 2003.  
 7 Do you have that, sir?  
 8 A. Yes.  
 9 Q. And in the middle of page 18, you address in your  
 10 report the question of whether Claim 1 covers Figures 7  
 11 and 8; right?  
 12 A. Yes.  
 13 Q. And when you wrote your report, let's just -- when  
 14 you wrote your report, what you wrote was, quote, it is  
 15 particularly important to note that in connection with  
 16 the endoscope shown in the Roos '198 patent at Figures 7  
 17 and 8, there is no plastic cover and the neutral electrode  
 18 is on the outside of the endoscope, not arranged within it.  
 19 Correct? That's the sentence you wrote in  
 20 your report of February 17 of 2003; correct?  
 21 A. Yes, that's in the report.  
 22 Q. Right. And what you just wrote there, not arranged  
 23 within it, those were your words; correct?  
 24 A. Yes.  
 25 Q. You wrote those words yourself; right?

1 BY MR. BOBROW:  
 2 Q. Sir, I have had handed you PX-605, which is a patent  
 3 t Roos, Eberhard Roos from Germany, U.S. Patent Number  
 4 4,706,667.  
 5 Do you see that?  
 6 A. Yes.  
 7 Q. And this is the Roos patent that you considered in  
 8 connection with your work on this matter; is that right?  
 9 A. It looks like it's the patent. Yes. Excuse me.  
 10 MR. BOBROW: Pardon me, Dr. Taylor.  
 11 Your Honor, I move PX-605 into evidence.  
 12 THE COURT: Any objection?  
 13 MR. MARSDEN: No objection.  
 14 THE COURT: All right. Thank you.  
 15 THE DEPUTY CLERK: So marked.  
 16 \*\*\* (Plaintiff's Exhibit No. 605 was received into  
 17 evidence.)  
 18 BY MR. BOBROW:  
 19 Q. Now, the '667 patent was issued to Eberhard Roos;  
 20 right?  
 21 A. Yes.  
 22 ---  
 23  
 24  
 25

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1 A. Yes.  
 2 Q. And you wrote those words to describe Figures 7 and  
 3 8; right?  
 4 A. That's right.  
 5 Q. Now, in connection with your work on this matter, I  
 6 take it that you have also reviewed --  
 7 A. Excuse me. Can I put this away?  
 8 Q. Sure.  
 9 (Pause.)  
 10 BY MR. BOBROW:  
 11 Q. You have also reviewed another patent to Mr. Roos;  
 12 correct?  
 13 A. The '667? Is that the one are you talking about?  
 14 Q. Exactly. You reviewed that reference, the Roos  
 15 '667 patent, in connection with your work on this matter;  
 16 right?  
 17 A. Yes, I did.  
 18 Q. And you, in fact, considered this reference at the  
 19 time that you wrote your report; correct?  
 20 A. Yes.  
 21 Q. All right.  
 22 MR. BOBROW: Your Honor, may I approach?  
 23 THE COURT: Yes, you may.  
 24 (Document passed forward.)  
 25

1  
 2 Q. He is the same man who is on the Roos '198 patent  
 3 that you talked about earlier on your direct examination;  
 4 correct?  
 5 A. Yes, he is.  
 6 Q. And he is the same man who is the Roos in the  
 7 Elsasser and Roos article; right?  
 8 A. Yes, he is.  
 9 Q. And this patent is dated in, issued in November 1987;  
 10 correct?  
 11 A. Yes.  
 12 Q. In this patent, the '667 patent, Mr. Roos actually  
 13 talks a bit about the German application that was the  
 14 predecessor, or sometimes it is called the parent  
 15 application, to what ended up issuing as the Roos '198  
 16 patent; correct?  
 17 A. Yes. You are talking about -- do you have a  
 18 specific reference?  
 19 Q. Sure. Why don't we bring up Column 1 of the '667  
 20 patent, beginning at Line 14, going down to Line 29.  
 21 Perhaps we can highlight that paragraph.  
 22 You will see at the top there it refers to a  
 23 known electrosurgical high-frequency cutting instrument of  
 24 this kind. Then it gives a number that begins DE-OS. And  
 25 it goes on there in there; right?



1 A. Yes.  
 2 Q. And the DE stands for Germany; right?  
 3 A. Deutsch, yes.  
 4 Q. Exactly. What is being referred to here in the  
 5 '667 patent, when it refers to that No. 25 21 719, that  
 6 is actually the German parent application to the Roos  
 7 '198 patent; right?  
 8 A. That's correct. At least that's my understanding,  
 9 anyway.  
 10 Q. In fact, on the '198 patent, that number, 25 21 719,  
 11 appears right on the front, doesn't it?  
 12 A. It does.  
 13 Q. Here, in the '667 patent, in this paragraph, Mr.  
 14 Roos is talking about one of the instruments that is  
 15 described here in the '198 patent; correct?  
 16 A. You are talking about the paragraph that starts at  
 17 Line 14, going down?  
 18 Q. Exactly. And he is talking there, is he not, of  
 19 at least Figure 1 of the '198 patent?  
 20 A. He is talking about -- I am not sure which one he  
 21 is referring to, he is talking about one of the  
 22 instruments in that application.  
 23 Q. Right. And he says there that the neutral electrode  
 24 is admittedly arranged in the immediate vicinity of the  
 25 cutting loop. It is, however, so separated from the tissue

1 by a plastic cover or by its arrangement in an endoscope  
 2 that it can only enter into electrical contact with the  
 3 cutting electrode electrolytically via the secretion which  
 4 is present during the cutting process.  
 5 You see what I am referring to there?  
 6 A. Yes.  
 7 MR. BOBROW: Why don't we put up Figure 1 of  
 8 the '198 patent to Roos? Paragraph. If we can put it up  
 9 on the same screen... If not, just put up the '198  
 10 BY MR. BOBROW:  
 11 Q. There we have Figure 1. You can see in Figure 1, can  
 12 you not, there is this sort of shadow right there, that's  
 13 the plastic cover; right? This portion that sticks out  
 14 over this endoscope; right?  
 15 A. The one that is labeled 11?  
 16 Q. I think it's labeled 18, right there. That's the  
 17 plastic cover; right?  
 18 A. Yes.  
 19 Q. And what we just read in the Roos '667 patent, the  
 20 later patent, it's talking there about an electrode that  
 21 is separated from the tissue by a plastic cover; right?  
 22 A. Sorry. Say that again?  
 23 Q. In the '667 patent, it talks about a cutting  
 24 electrode that is separated from the tissue by a plastic  
 25 cover?

1 A. Yes.  
 2 Q. So it is pretty clear, is it not, that at the very  
 3 least, in the '667 patent, Mr. Roos is talking about Figure  
 4 1; correct?  
 5 A. Well, he certainly could be. Certainly, the Figure  
 6 1 that is in the '198 patent may be the figure that he is  
 7 discussing here -- or the configuration, I should say, that  
 8 he is discussing in the '667. He didn't specifically call  
 9 it out. So we are surmising here, I guess, aren't we?  
 10 Q. Given that there is the plastic over that embodiment  
 11 and there isn't plastic over any other one, wouldn't you  
 12 agree that what he is talking about there is Figure 1?  
 13 A. Most likely. But I can't confirm it. It's most  
 14 likely the case.  
 15 Q. Fair enough. So here, for this embodiment -- this is  
 16 a bipolar embodiment; right?  
 17 A. That's my understanding, yes.  
 18 Q. This is an embodiment that Mr. Roos in his '198 patent  
 19 said was used with washing liquid; correct?  
 20 A. Yes.  
 21 Q. Those are the words that Mr. Roos used in the '198  
 22 patent that you talked about on your direct examination?  
 23 A. That's correct.  
 24 Q. And if we can go back to the '667 patent and  
 25 highlight that language, what Mr. Roos is saying there

1 in this patent is that using this device as it was  
 2 designed, that the return electrode and the treatment  
 3 electrode can only enter into electrical contact with  
 4 the cutting electrode electrolytically via the secretion  
 5 which is present during this cutting process.  
 6 Right? That's what he says?  
 7 A. That's what he says.  
 8 Q. Wouldn't you agree with me, sir, that if there were  
 9 saline or Lactated Ringer's that were present in that  
 10 fluid, in that washing liquid as he describes, one would  
 11 not need secretions from the body to make that fluid  
 12 electrically conductive so as to electrically connect  
 13 the treatment electrode with the neutral electrode? The  
 14 liquid would already be conductive and secretions wouldn't  
 15 be needed; isn't that right?  
 16 A. And that's actually one of the reasons why this  
 17 particular passage in '667 is confusing, because of the  
 18 fact that we know that at least one configuration of Roos  
 19 works, clinically works, because he couldn't have  
 20 conducted 32 procedures without being able to resect  
 21 tissue. And he did resect -- let me finish, please. He  
 22 did resect tissue using washing liquid.  
 23 So that's one of the reasons why this  
 24 particular passage is confusing to me.  
 25 Q. Well, let's back up a little bit then, because you

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1 also testified earlier about the Roos and Elsasser article;  
 2 correct?  
 3 A. Yes.  
 4 Q. And the reduce and Elsasser article talks about some  
 5 surgeries that were performed; right?  
 6 A. Correct.  
 7 Q. And in the Roos and Elsasser article, the instrument  
 8 that was used was essentially the instrument from Figures  
 9 7 and 8 of the '198 patent; right? That's the one that was  
 10 used to perform the surgery?  
 11 A. That configuration was the one that was used to  
 12 perform the surgeries. They also tried another  
 13 configuration, and I have forgotten which figure it  
 14 refers to in the patent, that worked but not as well.  
 15 Q. But the one in reference to that you said was used  
 16 in surgery, that is Figures 7 and 8 in the '198 patent?  
 17 That's the one that is described?  
 18 A. Absolutely.  
 19 Q. Not Figure 1, correct, but they describe Figures 7  
 20 and 8?  
 21 A. Okay.  
 22 Q. So my questions have to do right now with what is  
 23 described here for Figure 1 and this language here in  
 24 '667.  
 25 Now, wouldn't you agree with me, sir, that if

1 treatment electrode and the neutral electrode? Isn't that  
 2 true?  
 3 A. Explain to me the logic again?  
 4 Q. I am simply saying, sir, that if electrically  
 5 nonconductive fluid were introduced, if that was  
 6 introduced into the body, then in order to electrically  
 7 connect and have a good electrical connection between the  
 8 treatment electrode and the neutral electrode, you would  
 9 need to have secretions from the body in order to make  
 10 that fluid electrically conductive?  
 11 A. In which case the fluid would be electrically  
 12 conductive, right.  
 13 Q. I am simply saying if you introduce a nonconductive  
 14 fluid and there are secretions into the fluid, then you  
 15 would need those secretions to have an electrolytic  
 16 connection between the treatment electrode and the neutral  
 17 electrode; right?  
 18 A. I follow your logic. And once again --  
 19 Q. Can you please answer the question?  
 20 A. The answer is yes. I follow your logic, but it's  
 21 confusing. That's all.  
 22 Q. But I just want it to be clear that your answer to  
 23 my question is if you introduce an electrically  
 24 nonconductive fluid, you would need secretions from the  
 25 body to couple the treatment electrode to the return

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1 the liquid used with Figure 1 were electrically conductive  
 2 fluid when it was introduced into the surgical site, that  
 3 secretions into the fluid would not be necessary in order  
 4 to make it electrically conductive so as to electrically  
 5 couple the active and the return electrode together?  
 6 Wouldn't you agree with that?  
 7 A. I would agree with you. But once again, it's  
 8 confusing, because I think you have already established,  
 9 in the course of your examination on me, that the washing  
 10 liquid that was used in '198 is the same washing liquid  
 11 throughout; right? And, therefore, if the washing liquid  
 12 that was used -- that was used throughout all the  
 13 different configurations, if the washing liquid was  
 14 successful in Figures 7 and 8, clinically, then it must  
 15 have been electrically conductive fluid. There is a  
 16 logical connection there.  
 17 Q. Well, that's what you are saying now. But isn't  
 18 it true, sir, that electrical current can flow through  
 19 electrically nonconductive fluids? Isn't that true?  
 20 A. Yes, it can.  
 21 Q. And isn't it also true that if an electrically  
 22 nonconductive fluid were introduced into the surgical site,  
 23 that you would need secretions from the body in order to  
 24 make the fluid conductive so as to maintain a good  
 25 electrical connection, electrolytic connection between the

1 electrode. Is that a true statement?  
 2 A. I think the answer is yes. But I still think it's  
 3 confusing.  
 4 Q. All right. Now, let's see if we can go through the  
 5 rest of this paragraph and see if there is any more  
 6 clarity here, because it also says, in this paragraph in  
 7 Column 1, that because of this problem, that the device  
 8 was relying upon tissue discretions, it says that it was  
 9 difficult to maintain the current intensity required for  
 10 trouble-free cutting in a required, precisely defined  
 11 manner at the cutting electrode.  
 12 Do you see that?  
 13 A. Yes.  
 14 Q. And the import of that is that the fluid that was  
 15 being used with this Roos '198 patent, Figure 1, was that  
 16 the fluid wasn't sufficiently conductive to be able to d  
 17 trouble-free cutting; correct?  
 18 A. One of the problems I am having with this is, this  
 19 particular paragraph doesn't even reference any fluid at  
 20 all. So I am wondering if this device wasn't used or  
 21 intended to be used for open surgery.  
 22 Q. Well, that is not how it's described in the '198  
 23 patent, is it? In the '198 patent it says that Figure 1  
 24 is used with washing liquid; right?  
 25 A. The thing is, if you read the first sentence, in a

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1 known electrosurgical high-frequency cutting instrument  
 2 of this kind, does that mean it is exactly the same or  
 3 does that mean it is sort of similar?  
 4 Q. In that description he cites specifically to the  
 5 parent application to the '198 patent; right?  
 6 A. I agree with you on that.  
 7 Q. In the '198 patent, every single device that is  
 8 described in there is designed for use with fluid;  
 9 correct?  
 10 A. Yes, it is.  
 11 Q. And in every single one of those, every single  
 12 embodiment in the Roos '198 patent is described as being  
 13 used with some type of washing liquid; correct?  
 14 A. It is.  
 15 Q. All right. Now, wouldn't you agree with me that  
 16 what Mr. Roos is saying here in his patent, when he is  
 17 describing the parent application to the '198 patent, he  
 18 is saying here that when you use this instrument that  
 19 there was not sufficient discretion from the body to make  
 20 the fluid sufficiently conductive so that you could get  
 21 trouble-free cutting? Isn't that the import of this  
 22 paragraph?  
 23 A. He is saying that. But there is no reference to any  
 24 other fluid.  
 25 Q. But that is the import of this paragraph; correct?

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1 A. Yes.  
 2 Q. All right. Now, I have another question about the  
 3 Roos '198 patent.  
 4 If we could put that back up and take the '667  
 5 patent down...  
 6 In the '198 patent, there are of course a large  
 7 number of figures and we have gone through a couple of those  
 8 already; correct?  
 9 A. Right.  
 10 Q. I think earlier you had put up on the overhead  
 11 Figures 7 and 8 when you were going through your direct  
 12 examination; correct?  
 13 A. Yes, I did.  
 14 Q. And one of the things that you said was that in the  
 15 '198 patent that there is a disclosure of a connector;  
 16 correct?  
 17 A. Yes.  
 18 Q. And you said that the connector was located, the  
 19 language of the claim says that the connector is near the  
 20 proximal end of the shaft; right?  
 21 A. Yes.  
 22 Q. And so it's your testimony here today that the  
 23 figures of the '198 patent show there is a connector near  
 24 the proximal end of the shaft; is that right?  
 25 A. Yes.

1 Q. And so I take it what that means is that you have  
 2 been able to review the Roos '198 patent and you have been  
 3 able to locate somewhere in those figures some discussion  
 4 of the location of where the connector is to connect back  
 5 to the generator; right?  
 6 A. Well, there is a connector. There has to be.  
 7 Q. I am not asking you that question. I am saying  
 8 that you have been able to review the '198 patent and you  
 9 have been able to discern some description in there of  
 10 the location of the connector. Not that there is one.  
 11 But the specific location of it; right?  
 12 A. There is not a specific reference to a location of  
 13 the connector.  
 14 Q. All right. So here, when you marked on this board  
 15 that the limitation was met, that the connector is near  
 16 the proximal end of the shaft, the Roos '198 doesn't say  
 17 where the connector is; correct?  
 18 A. The patent does not say -- the patent does not say  
 19 explicitly where the connector is located.  
 20 Q. All right. Now, since we are on the subject of Mr.  
 21 Roos --  
 22 A. You do realize that all resectoscopes have connectors  
 23 at the back end of the resectoscope.  
 24 Q. I don't realize that. In all events, in the '198  
 25 patent, there is no discussion of where the connector is;

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1 correct?  
 2 A. That's correct, yes.  
 3 Q. When you said there is that discussion, that wasn't  
 4 true, was it?  
 5 A. No, but then again --  
 6 Q. There is nothing in the '198 patent that says that;  
 7 correct?  
 8 A. There is nothing in the '198 patent that says it  
 9 explicitly. But there are no resectoscopes on the market  
 10 that don't have a connector at the end, on the back of  
 11 the resectoscope.  
 12 Q. In the market, you said?  
 13 A. In the market.  
 14 Q. Why don't we turn, then, to DTX-59-A and B. This is  
 15 the Roos and Elsasser article. Perhaps we can put up the  
 16 German language original. Do you have that, sir?  
 17 A. Yes.  
 18 Q. Why don't we go to Figure 3.  
 19 Now, if we can highlight Figure 3, please.  
 20 Here in the Roos and Elsasser article, in the first part of  
 21 the article, once again, there is a discussion of a  
 22 monopolar TURP procedure; correct?  
 23 A. You are asking me if there is a discussion of  
 24 conventional TURP?  
 25 Q. Monopolar?

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1 A. Yes, there is.  
 2 Q. And Figure 3 is one of the figures that Roos and  
 3 Elsasser used to describe that conventional monopolar  
 4 procedure; correct?  
 5 A. I am just reading the English version of this.  
 6 Q. Fair enough. I am, too.  
 7 A. Yes, it is.  
 8 Q. And so what is being shown here in Figure 3 is a  
 9 resectoscope that is being inserted into the body;  
 10 correct?  
 11 A. Well, I believe what is being shown here, you have  
 12 got the resectoscope there. This represents the bladder.  
 13 And this represents the prostate.  
 14 Q. So right here, that region that I am circling now,  
 15 which is cross-hatched at about a 45-degree angle, that  
 16 area there is the prostate; is that right?  
 17 A. That is correct.  
 18 Q. And that's tissue?  
 19 A. Yes, us men would consider it to be tissue.  
 20 Q. Fair enough. And so here, this is the tip of the  
 21 resectoscope; right?  
 22 A. Yes.  
 23 Q. The part that I am circling there. And this little  
 24 loop here, that is the treatment electrode; correct?  
 25 A. That's the cutting loop, yes.

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1 Q. And these lines here that go back to the  
 2 resectoscope, those are current flux lines; correct?  
 3 A. Yes.  
 4 Q. And what is being depicted here is current flux  
 5 lines between this loop and the flux lines going back to  
 6 essentially a metal portion of this resectoscope; right?  
 7 A. That's right.  
 8 Q. And you already said that this is a monopolar  
 9 embodiment; correct?  
 10 A. For conventional -- yes.  
 11 Q. What is depicted here is monopolar; right?  
 12 A. Right.  
 13 Q. There is no return electrode there, is there?  
 14 A. Right.  
 15 Q. What this is then showing is current flow through  
 16 what must have been electrically nonconductive fluid  
 17 because that is the fluid that was used in monopolar  
 18 electrosurgery; correct?  
 19 A. Actually, this diagram is not entirely correct,  
 20 because what actually happens is you have current flux  
 21 lines that flow back to almost all parts of the body,  
 22 including at the endoscope.  
 23 Q. But this is showing current flow through what must  
 24 have been a nonconductive fluid because nonconductive  
 25 fluids were used in monopolar TURP procedures; right?

1 A. It does show current flow. Like I said, it is not  
 2 entirely correct.  
 3 Q. But let's talk about the part that is correct. I  
 4 think it's correct, isn't it, that this fluid that the tip  
 5 of this device is in would have been essentially something  
 6 like glycine or some similar electrically nonconductive  
 7 fluid. You wouldn't in a monopolar device using saline  
 8 or Ringer's lactate?  
 9 A. The Europeans favor mannitol. But it could have been  
 10 glycine.  
 11 Q. In all events, it could have been glycine; right?  
 12 A. That's correct.  
 13 Q. Now, similar to the '198 patent, the Roos article  
 14 doesn't use the word saline; correct?  
 15 A. It uses washing liquid or washing fluid, something to  
 16 that effect.  
 17 Q. I think it's to that effect. The words are a little  
 18 bit different. But he doesn't use saline; correct?  
 19 A. He does not use saline.  
 20 Q. He doesn't use Ringer Lactate or Lactated Ringer's?  
 21 A. Correct.  
 22 Q. I think what he does say, if you look at the English  
 23 translation at Page 2, it's described as irrigation liquid;  
 24 correct? About the middle of the page, sir.  
 25 A. Yes. The irrigation liquid.

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1 Q. And so that irrigation liquid would have been glycine  
 2 or mannitol or some electrically nonconductive fluid;  
 3 right?  
 4 A. I think at this point, isn't he talking about his  
 5 invention, the actual --  
 6 Q. Well, this is a discussion of Figures 2, 3 and 4.  
 7 And so we are talking here about a conventional approach;  
 8 correct?  
 9 A. Oh, I am sorry. Yes, you are right.  
 10 Q. Fair enough.  
 11 Now, just to anticipate maybe where you were  
 12 going, if you turn to page and look at Page 4, I believe  
 13 here he is talking about the bipolar embodiments; right?  
 14 This is the beginning of that discussion?  
 15 A. Yes, that's right.  
 16 Q. And in Paragraph No. 1, at the very end of that  
 17 sentence, he talks about the fluid that is used. Do you  
 18 see that?  
 19 A. Yes.  
 20 Q. And he calls it irrigation liquid; right?  
 21 A. Yes.  
 22 Q. And those are the same words that he used to describe  
 23 the fluid that was used for the monopolar embodiment on  
 24 the previ us page; correct?  
 25 A. Yes. Not the same fluid, but yes.

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1 Q. He describes them using the exact same words,  
 2 doesn't he?  
 3 A. He uses the exact same words, yes. But that doesn't  
 4 necessarily mean it's the same exact fluid.  
 5 Q. The same words are used; right?  
 6 A. Yes.  
 7 Q. Now, let's go back to the previous page.  
 8 A. Are we on Page 3 now?  
 9 Q. I am sorry. I believe we are on Page 2. Again,  
 10 this is the monopolar embodiment, so we know that it would  
 11 be mannitol or glycine or some similar fluid; correct?  
 12 A. That's right.  
 13 Q. Now, if you look at the English language text for  
 14 Figure 3 that we were looking at earlier, do you have  
 15 that, at the very bottom of Page 2?  
 16 A. Right.  
 17 Q. And in that description, Mr. Roos and Mr. Elsasser  
 18 are describing that current flows directly from the  
 19 cutting loop to those parts of the resectoscope projecting  
 20 into the irrigation fluid. Do you see that? That's in  
 21 the text at the very bottom of Page 2.  
 22 A. Yes.  
 23 Q. So here in the article, Elsasser and Roos are talking  
 24 about current flow in the monopolar embodiment; right?  
 25 From the cutting loop back to the resectoscope; correct?

1 Patent Office in relation to the prosecution of the ' 536  
 2 patent?  
 3 A. That's correct.  
 4 Q. And the '536 patent and its claims issued over this  
 5 Doss patent; right?  
 6 A. That's correct.  
 7 Q. And the Doss patent also was given to the Patent  
 8 Office in connection with the re-examination of the 536  
 9 patent; correct?  
 10 A. Once again, there were a lot of patents that were  
 11 considered.  
 12 Can you show me that, just so we can clarify  
 13 it?  
 14 Q. Maybe we will get to that a little later. Why don't  
 15 we talk about what is actually in the Doss patent at this  
 16 point?  
 17 A. Okay.  
 18 Q. Now, in the Doss patent, why --  
 19 MR. BOBROW: why don't we put up Figures 7 and  
 20 8?  
 21 BY MR. BOBROW:  
 22 Q. I think those were the figures that you had up  
 23 earlier.  
 24 In this patent, this was the figure that you  
 25 had up earlier, right, just without the colors?

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1 A. Yes.  
 2 Q. Let me shift gears and ask you some questions about  
 3 the Doss '007 patent. Do you have that, sir? That's  
 4 DTX-17.  
 5 A. I have it in front of me, yes. Yes, I do.  
 6 Q. And the Doss patent is one of the patents that you  
 7 talked about on your direct examination with respect to  
 8 the '536 patent; correct?  
 9 A. Yes.  
 10 Q. And the Doss patent is a patent that was actually  
 11 cited during the prosecution of the '536 patent itself;  
 12 right?  
 13 A. I will take your word for it. There were a lot of  
 14 patents that were cited and I don't have that in front  
 15 of me. So I will take your word for it.  
 16 Q. Why don't we actually show it.  
 17 MR. BOBROW: why don't we pull up JTX-1?  
 18 BY MR. BOBROW:  
 19 Q. And if you look in the U.S. patent document section,  
 20 if you highlight that, you will see, I believe it's the  
 21 fifth one down, it says, 4,381,007 to Doss.  
 22 Do you see that?  
 23 A. It is verified, you are right.  
 24 Q. And so the document that you were describing earlier  
 25 as the Doss patent, that patent was considered by the

1 A. Yes.  
 2 Q. And now, in the text of this patent, the Doss patent,  
 3 in the text of it, there is no description of any of the  
 4 electrodes that are shown in this embodiment.  
 5 They are never described as being a return  
 6 electrode; correct?  
 7 A. We specifically mentioned those words are not  
 8 specifically used, return electrode?  
 9 Q. That's correct.  
 10 A. Yes.  
 11 Q. Return electrode is not a term that is used here,  
 12 is it, in the Doss '007 patent?  
 13 A. Just hold on a second.  
 14 I don't believe it's used.  
 15 Q. Right. In fact, if you look at Column 4, it says,  
 16 tubular electrodes 34 and 36, for example? There are  
 17 other places, as well. But in each case where it  
 18 describes the electrodes it calls them electrodes. It  
 19 doesn't call them, for example, a return electrode;  
 20 correct?  
 21 A. No, it does not.  
 22 Q. Now, in the various embodiments of the '007 patent,  
 23 would you agree that each of the electrodes in this  
 24 configuration is designed in a way that it will have a  
 25 high current density at the tip?

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1 A. No, I would not.  
 2 Q. All right. So just to be clear, your testimony is --  
 3 let me ask it specifically again, just so it is clear.  
 4 Would you agree with me that each of the electrodes in  
 5 the figures of the Doss patent is designed in a way that  
 6 will have a high current density? Do you disagree with  
 7 that?  
 8 A. When you say high, are you saying that both  
 9 electrodes have high current densities. Is that your  
 10 question?

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1  
 2 Q. Each of the electrodes is designed in a way that  
 3 will have a high current density. That's the question.  
 4 A. I think the answer may be yes, but I think one of  
 5 the electrodes will have a higher current density than the  
 6 other.  
 7 Q. That's not my question, sir.  
 8 A. Okay. I understand.  
 9 Q. My question is in this patent, for each embodiment,  
 10 in each of the figures, is each of the electrodes designed  
 11 in a way that will have a high current density?  
 12 A. I'm not sure I agree with that.  
 13 Q. Well, you recall I asked you about the Doss patent  
 14 at your deposition, don't you?  
 15 A. Yes.  
 16 Q. And you had reviewed and studied the Doss patent  
 17 before the deposition; right?  
 18 A. Yes.  
 19 Q. And again, the Doss patent was a reference that you  
 20 talked about in your report; correct?  
 21 A. Yes.  
 22 Q. All right. Now, if you would please turn to Page 481  
 23 of your deposition... That is in a white binder.  
 24 A. Which day?  
 25 Q. Pardon me?

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1 MR. BOBROW: Oh, no. Please don't.  
 2 I apologize, your Honor. I didn't know that  
 3 was going to be put up.  
 4 THE COURT: Okay.  
 5 BY MR. BOBROW:  
 6 Q. This is in the second tab, Taylor deposition, March  
 7 28, 2003. And this is Page 481.  
 8 Do you have that sir?  
 9 A. Yes.  
 10 Q. And at Page 481, I asked you the following question  
 11 and you gave the following answer.  
 12 "Question: If you look at the figures in text  
 13 of the Doss '007, would you agree that each of the  
 14 electrodes in the embodiments described is designed in a  
 15 way that it will have a high current density?"  
 16 And in response to my question, you answered in  
 17 your deposition:  
 18 "Answer: Yes."  
 19 Is that correct?  
 20 A. Yes.  
 21 Q. Now, in the devices in Doss, there are a number of  
 22 them that are depicted; correct? Probably seven or eight  
 23 figures; correct?  
 24 A. There are a number of figures, yes.  
 25 Q. And would you agree with me that in each of the

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1 embodiments, the current density of one of the electrodes  
 2 is substantially the same as the current density of the  
 3 other electrode or electrodes in that configuration?  
 4 MR. BOBROW: Why don't we put Figure 7 back  
 5 up?  
 6 THE WITNESS: Can you -- are you going to put  
 7 the figure back up?  
 8 BY MR. BOBROW:  
 9 Q. Well, actually, why don't you just answer the  
 10 question, sir? Would you agree with me that each of the  
 11 electrodes has substantially the same current density as  
 12 the other electrode for any given one of the devices that  
 13 is used or described in that patent?  
 14 A. I don't think that's correct.  
 15 Q. All right. Well, remember I talked to you about  
 16 this in your deposition as well; correct?  
 17 A. Right.  
 18 Q. And you answered my question at that time under oath,  
 19 didn't you?  
 20 A. Yes, and I think I misunderstood your question, but  
 21 that's --  
 22 Q. All right. Well, we can get to that in just a  
 23 minute. If you take a look, please, at Page 482 of your  
 24 deposition.  
 25 Do you have that, sir?

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1 A. Yes, I do.

2 Q. And at that time, I asked you the following questions  
3 and you gave the following answer:

4 "Question: And in each of the embodiments  
5 shown, would you agree that the current density in each of  
6 the electrodes is substantially the same as each of the  
7 other electrodes in the embodiment?"

8 And there was an objection by Mr. MacFerrin and  
9 you gave the answer:

10 "Answer: Does that mean from one embodiment  
11 to another or just within the same embodiment?"

12 "Question: Good question. Within the same  
13 embodiment is what I meant, that the electrodes had  
14 substantially the same current density?"

15 "Answer: It would appear that that is  
16 correct."

17 That's the testimony you gave back on March  
18 28th, 2003; correct?

19 A. That is testimony, and it is also a mistake.

20 Q. So you believe your testimony back then was mistaken;  
21 is that correct?

22 A. I made an error, yes.

23 Q. Did you correct that mistake?

24 A. No, I was under the impression I could not correct  
25 testimonial mistakes. I could only correct typographical

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1 errors or grammatical errors.

2 MR. BOBROW: Let's put Figure 7 up, okay?

3 BY MR. BOBROW:

4 Q. Now, here in this figure, this is the one you had up  
5 earlier; right?

6 A. Yes, it is.

7 Q. And there are here at the tip of the device some  
8 lines there. Do you see those?

9 A. Yes.

10 Q. Some dashed lines. And that's designed to represent  
11 a current flux line; correct?

12 A. The dashed lines represent current flux, yes.

13 Q. Right. And would you agree here that this is  
14 showing the current flux between these two electrodes;  
15 right?

16 A. Yes.

17 Q. All right. And would you also agree that each of  
18 the electrodes as shown here is designed to cause a tissue  
19 effect, in this case in the eye?

20 A. Well, that's sort of goes to the heart of why I  
21 think there is an error on my part.

22 Q. Well, but I would like you to answer my question,  
23 please?

24 A. Okay. Repeat your question. I'm sorry. Repeat your  
25 question.

1 Q. Yes.

2 A. If you would, please.

3 Q. I was simply asking if each electrode in this probe  
4 design is designed to cause a tissue effect. That's my  
5 question.

6 MR. MARSDEN: Your Honor, objection. This goes  
7 to an issue that dealt with claim construction. An issue  
8 which your Honor made a ruling.

9 THE COURT: Well, why don't we take our lunch  
10 early because I have to think about that one.

11 All right. Ladies and gentlemen, we'll take  
12 our lunch, a half-hour, and I'll just remind you not to  
13 discuss the case among yourselves.

14 (At this point the jury then left the  
15 courtroom, and the following occurred without the presence  
16 of the jury.)

17 THE COURT: All right. You may step down, sir.  
18 Let's have the question again and the objection.

19 MR. BOBROW: I believe that the question was  
20 simply whether each of the electrodes in the probe of the  
21 Roos patent is designed to cause a tissue effect. And I  
22 believe that that is quite relevant, your Honor, to the  
23 claim construction here and to whether or not this device  
24 discloses an active electrode and return electrode and  
25 that's where the testimony is going.

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1 MR. MARSDEN: Right, that is where the  
2 testimony is going. And they requested a claim

3 construction that the return electrode could not have a  
4 tissue effect and your Honor rejected that construction,  
5 so that's not a basis on which to say this is not a  
6 return electrode. What your Honor ruled was that you look  
7 at the current density, so that line of questioning was  
8 appropriate, but the line of questioning regarding tissue  
9 effect is not.

10 MR. BOBROW: But I believe the construction  
11 does talk about the active electrode stimulating the  
12 tissue so that is where this goes. I'm asking him whether  
13 or not each of the electrodes has that tissue effect such  
14 that you would have tissue stimulation. It's directly  
15 relevant, your Honor.

16 THE COURT: So which claim construction are  
17 you talking about?

18 MR. BOBROW: This has to do with the definition  
19 of an active electrode and the return electrode. And the  
20 definition of active electrode involves tissue stimulation.

21 MR. MARSDEN: It's 8 and 9, your Honor.

22 MR. BOBROW: And so I'm simply trying to  
23 understand and get testimony from this witness about the  
24 tissue stimulation effects that the different electrodes  
25 have in this embodiment.

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1 THE COURT: All right. Well, certainly the  
2 definition of active electrode is a stimulating electrode,  
3 but the definition of a return electrode doesn't say  
4 stimulate, it just says it has a large area of contact to  
5 avoid a low current density. The only question is  
6 whether this, the question you are asking, is misleading  
7 because it is maybe inconsistent with what I've said.

8 MR. BOBROW: But, your Honor, respectfully, I  
9 am certainly trying not to be misleading. I believe we  
10 are entitled to argue to the jury -- pardon me. I believe  
11 that I should be allowed to argue to the jury. I request  
12 the opportunity to argue to the jury that both of these  
13 electrodes are active electrodes and that both of them  
14 have that tissue stimulation effect, that both of them  
15 have a high current density, that both of them have sharp  
16 edges and the like which would make them tissue treatment  
17 or tissue stimulation electrodes.

18 THE COURT: Well, if you are saying there is  
19 no difference between the two, I mean I do believe that  
20 under this definition there has to be a difference between  
21 the active and the return. If you are saying and your  
22 point is that in the Roos prior-art reference there is no  
23 difference between the two, then that is an appropriate  
24 line of cross.

25 MR. BOBROW: And that's what I'm trying to

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1 establish by the testimony that both of these have a  
2 tissue effect. I think you heard, your Honor, in the  
3 course of the testimony that, for example, the accused  
4 devices are designed in a way that the return electrode  
5 is very benign, that it doesn't arc, that it's not  
6 designed to remove tissue or what-have-you because of its  
7 size and otherwise.

8 And it's ArthroCare's position that both of  
9 these electrodes are active, that both of them have a  
10 tissue effect, have high current density and stimulate the  
11 tissue. That's where we're going with this. I believe  
12 it's a fair line of questioning.

13 MR. MARSDEN: The tissue effect is not part  
14 of the definition of return electrode, and I think the  
15 argument there is no return electrode in this particular  
16 prior-art reference and because it does, in fact, have a  
17 larger area of contact and a lower current density, it  
18 does meet the Court's definition of return electrode.

19 THE COURT: Well, that's argument.

20 MR. BOBROW: That's argument.

21 THE COURT: I think that is argument.  
22 I'm working the jury instructions and verdict  
23 form. I apologize if I'm not keeping up to speed with  
24 you all, but I think it's a fair line of questioning. All  
25 right.

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1 MR. MARSDEN: Thank you.

2 THE COURT: Should we address the other issue?

3 MR. HEBERT: It's an issue Mr. Blumenfeld has.

4 THE COURT: Why don't we do that.

5 MR. BLUMENFELD: Your Honor, it's an issue I  
6 raised this morning that Smith & Nephew advised us last  
7 night that they intend to use with Mr. Raffle this  
8 afternoon, the Ethicon license agreement and their antitrust  
9 counterclaim. And when I asked Mr. Hebert this morning in  
10 the hall whether he still intended to do that, he said yes,  
11 because I had opened the door to that on my cross-  
12 examination of Mr. Sparks. If I opened the door on the  
13 Ethicon license and the antitrust counterclaim, I missed  
14 it, and I guess it's to Mr. Hebert to explain how I did  
15 that.

16 THE COURT: And what relevance it has in the  
17 first instance.

18 MR. HEBERT: What this goes to, this is raised  
19 in one of the motions in limine and ArthroCare moved in  
20 limine to keep out evidence of the antitrust issues. Your  
21 Honor conditionally granted that and said -- this is Item  
22 No. 7 in motions in limine. It was granted so long as  
23 ArthroCare does not introduce evidence regarding the  
24 Ethicon license. And then the ruling goes on to deal with  
25 the issue about the harmful effects which are talked about

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1 here.

2 And Mr. Blumenfeld did get into this in cross-  
3 examination of Mr. Sparks when he is asking him about a  
4 Smith & Nephew document which talks about competition and  
5 he directs him to that and he directs him to the portion  
6 that discusses that Mitek and Stryker -- now, Mitek is a  
7 division of Ethicon, so when it talks about Mitek, there  
8 is no dispute about this, it's talking about Ethicon as  
9 well. It's one and the same -- are paying royalties in  
10 return for licensing the ArthroCare patents.

11 So that is what he was asking Mr. Sparks about  
12 in his cross-examination. He was asking him if he knew  
13 about the ArthroCare patents that were being discussed in  
14 regard to that licensing point and document.

15 MR. BLUMENFELD: Your Honor, I have a  
16 transcript. What I asked him, this is the question:

17 "Question: Under exceptive, at the top, if you  
18 can highlight, in that section there is a reference to,  
19 right in the middle, to key ArthroCare patents and I  
20 highlighted the three words 'key ArthroCare patents.' Do  
21 you see? It's the third line down.

22 "Answer: In that section?

23 "Question: At the top of the page.

24 "Answer: Right. I have got it.

25 "Question: Do you know what key ArthroCare



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1 patents were, what key ArthroCare patents were that Smith &  
2 Nephew was referring to?"

3 That was my question and it had nothing to do  
4 with licenses. I didn't ask about licenses. I haven't  
5 asked anyone about licenses.

6 MR. HEBERT: But at the same time he asked the  
7 question, he broadcast the marketing plan and highlighted  
8 the portion of the marketing plan that talks about the  
9 Mitek and Stryker paying royalties to ArthroCare in terms  
10 of the licensing.

11 So that would be what we say would open the  
12 door.

13 THE COURT: And what is the relevance of this  
14 evidence in the first place, given the fact you have so  
15 little time to present evidence in the second place?

16 MR. HEBERT: To undercut any suggestion that  
17 the patents are strong because they're licensed. They're  
18 licensed because of this very unusual relationship that  
19 ArthroCare and Ethicon have entered into which gives rise  
20 to the antitrust claim as opposed to any strength in the  
21 patents.

22 It would only be a couple questions, two or  
23 three questions.

24 THE COURT: Yes, but it's such a subtle point.  
25 I don't believe that it's appropriate.

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1 All right. Let's take some time.

2 MS. BOYD: Your Honor, we would like to read  
3 an Interrogatory response sometime before closing our case,  
4 Interrogatory Response No. 7. We have an agreement, I  
5 believe, from the other side.

6 THE COURT: Interrogatory Response No. 7?

7 MR. BOBROW: No objection.

8 THE COURT: All right.

9 MS. BOYD: Thank you.

10 (Luncheon recess taken at 1:10 p.m.)  
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AFTERNOON SESSION

(Proceedings resumed at 1:30 p.m.)

THE COURT: All right. Let's bring the jury  
in.

(At this point the jury entered the courtroom  
and took their seats in the box.)

THE COURT: Mr. Bobrow.

MR. BOBROW: Thank you, your Honor. Good  
afternoon, ladies and gentlemen.

BY MR. BOBROW:

Q. Good afternoon, Dr. Taylor.

A. Good afternoon.

Q. I believe that at the close of our session before  
lunch, I had asked you a question, and there was an  
objection to that. I think that issue has now been resolved.

Let me go back to that question. We were  
talking about the Doss '007 patent; correct?

A. Correct.

Q. And I had asked you some questions, for example,  
about Figure 7 of the Doss '007 patent. Do you recall,  
that was the context for our discussion?

A. Yes.

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Q. And I asked you a question before lunch, and this is  
the question I would now like you to answer: Is it true  
that in the Doss '007 patent, that each electrode in each  
of the probes is designed to cause a tissue effect, in  
this particular case in the tissue of the eye?

A. Would you mind putting back the figures, the two  
figures?

Thank you.

Q. So again, my question, sir, simply is, is each  
electrode designed to cause a tissue effect?

A. Yes.

Q. Now, in this figure, we had talked about these  
current flux lines before lunch.

Do you recall that?

A. Yes.

Q. And here -- and it's probably hard, given how shaky  
I am with my pointer -- do you see that number 102?

A. Yes.

Q. And there is a region here right underneath this  
electrode where it appears that the current flux lines  
are not shown. Do you see that? Right in this region  
here. Just above 102, it appears it is not showing a  
current flux line in that region; correct?

A. That's correct, yes.

Q. Instead it is showing these flux lines going out

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1 this way, from here in this case the right to the left,  
 2 and here from the left to the right.  
 3 Do you see what I am talking about there?  
 4 A. Yes.  
 5 Q. Now, imagine, if you would, instead of pointing down  
 6 in this fashion, you sort of looked at it end on and you  
 7 looked at those current lines end on. Do you have that in  
 8 mind now?  
 9 A. Yes.  
 10 Q. And if the current lines were as they are depicted  
 11 here, going from this electrode to here and from this  
 12 electrode to here, essentially, those current flux lines  
 13 would look sort of like a donut; right?  
 14 In other words, you have a hole in the middle,  
 15 where there weren't current flux lines, then you would  
 16 have some current flux lines in sort of a donut shape.  
 17 Is that fair?  
 18 A. Yes. I am not sure exactly how the donut would look.  
 19 It might not look like a regular donut we are familiar  
 20 with. A toroid of some sort.  
 21 Q. And a toroid is basically just a ring; correct?  
 22 A. It's a three-dimensional ring, yes.  
 23 Q. It is sort of like a washer that you might use with  
 24 a nut and a bolt; it's got a hole in the middle and there  
 25 is sort of a ring with some mass around it?

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1 A. That's right. It's sort of a Thalman (phonetic)  
 2 washer.  
 3 Q. Why don't we take a look, then, at the Doss007  
 4 patent. Specifically Column 5?  
 5 A. Which one is that again?  
 6 Q. The DTX number is 17.  
 7 A. 17.  
 8 Q. Okay. Do you have that, sir?  
 9 A. Which one was it again?  
 10 Q. Column 5. The paragraph that I have interest in,  
 11 actually, starts around Line 27. It begins, Figures 7  
 12 and 8.  
 13 MR. BOBROW: Chris, do you have that?  
 14 THE WITNESS: Okay, I see it.  
 15 BY MR. BOBROW:  
 16 Q. All right. And here, this part of the Doss '007  
 17 patent is talking about the figure that you had up in  
 18 direct examination and the figure, in fact, that we just  
 19 had up and were talking about with these donut or toroid-  
 20 shaped lines; correct?  
 21 A. That's correct.  
 22 Q. If you take a look at about Line 43, there is a  
 23 sentence that says, quote, An advantage of this particular  
 24 electrode configuration is that a ring or torus-shaped  
 25 treatment region can be realized, since electric current

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1 flows essentially in a torus-shaped volume under and  
 2 between electrodes 72 and 74.  
 3 Do you see what I am referring to there?  
 4 A. Yes.  
 5 Q. Now, when it is referring there to a torus-shaped  
 6 volume, that is referring to the volume of tissue that  
 7 is being treated in this case by the electrosurgical  
 8 energy of this device; right?  
 9 A. That's what it would imply, yes.  
 10 Q. And the Doss patent is generally describing an  
 11 electrosurgical device that is designed to use this  
 12 current to provide some heating within the corneal and  
 13 other tissues of the eye; correct? It is supposed to  
 14 provide some deep heating, essentially?  
 15 A. Heating. I am not sure I would characterize it as  
 16 deep. It is designed to shape the cornea.  
 17 Q. So what this is saying then -- if we could back to  
 18 Figure 7 -- is that both of these electrodes here, which  
 19 it describes as electrodes 72 and 74, in each of these  
 20 regions, one to the left and one to the right, you will  
 21 have as a result of the current flow between those  
 22 electrodes a region of tissue that has been warmed or  
 23 heated and thereby treated within the eye, in this torus  
 24 shaped fashion; is that right?  
 25 A. Correct.

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1 Q. Now, on the direct examination, you had said that  
 2 this Doss patent anticipates Claim 45 and -- and the  
 3 dependent claims with respect to the '536 patent; correct?  
 4 A. Yes.  
 5 Q. And one of the limitations of Claim 45 of the '536  
 6 patent, and thus a limitation in all of the claims that  
 7 depend from it, is the limitation that provides that you  
 8 have a connector near the proximal end of the shaft.  
 9 Do you recall that?  
 10 A. Right.  
 11 Q. And the proximal end of the shaft is sort of the  
 12 back part of the shaft, not the tip of the device that  
 13 you would be inserting in towards the tissue treatment  
 14 area, but removed from that towards the back; correct?  
 15 A. Yes.  
 16 Q. And here in the Doss '007 patent, would you agree  
 17 with me that there is no disclosure of where the connector  
 18 is located, in other words, there is nothing that tells  
 19 you where the connector is located with respect to the  
 20 shaft?  
 21 A. Hold on a second.  
 22 I believe that's correct. There is no  
 23 specific mention of the location of that.  
 24 ---  
 25

Page 1401

Page 1403

1  
2 Q. Okay. Now, you had also mentioned that you believe  
3 that the Doss '007 patent anticipated some of the claims  
4 of the '592 patent.  
5 Do you recall that?  
6 A. Yes.  
7 Q. And I think that one of those claims was Claim 21 of  
8 the '592, which talks about a voltage in the range of  
9 from 500 volts to 1400 volts peak to peak; is that right?  
10 A. Yes, that's the language I remember. Yes.  
11 Q. And it's your testimony that the Doss '007 patent  
12 necessarily discloses a voltage in the range of 500  
13 volts peak to peak. Is that true?  
14 A. I think it does disclose that range, yes.  
15 Q. And the portion of the patent you base that  
16 testimony on was a passage at the very beginning of the  
17 text of the patent that talks about the voltage being  
18 between about 20 and 200 volts RMS; correct?  
19 A. That's correct.  
20 Q. What did you when you did your calculation to go  
21 from an RMS -- that stands for roots means square, does it  
22 not?  
23 A. Sure does.  
24 Q. So to go from the root means square voltage to the  
25 peak to peak voltage, you multiply the 200 that is set

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1 forth in the page by 2.83 and that gets your north  
2 someplace of about 568 volt peaks to peak; right?  
3 A. Roughly.  
4 Q. Now, in terms of calculating the peak to peak  
5 voltage, isn't you true that you need to know the waveform  
6 that the generator is producing?  
7 A. Yes, you do.  
8 Q. You need to know whether it's a sine wave, whether  
9 it's a square wave or some other waveform; is that correct?  
10 A. That's correct.  
11 Q. And there is nothing in the Doss patent that says  
12 that a sine wave is used with this generator; correct?  
13 A. That's correct.  
14 Q. So we don't know whether there is a sine wave here  
15 or a square wave or some other waveform; right?  
16 A. You're correct. But, to my knowledge, there are no  
17 commercially-available square wave generators.  
18 Q. But you don't know what Mr. Doss may have been  
19 working with in his lab or what you have when he was  
20 writing this application, do you?  
21 A. No.  
22 Q. And whether it's commercially available or not isn't  
23 the test, is it?  
24 A. No, it's not the test.  
25 Q. All right.

1 A. However, it could be used with a sine wave  
2 generator.  
3 Q. But it could be used with a square wave generator?  
4 A. Could be.  
5 Q. And square wave generators are known in the  
6 electrosurgical art, aren't they?  
7 A. They are but not necessarily practiced.  
8 Q. In fact, one of the references, the Slager reference  
9 actually used a square wave generator?  
10 A. Yes, it did.  
11 Q. That was in the electrosurgical context; right?  
12 A. Yes.  
13 Q. So in terms of what is actually disclosed in the  
14 Doss patent, we don't know whether it was a sine wave or  
15 a square wave or something else. True?  
16 A. True.  
17 Q. Now, if you are calculating the peak-to-peak voltage  
18 from the root-means-square voltage, if the waveform in  
19 Doss were a square wave, when you go from 200 volts RMS  
20 to peak to peak, that's 400, isn't it?  
21 A. Actually, if you actually use the correct formula of  
22 the root-means-square calculation, which it's an  
23 integrations calculus, it depends whether or not the  
24 period of the square wave is equal.  
25 But if you make the assumption -- let me

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1 finish -- if you make the assumption that is an equal  
2 period, I think that formula is correct. But, frankly,  
3 I haven't done the math.  
4 Q. Okay. But it's your best understanding here that  
5 if you have a square wave where the waveform is symmetric  
6 and you go from RMS to peak to peak and it's a square  
7 wave, then the Doss patent would be disclosing  
8 approximately 400 volts peak volts peak to peak; right?  
9 A. Yes, according to your formula. Now, like I'd said,  
10 I haven't done the math, but I'll presume that you have and  
11 that you're correct.  
12 Q. Now, you have a background in electrical engineering;  
13 is that right?  
14 A. Yes.  
15 Q. Now, let me ask you now a few questions about the  
16 Pao '499 patent. And this was another patent that you  
17 discussed this morning on your direct examination with  
18 respect to the '536 patent.  
19 Do you have that, sir?  
20 A. Yes, I have it.  
21 Q. Now, the Pao patent, '499 patent, which is DTX-21,  
22 this was one of the patents that was also in front of the  
23 Patent Office during the prosecution of the '536 patent;  
24 correct?  
25 MR. BOBROW: Why don't we call that up, Chris?

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1 THE WITNESS: Yes.  
 2 BY MR. BOBROW:  
 3 Q. All right. And if you take a look down there maybe ten  
 4 items down, you see 4,674,499, Pao?  
 5 A. Yes.  
 6 Q. And that's DTX-21?  
 7 A. Yes, it is.  
 8 Q. And this same patent also was before the Patent  
 9 Office in connection with the re-examination -- is that  
 10 right -- of the '536 patent?  
 11 A. I believe so, yes.  
 12 Q. And with respect to the '536 patent, of course, the  
 13 Patent Office granted ArthroCare's '536 patent over the  
 14 Pao '499 patent; right?  
 15 A. Yes. And that's probably one of the reasons why  
 16 we're here today.  
 17 Q. Now, as far as the Pao patent, I believe that you  
 18 had shown earlier a couple of figures from the Pao patent.  
 19 Why don't we pull up in the patent the figure that I think  
 20 you had up, which I think was Figure 9.  
 21 MR. BOBROW: Can you call that up, please,  
 22 Chris?  
 23 And why don't you highlight Figure 9 on that  
 24 page?  
 25

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1 BY MR. BOBROW:  
 2 Q. All right. And is that the figure, sir, obviously  
 3 with colors added that you were using during your direct  
 4 examination?  
 5 A. It was one of the figures, yes.  
 6 Q. And actually, the Pao '499 patent describes a number  
 7 of different device configurations, doesn't it?  
 8 A. It does.  
 9 Q. And it looks like there are 12, 13, 14, some odd  
 10 number of figures. There is a fair number. But would you  
 11 agree with me, sir, that the instruments that are described  
 12 here in the Pao patent all have what is called a coaxial  
 13 configuration?  
 14 A. In terms of the electrode configuration?  
 15 Q. Yes.  
 16 A. Yes.  
 17 Q. By coaxial, we know they're saying out certain tube  
 18 and within that tube is another one of the electrodes;  
 19 correct?  
 20 A. That's correct.  
 21 Q. So the outer electrode serves -- I'm sorry -- the  
 22 outer tube served as an electrode and the inner one does  
 23 as well?  
 24 A. Yes.  
 25 Q. And we call that coaxial in the electrosurgical area;

1 correct?  
 2 A. Yes.  
 3 Q. If you would, please, let's take a look at Column 9  
 4 of the '499 patent and specifically there is a paragraph  
 5 that begins about Line 48 and runs down to about 63.  
 6 MR. BOBROW: Chris, if you could highlight that,  
 7 please...  
 8 BY MR. BOBROW:  
 9 Q. All right. And we have the text up. I'm sorry, sir.  
 10 Do you have that page?  
 11 A. I'm sorry. You said Column 8 or 9?  
 12 Q. 9, I believe, is where we are. And we're at --  
 13 A. Oh, yes. Okay. I'm sorry.  
 14 Q. No problem. So that paragraph begins, quote, The  
 15 coaxial bipolar probes of the present invention are used  
 16 generally as follows.  
 17 Do you see what I'm referring to there?  
 18 A. Yes.  
 19 Q. And so what is being described here is the use of  
 20 the various probes, and there are a number of them, but  
 21 the various probes are coaxial in this patent; right?  
 22 A. Yes.  
 23 Q. And as you move down in this paragraph, about Line  
 24 58, there is a sentence that says, quote, The end of the  
 25 probe region is placed against the tissue causing the

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1 first ends of the axial and outer electrodes respectively  
 2 to come into contact with the tissue. Electrical current  
 3 then flows through the tissue between the axial and outer  
 4 electrodes.  
 5 Do you see that, sir?  
 6 A. Yes.  
 7 Q. Now, here in this passage, when it is talking about  
 8 the, first of all, the axial electrode, that's talking  
 9 about the active electrode; is that right?  
 10 A. Yes.  
 11 Q. And we're referring here to the outer electrodes.  
 12 In your view, that would be the reference to the return  
 13 electrode here. The outer one of the electrodes in this  
 14 coaxial configuration; is that right?  
 15 A. That's my view, yes.  
 16 Q. And here in this text, where it's describing the  
 17 operation of the coaxial probes, it says that, in effect, '  
 18 then the axial and the outer electrodes come into contact  
 19 with the tissue; right?  
 20 A. Yes.  
 21 Q. And so, if you're interpreting the outer electrodes  
 22 as being a return, that means there the return electrode  
 23 as described in this paragraph is in contact with the  
 24 tissue; right?  
 25 A. Yes. And this is one description how it could be

1 used, but there are other descriptions where the outer  
 2 electrode and return electrode does not contact tissue.  
 3 Q. We can come to that; but here, this is actually  
 4 describing how these are devices are used. That's up at  
 5 Line 48. It says are used generally as follows; right?  
 6 A. But it doesn't say exclusively used, but it does say  
 7 used generally as follows.  
 8 Q. And the way it's generally used is with both  
 9 electrodes contacting the tissue?  
 10 A. I'm not sure I would go there, but that's -- that is  
 11 one way of it being used.  
 12 Q. All right. And then it says the electrical current  
 13 then flows through the tissue between the axial and the  
 14 outer electrodes; right?  
 15 A. Yes.  
 16 Q. And it says it then flows immediately after saying  
 17 that both the active and the return are in contact with  
 18 the tissue; correct?  
 19 A. In this description of its use, yes.  
 20 Q. So in this description of its use, what it's  
 21 essentially saying is that you put the active and the  
 22 return in contact with tissue and then the current then  
 23 will flow between those two electrodes through the tissue;  
 24 right?  
 25 A. And this is one way, yes. The answer to your

1 A. Yes.  
 2 Q. And now if we go over to Column 8, at about Line 53,  
 3 there is a discussion there about Figure 12.  
 4 A. What column? What line?  
 5 Q. Column 8, Line 53 going down to about 60.  
 6 And perhaps -- do you have that language, sir?  
 7 A. The preferred probe? That one? Yes.  
 8 Q. Right. And here in the description of Figure 12,  
 9 it talks about inserting the probe through a small limbal  
 10 incision in the cornea and that it's placed in firm  
 11 contact with the nucleus 300, as shown in Figure 12.  
 12 Do you see that?  
 13 A. Yes.  
 14 Can I look at the figure for a second?  
 15 Q. Yes?  
 16 MR. BOBROW: why don't we put Figure 12 up,  
 17 please?  
 18 BY MR. BOBROW:  
 19 Q. Now, Figure 12 is a diagram of the human eye; right?  
 20 A. Well, yes. Part of it, yes.  
 21 Q. Sure. And over here, from, going from right to  
 22 left, that's the probe; right?  
 23 A. Right.  
 24 Q. And here, this circle labeled 300, what is that?  
 25 A. That's the nucleus of the eye -- nucleus of the lens,

1 question is yes, and this is one way you use the device.  
 2 It's not the only way.  
 3 Q. All right. Now let's take a look, if we might, at  
 4 Column 3 of the same patent.  
 5 And if you look at Column 3 at about Line 11,  
 6 going to about Line 15...  
 7 Do you see what I'm referring to?  
 8 A. Does that start with, The probe region?  
 9 Q. Yes, The probe region.  
 10 Do you see that?  
 11 A. Yes.  
 12 Q. And the probe region in these devices is talking  
 13 about the end of the devices, right, where the active  
 14 and return electrodes are?  
 15 A. I think in this particular patent, they're actually  
 16 referring to the entire probe. So the entire metallic  
 17 part of the shaft going from the distal end up to where  
 18 the handle spot is.  
 19 I think that's what they mean, but I could be  
 20 wrong.  
 21 Q. But around Lines 11 to 15, there is, once again, a  
 22 reference to tissue contact being made.  
 23 Do you see what I'm referring to there?  
 24 A. Lines 11 to --  
 25 Q. About Line 15.

1 I should say.  
 2 Q. Okay. And this device is shown to be inserted  
 3 within the volume of the eye. Is that true?  
 4 A. Yes.  
 5 Q. What is the nucleus made of?  
 6 A. I can't tell you the exact tissue description, but  
 7 it's tissue, probably collagen and some other stuff.  
 8 Q. So the nucleus of the eye is a form of tissue;  
 9 correct?  
 10 A. Yes.  
 11 Q. And tip of this probe here, the reason it's shown in  
 12 a dashed phantom way like that is because it's being  
 13 inserted into a solid object; right?  
 14 A. Yes.  
 15 Q. And that solid object in this case is tissue?  
 16 A. Yes.  
 17 Q. Now, let me turn, if I might, to another reference  
 18 that you had talked about a bit earlier today, which is the  
 19 Slager reference, which is DTX-65.  
 20 A. I have it.  
 21 Q. Do you have that, sir?  
 22 A. Yes.  
 23 Q. And I believe that earlier today you had testified  
 24 that various claims of the '882 patent and the '592  
 25 patent were anticipated by the Slager reference; is that

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1 correct?  
 2 A. Yes, I did.  
 3 Q. Okay. And you didn't say that Slager was relevant  
 4 to the '536, but that it was relevant to '882 and to '592?  
 5 A. That's correct, yes.  
 6 Q. Now, in the Slager article, there are two tests that  
 7 are being described here; right? One being done in vitro  
 8 and one being done essentially in vivo in a pig; is that  
 9 right?  
 10 A. Yes.

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1  
 2 Q. And the portions of this article that you were saying  
 3 were relevant to the '882 and the '592 patent related to  
 4 the in-vitro test; correct? Not to the test on the pig?  
 5 A. You said the in-vitro test?  
 6 Q. I did.  
 7 A. Yes.  
 8 Q. Okay. The in vitro means what in this article?  
 9 A. In vitro means it's outside the body, generally in a  
 10 dish preparation of some sort. I guess it's the opposite  
 11 of in vivo, which is inside the body.  
 12 Q. So the tests that were being done here, when they  
 13 described the tests as being in vitro; those are outside  
 14 a patient's body; correct?  
 15 A. Outside anybody's body, any animal's body.  
 16 Q. Or human being?  
 17 A. Well, I hope animals.  
 18 Q. Fair enough. For the context that brings us here,  
 19 what is being described here as in vitro is something that  
 20 is not done in a living human patient; correct?  
 21 A. That's correct.  
 22 Q. Instead it is typically done in some sort of dish,  
 23 bowl, in a laboratory; right?  
 24 A. In some preparation or another, yes, a dish.  
 25 Q. What is being described here in the Slager article

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1 is that some pieces of aortic tissue from an aorta, from  
 2 a cadaver were taken and were put into some sort of a  
 3 dish; correct?  
 4 A. Yes.  
 5 Q. Then I think that you mentioned earlier that there  
 6 was some saline that was administered and then put into  
 7 that same dish; correct?  
 8 A. Yes.  
 9 Q. Now, there is no indication, is there, as to how  
 10 the saline got into the dish; right?  
 11 A. Well, it has to be poured in. It doesn't just  
 12 magically appear. It is not specifically said in the  
 13 article that somebody poured in or delivered to the dish  
 14 the saline.  
 15 Q. And certainly, there is nothing in here that says  
 16 that the fluid was supplied to the dish through the  
 17 electrode that was put in contact with the tissue; right?  
 18 A. That's correct.  
 19 Q. And in terms of describing the setup for this Slager  
 20 reference, where you have a dish, you have some tissue in  
 21 the dish, you have some fluid that somehow got there, and  
 22 then you have an electrode that gets put onto the tissue,  
 23 then you apply energy, supply it from a generator, you  
 24 would agree with me, wouldn't you, that that is describing  
 25 an electrosurgical system?

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1 A. I am sorry. Can you repeat the question?  
 2 Q. Sure. What I am asking, sir, is in this experiment,  
 3 where you have a dish, you have some tissue in the dish,  
 4 you have saline that has been put into the dish, you bring  
 5 an electrode in contact with the tissue, and you apply  
 6 energy in a generator, that is describing an  
 7 electrosurgical system. True?  
 8 A. Yes.  
 9 Q. And it's describing an electrosurgical system even  
 10 though we don't have any idea how the fluid got into the  
 11 dish; correct?  
 12 A. That's right.  
 13 Q. And it's an electrosurgical system even though the  
 14 fluid didn't come in through the electrode that is  
 15 described here in Slager; correct?  
 16 A. Yes.  
 17 Q. Now, in this Slager patent -- I am sorry, it is not  
 18 a patent, it is a paper. In the Slager paper, there is  
 19 another experiment that is described as we had mentioned  
 20 that is in a -- that was done in a pig; correct?  
 21 A. Yes.  
 22 Q. And they call that the in vivo test; right?  
 23 A. Yes.  
 24 Q. And in that particular test, the article says that  
 25 there was a subcutaneous needle, ten centimeters long,

1 Q. Yes.  
 2 A. Most likely you would, yes.  
 3 Q. Now, you also had mentioned that the Slager article  
 4 talks about suction. I think this was in reference to  
 5 Claim 54 of the '882 patent that has in it this  
 6 requirement that there be evacuation of fluid; correct?  
 7 A. Yes.  
 8 Q. And if you take a look at the last page of the  
 9 article, the second paragraph down, over on the left-hand  
 10 side, it says one of the areas deserving further attention.  
 11 Do you see that?  
 12 A. Yes, I do.  
 13 Q. And in this part of the article, it is talking about  
 14 bubbles being generated when this device is used; right?  
 15 A. Yes.  
 16 Q. And so it says that one could look into using a,  
 17 quote, suction technique, do you see that, to solve the  
 18 problem of the bubbles; right?  
 19 A. Yes.  
 20 Q. And in terms of this suction technique, the suction  
 21 technique that is described here, it doesn't say where  
 22 the suction lumen would be that is performing the suction;  
 23 right?  
 24 A. It does not.  
 25 Q. It doesn't even say what it is that is going to be

1 used to suck away the bubbles, does it?  
 2 A. No.  
 3 Q. So we don't know from this description whether the  
 4 suction would be taking place through a lumen that is  
 5 adjacent to an electrode, do we?  
 6 A. No, we don't.  
 7 Q. Now, I had some questions for you, also, about the  
 8 Manwaring patent. Actually, let's stay on Slager for  
 9 just a minute, because I think I forgot to ask you a  
 10 question. To do that, I think I am going to need to put  
 11 up one of the claims from the '592 patent. Here at the  
 12 very top, we have Claim 23, and this says a method for  
 13 applying electrical energy to a target site on the body  
 14 structure that is on or within a patient's body.  
 15 Do you see that?  
 16 A. Yes.  
 17 Q. And it looks like that box over there was checked  
 18 in black, do you see what I am referring to?  
 19 A. Yes.  
 20 Q. Now, would you agree with me that in the Slager  
 21 article, in the in vitro test we were talking about, the  
 22 energy was being applied to aortic tissue that had been  
 23 taken from a cadaver a couple of days before; is that  
 24 right?  
 25 A. I am not sure about the time. It was taken from a

1 cadaver.  
 2 Q. And the energy wasn't being applied to a patient,  
 3 was it?  
 4 A. Well, from the perspective of a patient being  
 5 referred to as someone that is alive, that's correct.  
 6 Q. And so in terms of the tissue, there was a cadaver,  
 7 the tissue was taken from the cadaver, placed into a dish;  
 8 right? And then energy was applied to it there. It wasn't  
 9 on an animal or a human being or what-have-you at the time;  
 10 right?  
 11 A. Right, yes. The tissue was not living tissue. It  
 12 was human tissue, but it wasn't living tissue.  
 13 Q. It wasn't living tissue and it wasn't on the patient's  
 14 body when the energy was applied; correct?  
 15 A. That's true. The reason I am hesitating is, the  
 16 aorta is part of your body.  
 17 Q. I am not saying it's not tissue. My question is,  
 18 when the energy was applied, it wasn't on a patient's body.  
 19 Is that true?  
 20 A. That's true.  
 21 Q. Now let's take a look at the '882 patent. You had  
 22 mentioned that the Slager article is also relevant to  
 23 Claim 1 of the '882 patent; right?  
 24 A. Yes.  
 25 Q. And again here, we have the Slager article has a

1 checkmark by it next to this language from Claim 1;  
 2 correct?  
 3 A. Yes.  
 4 Q. And the language there is a method for applying  
 5 energy to a target site on a patient body structure  
 6 comprising.  
 7 Do you see that?  
 8 A. Yes.  
 9 Q. And once again, the tissue to which the energy was  
 10 applied in the Slager article was no longer part of a  
 11 living human being; correct?  
 12 A. Correct.  
 13 Q. The tissue at that point in time was dead; right?  
 14 A. Correct.  
 15 Q. And so there wasn't any application of energy to a  
 16 patient, was there?  
 17 A. No.  
 18 Q. Did you hear Mr. Marsden's opening statement?  
 19 A. Yes. But that's been some time ago.  
 20 Q. But do you recall that Mr. Marsden was suggesting  
 21 that Smith & Nephew didn't infringe the method claims  
 22 itself because it was in the business of making and  
 23 selling these devices, not using them; correct?  
 24 A. That's correct.  
 25 Q. And not using them on patients; right?

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1 A. That's correct.  
 2 Q. And so he was saying that they didn't, Smith &  
 3 Nephew didn't infringe these method claims because they  
 4 didn't perform the surgeries themselves on patients'  
 5 bodies; right?  
 6 A. That's correct.  
 7 Q. Would you agree with him that if you are not using  
 8 the device on a patient's body, that you are not  
 9 infringing Claim 1 of the '882 patent or the method claims  
 10 of the '592 patent?  
 11 A. Yes.  
 12 Q. Now, since we have the '882 up, let me ask you some  
 13 questions about the Manwaring reference. This is the  
 14 '138 patent. And I apologize, sir, I believe that's  
 15 DTX-46.  
 16 A. I have it.  
 17 Q. Now, as far as the Manwaring patent goes, once  
 18 again, in connection with your work as an expert in this  
 19 matter, when you prepared your expert report, you didn't  
 20 perform tests using the Manwaring device to see whether  
 21 or not it emitted photons in the ultraviolet light;  
 22 correct?  
 23 A. That's correct.  
 24 Q. Now, when you were analyzing the Saphyre bipolar  
 25 ablation probes, I take it that you also didn't do a test

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1 back at that time to determine whether or not those  
 2 emitted UV light, either, did you?  
 3 A. When you say analyzing, are we talking about the  
 4 experiments I did?  
 5 Q. Your use of the device prior to the time you  
 6 submitted your expert report, you didn't look at whether  
 7 those devices did or didn't emit ultraviolet photon either.  
 8 Is that true?  
 9 A. That's correct, yes.  
 10 Q. Now, taking a look here at the Manwaring '138 patent,  
 11 why don't we pull up Figure 5?  
 12 ---  
 13  
 14  
 15  
 16  
 17  
 18  
 19  
 20  
 21  
 22  
 23  
 24  
 25

1  
 2 Q. (Continuing) And Figure 5 is a closeup of the tip of  
 3 the Manwaring device; correct?  
 4 A. Yes.  
 5 Q. And there is a little region there that, here, where  
 6 the tip, it says it's in a fluid-filled medium; is that  
 7 right?  
 8 A. Yes.  
 9 Q. And then here, Item 36, we have the tip of an  
 10 electrode; correct?  
 11 A. Yes.  
 12 Q. And then over here, it says tissue over to the right-  
 13 hand side; correct?  
 14 A. Yes.  
 15 Q. Now, in column 7 of this patent, there is a  
 16 discussion about using an embodiment of this device where  
 17 fluid is not delivered through the device to the tissue;  
 18 correct?  
 19 That's at Column 7 around Line 19?  
 20 A. Oh. Column 7 says -- okay. Column 7, Line 19.  
 21 Q. Right. That says if the source of pressurized fluid  
 22 as illustrated in Figure 2 were omitted; correct?  
 23 A. Yes.  
 24 Q. Now we're talking about fluid not being delivered  
 25 to the region of the body that is being treated here;

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1 right? We're not affirmatively delivering the fluid?  
 2 A. That's right.  
 3 Q. And so it says for this device to work, you need to  
 4 essentially suck some of the fluid, it might be the  
 5 cerebral spinal fluid, that's in the working field into  
 6 the tip of the device; correct?  
 7 A. Yes.  
 8 Q. And when you suck that fluid into the tip of the  
 9 device, that fluid is going to be in the vicinity of the  
 10 tip of the electrode.  
 11 MR. BOBROW: If we can put up Figure 5 again...  
 12 BY MR. BOBROW:  
 13 Q. Right. So here we have Figure 5, and if some fluid  
 14 is drawn in, the fluid is going to be in this region here,  
 15 right next to this No. 36 of the probe; right?  
 16 A. Yes.  
 17 Q. And the fluid that is going to be brought into the  
 18 tip of that tube is going to be in the vicinity of the  
 19 tissue, if that you are trying to treat this tissue here  
 20 that is shown here in Figure 5; right?  
 21 A. Yes. But presumably it could also be from areas  
 22 that are outside of that specific location.  
 23 Q. Right. But you are not going to take the fluid  
 24 from this region at the tip and suck all of the fluid way  
 25 over here, way up into the device and leave no fluid down



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1 at the tip, are you? You're going to suck fluid in, so  
 2 that electrode tip has some fluid in contact with it;  
 3 right?  
 4 A. Oh, yes.  
 5 Q. And that fluid that you suck in, there is going to  
 6 be some fluid right there at the tip of the device and  
 7 right there on the tissue and you are going to apply  
 8 energy to that; right?  
 9 A. Let me see if I understand what you are saying.  
 10 Are you saying there will be fluid inside this space here?  
 11 Q. Yes.  
 12 A. Is that what you are saying?  
 13 Q. At the very tip of the device, when you suck some  
 14 of the fluid in, you will have fluid at the very tip of the  
 15 device?  
 16 A. Yes.  
 17 Q. And then you will apply some energy to that; right?  
 18 A. Yes, when you operate the device. Yes.  
 19 Q. Right. And then when you apply the energy, you get  
 20 sparking; right?  
 21 A. Yes.  
 22 Q. And then what this patent tells you is that you get  
 23 the sparking and that sparking then leads to the  
 24 vaporization of the fluid; correct?  
 25 A. In this particular -- yes. Yes.

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1 Q. All right. Now, you had mentioned before that you  
 2 had some question, and I think it was your opinion that  
 3 if this claim, the '882 patent, if it's valid, then you  
 4 had, it was your opinion that it wasn't enabled; right?  
 5 I think you offered that opinion this morning on your  
 6 direct examination? Or did I get that wrong?  
 7 A. Without getting into the legal terms here, if that  
 8 patent is valid, it applies to a lot of other devices  
 9 that are process devices.  
 10 Q. Okay. Now, in connection with your work on this  
 11 matter, how many hours have you spent on this matter up  
 12 through today?  
 13 A. Up through today?  
 14 Q. Sure.  
 15 A. It's between three and four hundred.  
 16 Q. And all of those three and four hundred hours were  
 17 compensated at \$150 an hour?  
 18 A. That's correct.  
 19 Q. And you've been paid by Smith & Nephew for your work;  
 20 is that correct?  
 21 A. That's correct.  
 22 Q. Now, in connection with your three and four hundred  
 23 hours of work you spent on this matter, did you attempt to  
 24 build a device that would embody Claim 1 of the '882  
 25 patent? Did you try to build it?

1 A. Since the Codman ME 2 device essentially practices  
 2 Dr. Manwaring's patent, I didn't have to. I could buy one.  
 3 Q. But you didn't buy one?  
 4 A. No.  
 5 Q. So I'm asking you, sir, whether you built one?  
 6 A. Oh. No.  
 7 Q. Okay. You didn't try to build a device that -- using  
 8 the specification and the like, try to build a device that  
 9 would be consistent with the teachings of the patent?  
 10 That's all I'm asking.  
 11 A. Yes, but let me be clear. We're talking about  
 12 building a device that would practice the corrected Claim  
 13 1?  
 14 Q. Good question. The answer is yes. Did you attempt  
 15 to build the device that would practice the corrected  
 16 Claim 1 at the time you were doing your work, on your  
 17 expert report? Did you build such a device?  
 18 A. No. Because I already developed devices that meet  
 19 that.  
 20 Q. But you didn't try to build one yourself?  
 21 A. I got one sitting on my shelf on my bookcase at  
 22 home.  
 23 Q. You didn't build one, sir? Could you answer the  
 24 question?  
 25 THE COURT: Please just answer the question.

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1 THE WITNESS: No, I did not.  
 2 I thought I already answered the question.  
 3 BY MR. BOBROW:  
 4 Q. So now, as far as the teachings of the '882 patent  
 5 go, would you agree with me there is a discussion in the  
 6 '882 patent of some of the preferred ways of trying to  
 7 practice Claim 1 of the '882 patent?  
 8 A. Yes.  
 9 Q. Would you agree with me there are preferred voltage  
 10 ranges that are set forth?  
 11 A. Do you mind if I go back to the patent?  
 12 Q. Please.  
 13 A. Yes.  
 14 Q. And in addition to preferred voltage ranges, there  
 15 are preferred materials with instruction for the electrode;  
 16 correct? The active electrode?  
 17 A. Yes.  
 18 Q. If you take a look, sir, at the bottom of Column 16?  
 19 A. I found it, yes.  
 20 Q. And it says, it refers to metals like titanium and  
 21 platinum.  
 22 Do you see that?  
 23 A. Yes.  
 24 Q. And this also gives preferred frequencies; correct?  
 25 A. Yes, it does.

1 Q. And that's at Column 13; right?  
 2 A. Yes.  
 3 Q. And the voltage range, the preferred ones are also  
 4 set forth in Column 13, aren't they?  
 5 A. Yes.  
 6 Q. There is also a preferred fluid that is supplied  
 7 and that's in Column 12, right, at around Line 38.  
 8 A. Yes.  
 9 Q. And it also provides preferred power levels; right?  
 10 A. Can you direct me there so I don't --  
 11 Q. I can. I'm sorry. This is at the top of Column 14.  
 12 There is a range preferred power levels.  
 13 A. Yes.  
 14 Q. And also there are preferred contact surface area  
 15 values for the active electrode in Column 15; right?  
 16 A. Yes.  
 17 Q. And there are preferred distances from the tissue  
 18 that are set forth at the bottom of Column 15; right?  
 19 A. Yes.  
 20 Q. Now, in connection with your work in this field of  
 21 electrosurgery, I think you testified that you had a  
 22 couple of patents that had issued to you. I think you  
 23 said five?  
 24 A. Five total, two in electrosurgery.  
 25 Q. And in connection with the patents that you have

1 infringes the patents; correct?  
 2 A. Yes, the accused products. Yes.  
 3 Q. Fair enough. And in terms of the use of that, you  
 4 were being assisted in your use by a laboratory manager;  
 5 correct?  
 6 A. Yes.  
 7 Q. There was somebody from there from Smith & Nephew  
 8 who was assisting you with the setup of the experiment  
 9 and the operation of the devices; correct?  
 10 A. That's correct.  
 11 Q. And you had a chance to use, at a very minimum, the  
 12 Saphyre; correct?  
 13 A. I used all three products, but I did use the Saphyre.  
 14 Q. And when did you these tests, there were recordings  
 15 made of what was going on inside of this cadaver shoulder  
 16 where the experiments were taking place; right?  
 17 A. That's correct.  
 18 Q. And that was done through some sort of a scope;  
 19 correct?  
 20 A. Well --  
 21 Q. There was a little video camera?  
 22 A. Yes. There was a little video camera that was  
 23 attached to the scope and that did the recording.  
 24 Q. When you did the recordings, those were actually  
 25 permanently recorded onto a CD; correct?

1 been involved in writing, I take it it's true that when  
 2 you were writing those patents, you would say what you  
 3 believe to be a preferred way of practicing the inventions  
 4 that you had come up with, right?  
 5 A. That's correct.  
 6 Q. And did you that so that could give some guidance  
 7 to people who were reading the patent once the patent  
 8 expired how to duplicate the device; right?  
 9 A. Right.  
 10 Q. And it's your expectation, isn't it, that a person  
 11 of skill in the art in looking at a patent would look at  
 12 what the patent itself, the preferred ranges, the preferred  
 13 materials, the preferred voltages and the rest to try to  
 14 figure out how to practice the invention; correct?  
 15 A. I would expect they would use that as their starting  
 16 point, yes.  
 17 Q. Now, sir, I heard your testimony earlier and you  
 18 had mentioned that you had actually used some of the  
 19 accused products at the Smith & Nephew, I think it's called  
 20 a bioskills lab; is that right?  
 21 A. Yes.  
 22 Q. And where is that? That's in Massachusetts?  
 23 A. Yes, Massachusetts. Mansfield.  
 24 Q. And you went out to that facility and had a chance  
 25 to use the accused -- the products, the use of which use

1 A. Yes.  
 2 Q. And you ended up saving that data and producing it  
 3 in connection with this case; correct?  
 4 A. Yes.  
 5 Q. And in forming your opinion about how the devices  
 6 work, you actually considered that information in  
 7 determining whether or not there was or wasn't  
 8 infringement by the accused products; right?  
 9 A. Yes.  
 10 MR. BOBROW: May I approach, your Honor?  
 11 THE COURT: Yes, you may.  
 12 BY MR. BOBROW:  
 13 Q. I'm simply showing you, and I know you can't look  
 14 inside of a CD, so I apologize in advance, but there was  
 15 a CD that was produced to us with this production number  
 16 SN10765. It's since been labeled PX-104 and it was  
 17 represented to us that this was a set of recordings of  
 18 some of the work that you did on the cadaver. I'll simply  
 19 have to make that representation to you because I obviously  
 20 can't show it to you unless we put it up on the screen.  
 21 MR. BOBROW: I would move this CD into evidence.  
 22 MR. MARSDEN: Your Honor, we'll object to its  
 23 being moved into evidence. If he intends to use it for  
 24 impeachment, that is one matter, but it's not appropriate  
 25 to move into evidence with our expert witness.

1 THE COURT: well, I'm not sure about that, but  
2 the problem is we don't generally -- this is, the exhibit  
3 is a test that the witness performed?

4 MR. BOBROW: That's correct.

5 THE COURT: I guess my problem is if this  
6 witness isn't the kind of witness who typically uses these  
7 products, I'm not sure what the relevance is or if the  
8 relevance is not waived by prejudice -- without knowing  
9 what this is, I'm not sure what why it should come in.

10 Maybe we should have a sidebar.

11 ---  
12 (Sidebar conference, out of the hearing of the  
13 jury, as follows.)

14 MR. BOBROW: This is a videotape that this  
15 witness took so that he could understand how the devices  
16 operate. And it records that. He was being assisted by  
17 somebody from Smith & Nephew at the time and so, given  
18 that, what I would like to be able to show just one clip  
19 that he used to show how he used the device and how he  
20 operated it and how the device functioned inside of the  
21 tissue.

22 Now, Dr. Choti was allowed on his direct  
23 examination to show tapes of the ones that he actually  
24 prepared. He is not an arthroscopic surgeon either, but  
25 what it does, it gives the jury a good sense of what the

1 shoulder space is like and how the devices fit inside the  
2 shoulder.

3 THE COURT: well, is this for -- I can't  
4 remember whether those were introduced. What is the  
5 relevance? Illuminate me here.

6 MR. BOBROW: What I want to try to show, the  
7 devices can be used and are designed in a way such that  
8 the return electrode doesn't need to be contacting the  
9 tissue while it's inside the patient's body. So here I  
10 want to show one clip where there are times when it's  
11 not in contact and essentially he was able to observe  
12 there are times when it was not in contact.

13 THE COURT: Tell me something. All the clips  
14 we've seen for purposes of infringement, were those actual  
15 surgeries or were those just people playing with them?

16 MR. BOBROW: well, we have seen two types. We  
17 saw Dr. Choti, and that was inside of a cadaver. And then  
18 we've also seen some that were actually on live patients  
19 where there was blood present. So that was either on an  
20 animal or that was on a human being, but something where  
21 blood was flowing. There is no blood flowing here.

22 THE COURT: Let's hear about Dr. Choti's clips,  
23 because I can't remember which ones those are.

24 MR. MARSDEN: Your Honor, I was trying to get  
25 assistance on that myself. I'm not sure that I was in the

1 courtroom when it was played, but apparently he did play  
2 some tapes of tests.

3 MS. MacFERRIN: He did not play any on direct,  
4 but on cross played the tape of the experiment.

5 MR. BOBROW: There was a Control RF experiment  
6 from Dr. Choti that your Honor allowed to be played on  
7 cross-examination to show how the Control RF device  
8 interfaced with the tissue; its relationship to the  
9 tissue was, and this is an identical situation except  
10 it's this witness and a different product.

11 THE COURT: And whose witness was Dr. Choti?  
12 I can't even remember.

13 MR. BOBROW: Dr. Choti was an expert for Smith &  
14 Nephew.

15 MR. MARSDEN: So apparently on cross there,  
16 they used one of his clips.

17 MR. BOBROW: That's right.

18 MR. MARSDEN: I don't know that that makes it  
19 right to do it again. I don't think it's particularly  
20 helpful, particularly if you have a selected clip. There  
21 is a lot of other clips.

22 MR. BOBROW: I apologize.

23 MR. MARSDEN: The jury has seen it in use or  
24 in sales videos, which is an important consideration for  
25 whether there is infringement. That's how we tell doctors

1 how it should be used. That's how we tell salespeople to  
2 show doctors how it should be used. And that would be the  
3 relevance.

4 MR. BOBROW: If I may make one more comment...

5 Dr. Choti testified that, on his direct  
6 examination, the shoulder, the cadaver was actually very  
7 much akin to a living shoulder. In other words, that it  
8 hasn't been obliterated, that it hasn't been damaged, but  
9 it was very much like a regular human shoulder. So I'd  
10 like to show this to show indeed there are lots of spaces  
11 in the shoulder where there are lots of room and that a  
12 surgeon can manipulate the device in a way and a person  
13 can manipulate the person in a way such that the return  
14 doesn't contact.

15 MR. MARSDEN: Your Honor, if they wanted to  
16 do that, they could have had their expert do the experiment.

17 MR. BOBROW: No. We tried to have our expert  
18 look at these tapes and testify about that, but that was  
19 precluded.

20 MR. JOHNSTON: Your Honor?

21 THE COURT: It's precluded by whom?

22 MR. BOBROW: By your Honor. Yes, you ruled  
23 that since it wasn't in his expert report, he couldn't  
24 talk about that. So I'd like to have the person who  
25 actually generated this tape talk about it.

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1 THE COURT: So you were saying Dr. Choti  
2 couldn't talk about it?  
3 MR. BOBROW: No, Dr. Goldberg. I'm sorry.  
4 There are too many witnesses. Dr. Goldberg couldn't talk  
5 about it. Couldn't talk about Dr. Choti's or Dr. Taylor's.  
6 I'd like to ask Dr. Taylor about Dr. Taylor's video.  
7 MR. JOHNSTON: Tom Johnston.  
8 There is one other difference. They did not  
9 do the test on the same shoulder because they're done  
10 weeks apart, and I believe that Dr. Taylor's shoulder had  
11 been scoped several times. Not as representative as Dr.  
12 Choti's.  
13 THE COURT: Was there any objection to Dr.  
14 Choti's being used? Like there is now?  
15 MR. BOBROW: No, there wasn't. It was  
16 admitted into evidence without objection.  
17 THE COURT: Well, I guess if I didn't rule on  
18 this issue before, my reaction to this issue is that this  
19 is an engineer playing with a dead body and it can't  
20 possibly be used for purposes of infringement. I mean I  
21 just think it's not appropriate. So the objection is  
22 sustained.  
23 MR. MARSDEN: Thank you, your Honor.  
24 MR. BOBROW: Thank you, your Honor.  
25 (End of sidebar conference.)

1  
2 Q. And you have seen this document before, haven't you?  
3 A. I think I have seen parts of it.  
4 Q. Okay. And if you turn to Page 0RA65076, you can see  
5 that this page talks about S&N ablation probes.  
6 Do you see that?  
7 A. Yes.  
8 Q. One of those probes is the Saphyre bipolar ablation  
9 probe; correct?  
10 A. Yes.  
11 Q. And S&N stands for Smith & Nephew; right?  
12 A. Yes.  
13 Q. And if you go a little bit further into the document,  
14 at 0RA65090, there is a document there called Managing  
15 Surgeon Expectations.  
16 Do you see that?  
17 A. Yes.  
18 Q. And this is talking about Saphyre suction probes;  
19 right?  
20 A. Just let me read it for a second.  
21 Yes.  
22 Q. And the Saphyre suction probes are designed so that,  
23 for example, they will clear bubbles that are generated  
24 when the devices are used in these arthroscopic surgeries;  
25 correct?

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1 ---  
2 MR. BOBROW: Ladies and gentlemen, I apologize  
3 for the delay.  
4 Why don't we move on to another exhibit?  
5 May I approach, your Honor?  
6 THE COURT: Yes, you may.  
7 BY MR. BOBROW:  
8 Q. Let me show you PX-324. PX-324 is already in  
9 evidence, sir.  
10 A. Okay.  
11 Q. And PX-324 is called Competitive Selling, ArthroCare  
12 with the name Rob Griffin.  
13 Do you see that?  
14 A. Yes.  
15 ---  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25

1 A. Bubbles and other debris, yes.  
2 Q. But including bubbles; right?  
3 A. Including bubbles, yes.  
4 Q. The second bullet point here says, quote, During  
5 use keep the electrode level with the target tissue for  
6 optimal evacuation of bubbles.  
7 Do you see that?  
8 A. Yes.  
9 Q. And when it says level there, that Saphyre probe  
10 actually has a flat active electrode face; correct?  
11 A. Yes, it does.  
12 Q. And it says -- what I am pointing to here with my  
13 finger to PX-544, this is the active electrode tip; right?  
14 A. Yes, it is.  
15 Q. Way down here?  
16 A. Yes.  
17 Q. And that would then be presented to the tissue such  
18 as this; correct? It says to hold it flat; right?  
19 A. That's what I would infer, yes.  
20 Q. And you have inspected these probes before; correct?  
21 A. Oh, yes.  
22 Q. And when you look at these probes, you can see that  
23 the return electrode is actually recessed somewhat from  
24 the plane of the face of the active electrode; right?  
25 A. Slightly, yes.

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1 Q. So if I were to hold this active electrode on that  
 2 desk, that glass-top desk right there, and I held that  
 3 active electrode flat, parallel to the desk, the return  
 4 electrode wouldn't touch it, would it?  
 5 A. No, it wouldn't.  
 6 Q. Because it's recessed somewhat; correct?  
 7 A. I am presuming you are holding the probe, the shaft,  
 8 parallel.  
 9 Q. That's right.  
 10 A. Okay.  
 11 Q. Now, if you take a look, also, at Page ORA65095,  
 12 again, it's talking about managing surgeon expectations.  
 13 And what is depicted there is the tip of one of these  
 14 Saphyre probes; correct?  
 15 A. Yes.  
 16 Q. And you can see there that the very tip of the probe  
 17 bends down at sort of a right angle so that the -- where  
 18 those little lightning bolts and bubbles are, that is the  
 19 active electrode face; right?  
 20 A. Yes.  
 21 Q. And here, the active electrode face is shown being  
 22 parallel to the tip; right? That is what is being  
 23 depicted there?  
 24 A. Yes.  
 25 Q. And the return electrode, as we are looking at this

1 A. That's correct.  
 2 Q. In describing that it says, quote, Tight seal between  
 3 probe and tissue causes steam bubbles to form under  
 4 electrode which allows an arc to be created and ablation  
 5 to occur.  
 6 Do you see that?  
 7 A. Yes.  
 8 Q. And do you understand that that is, indeed, how the  
 9 Saphyre bipolar ablation probes work when they are in  
 10 operation?  
 11 A. I think the answer to your question is yes. They  
 12 sort of omit the step that you got to apply energy to it  
 13 to get to the arc and so forth. But I think the idea is  
 14 it forms a steam layer and eventually an arc is generated  
 15 and that ablates the tissue.  
 16 Q. Now, all of these devices that have been accused of  
 17 infringement, all of them require an electrically  
 18 conductive fluid to work; right?  
 19 A. Yes.  
 20 Q. And you did some tests, didn't you, when you were  
 21 working on and looking at these various devices; right?  
 22 A. Are you talking about the experiments with the  
 23 cadaver shoulder?  
 24 Q. Those and others; right?  
 25 A. Those are the best tests that I did, yes.

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1 figure, would be off and to the left; correct?  
 2 A. Yes.  
 3 Q. That is where the return electrodes would be?  
 4 A. Yes.  
 5 Q. And you can see here, blown up somewhat, that,  
 6 indeed, the return electrode in that portion of the shaft  
 7 is recessed from the tissue that the active electrode  
 8 faces, touching there; right?  
 9 A. In this cross-section, that's correct, yes.  
 10 Q. And there is an arrow pointing to the very tip of  
 11 the device, and the very tip of the device has those two  
 12 points, do you see them, on the left and the right?  
 13 A. Yes.  
 14 Q. And that's intended to depict that the active  
 15 electrode tip is in contact with the tissue, right, at  
 16 those tips?  
 17 A. Well, if you actually take a look at the Saphyre  
 18 active electrode, it's got four little points that stick  
 19 up. I think that's what that is depicting.  
 20 Q. So those two little sharp points on either side,  
 21 those are in contact there with the tissue; right?  
 22 A. Yes.  
 23 Q. And then near the face of the active electrode, or  
 24 it looks like it's little lightning bolts and some bubbles;  
 25 right?

1 Q. You also did some tests in distilled water, didn't  
 2 you?  
 3 A. Yes.  
 4 Q. And distilled water is not an electrically conductive  
 5 fluid, is it?  
 6 A. No.  
 7 Q. And you tested the Saphyre device, for example, in  
 8 distilled water, didn't you?  
 9 A. Yes.  
 10 Q. And it didn't work, did it?  
 11 A. No, it did not.  
 12 Q. And you tried it in, you tried to use the Control  
 13 RF -  
 14 A. Can I make just one comment?  
 15 Even though I know I said distilled water, it  
 16 could also have been deionized distilled water. That is  
 17 a little different than regular distilled water.  
 18 Nonetheless, it didn't work.  
 19 Q. And both of those, deionized or distilled, they are  
 20 both electrically nonconductive, they would be categorized  
 21 as such in this field; correct?  
 22 A. Yes.  
 23 Q. And when you put the Control RF in this  
 24 nonconductive fluid, it also didn't work, did it?  
 25 A. That's correct.

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1 Q. So these devices, to work, require the presence of  
 2 an electrically conductive fluid; right?  
 3 A. Yes.  
 4 Q. And all of these devices work by creating a current  
 5 flow path between the active and the return through an  
 6 electrically conductive fluid; right?  
 7 A. And the tissue.  
 8 Q. And when these devices are used by doctors, they are  
 9 always used with an electrically conductive fluid; correct?  
 10 A. Yes. The instructions for use specifically say that.  
 11 Q. And in terms of arthroscopic procedures, those are  
 12 the procedures these devices are designed for; right?  
 13 A. Correct.  
 14 Q. When those procedures are done, there is always  
 15 electrically conductive fluid inside the joint space;  
 16 correct?  
 17 A. Yes.  
 18 Q. And these devices are used in that electrically  
 19 conductive fluid; right?  
 20 A. Yes.  
 21 Q. And they need that electrically conductive fluid in  
 22 order to work and treat the tissue inside of those joint  
 23 spaces; right?  
 24 A. Yes.  
 25 Q. And if you didn't have the fluid in there, the

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1 electrically conductive fluid in there, that was  
 2 administered to the knee or the shoulder, the devices  
 3 wouldn't work, would they?  
 4 A. Well, in the case of the RF portion it does,  
 5 because you are talking about whether or not other  
 6 devices --  
 7 Q. Right?  
 8 A. In the case of other devices, when activated, it  
 9 would work, you certainly would have electrically  
 10 conductive fluid in the joint space, since arthroscopy is  
 11 always used with electrically conductive fluid, you would  
 12 need that.  
 13 Q. Even in the case of the ElectroBlade, you heard Ms.  
 14 Drucker testify yesterday that the most popular mode of  
 15 this operation of this ElectroBlade device is the  
 16 simultaneous cutting and coag mode; right?  
 17 A. That's correct.  
 18 Q. By simultaneous cutting and coag, that means that  
 19 the RF is on; correct?  
 20 A. Yes.  
 21 Are we finished with this so I can put it away?  
 22 Q. Yes, Dr. Taylor.  
 23 Dr. Taylor, I believe that I finished my line  
 24 of questions and I appreciate your time. Thank you.  
 25 THE WITNESS: Thank you.

1 THE COURT: Redirect.  
 2 REDIRECT EXAMINATION  
 3 BY MR. MARSDEN:  
 4 Q. Good afternoon, Dr. Taylor.  
 5 A. Good afternoon.  
 6 Q. Just a few questions. First of all, was there  
 7 anything in Mr. Bobrow's questioning of you here on cross  
 8 that has caused you to change or reconsider any of the  
 9 opinions that you offered during your direct testimony?  
 10 A. No.  
 11 Q. Just to follow up on one of the last points that Mr.  
 12 Bobrow made about holding the device level, I guess we  
 13 could take any of these devices and hold them level, I  
 14 think you talked about it in reference, for example, to  
 15 a desktop.  
 16 Do you remember that question?  
 17 A. Yes.  
 18 Q. Is there any part of the inside of a joint that  
 19 looks like the top of a desktop?  
 20 A. Not to my knowledge.  
 21 Q. Does it make sense to talk about keeping something  
 22 parallel in the context of a joint?  
 23 A. No.  
 24 Q. I wanted to return to a couple of other points that  
 25 Mr. Bobrow raised just briefly. First, he talked a little

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1 bit about the Doss patent.  
 2 Do you recall that?  
 3 A. Yes.  
 4 Q. In particular, he was asking you about the two  
 5 electrodes in the Doss patent?  
 6 A. Right.  
 7 Q. Do you remember that?  
 8 A. Yes.  
 9 Q. I think the point of his question was, he was trying  
 10 to suggest to you there may not be a return electrode in  
 11 the Doss patent.  
 12 Did you understand that?  
 13 A. I think that was the line of reasoning, yes.  
 14 Q. Did the Court give us a definition of return  
 15 electrode?  
 16 A. Yes.  
 17 MR. MARSDEN: Can we pull up, please, 675, 4  
 18 Gary? If you could go to Paragraph 9, please... And blow  
 19 up Paragraph 9, please.  
 20 BY MR. MARSDEN:  
 21 Q. Did you use the Court's definition of return electrode  
 22 in determining whether or not the Doss reference had a  
 23 return electrode?  
 24 A. Yes.  
 25 Q. And what is the critical element of the Court's

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1 definition of whether or not something constitutes a return  
 2 electrode?  
 3 A. The critical element is an electrode having a larger  
 4 area of contact than an active electrode, thus affording a  
 5 lower current density.  
 6 Q. And when you reviewed the Doss patent, did you find  
 7 such an electrode?  
 8 A. Yes. The outer electrode is -- just look at the  
 9 geometry --  
 10 MR. MARSDEN: Can we pull up DDTX-458 again,  
 11 Gary?  
 12 BY MR. MARSDEN:  
 13 Q. That is the Doss reference. Does that help answer  
 14 the question?  
 15 A. Yes. In this geometry, the structure that is in  
 16 yellow, cross-hatched yellow is the return electrode. And  
 17 if you look at the sort of bottom-end view here, the  
 18 active electrode is in red. The return electrode is there.  
 19 And just on the basis of plane geometry if you assume both  
 20 electrodes have the same thickness, the outer electrode  
 21 will have more surface area.  
 22 Q. And does that outer electrode meet the Court's  
 23 definition of a return electrode?  
 24 A. I believe it does.  
 25 Q. Turning to another subject, Mr. Bobrow asked you

1 error or correcting that error that changes any of your  
 2 opinions that you have offered here today?  
 3 A. No.  
 4 Q. Moving to another topic, Mr. Bobrow spent some time  
 5 with you in connection with the Slager reference, talking  
 6 about the fact that this was done in a dish with tissue  
 7 that had been taken from an aorta.  
 8 Do you recall that?  
 9 A. Yes.  
 10 Q. Were you here when Mr. Eggers testified -- I guess  
 11 it was at the end of last week -- about how he reduced his  
 12 invention to practice?  
 13 A. Yes, I was.  
 14 Q. How did he do it?  
 15 A. He did it in, I don't know whether he used a chicken,  
 16 but he did it in a Petri dish or dish. I don't think he  
 17 said Petri, but in a dish.  
 18 Q. That was the same invention that you were talking  
 19 about five minutes ago?  
 20 A. Same methodology, basically using tissue in vitro.  
 21 Q. The last topic, Dr. Taylor. You were asked early on  
 22 in your cross-examination a lot of questions about the  
 23 Roos reference and electrically conductive fluid.  
 24 Do you recall that?  
 25 A. Yes.

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1 some questions about a correction you made during your  
 2 deposition.  
 3 Do you recall that?  
 4 A. Yes.  
 5 Q. When you realized you had made a mistake at your  
 6 deposition, what did you think was the right thing to do?  
 7 A. Well, based on the instructions I got -- my  
 8 understanding was I can correct grammatical errors, I  
 9 could correct typos. But I couldn't correct my deposition  
 10 until I got to trial.  
 11 Q. There was another question that dealt with a lunch  
 12 break and realizing over the lunch break that you had  
 13 made an error in some of your earlier testimony.  
 14 Do you recall that?  
 15 A. Yes.  
 16 Q. When you realized that and you went into the  
 17 deposition after the lunch break, what did you think was  
 18 the right thing to do?  
 19 A. Basically, we told Mr. Bobrow about the error.  
 20 Q. Did you answer all of Mr. Bobrow's questions about  
 21 the error?  
 22 A. Yes, I did.  
 23 Q. Did you answer them here again in court today?  
 24 A. Yes.  
 25 Q. Is there anything about that error or changing that

1 Q. You were asked a bunch of questions about another  
 2 patent to Mr. Roos, the '667 patent.  
 3 Do you recall that?  
 4 A. Yes.  
 5 Q. You knew about the Roos '667 patent, didn't you?  
 6 A. Yes, I did.  
 7 Q. You considered it before you rendered your opinions  
 8 here today?  
 9 A. Yes, I did.  
 10 Q. Was there anything in the '667 patent that caused you  
 11 to reconsider whether or not the teachings of the Roos '198  
 12 patent anticipate the '536 patent?  
 13 A. No, there isn't.  
 14 Q. Is there anything that Mr. Bobrow brought out during  
 15 your cross-examination that has caused you to reconsider  
 16 that?  
 17 A. No.  
 18 Q. Has the Court defined the term electrically conductive  
 19 fluid for us?  
 20 A. Yes.  
 21 MR. MARSDEN: Can we pull up DX-675?  
 22 BY MR. MARSDEN:  
 23 Q. This time look at Paragraph 5. The Court has  
 24 defined electrically conductive fluid to mean any fluid  
 25 that facilitates the passage of electrical current;

1 correct?  
 2 A. That's correct.  
 3 Q. And did you use that definition in rendering your  
 4 opinions here today?  
 5 A. Yes.  
 6 Q. Did you find electrically conductive fluid as defined  
 7 by the Court in the Roos '198 patent?  
 8 A. Yes.  
 9 MR. MARSDEN: Can we call up DDTX-444 again,  
 10 please?  
 11 BY MR. MARSDEN:  
 12 Q. I think Mr. Bobrow asked you, in fact, about Claim 1  
 13 of the '198 patent. Where do you find a fluid that  
 14 facilitates electrical current in the '198, Claim 1?  
 15 A. If you look in the language of Claim 1, the last  
 16 couple of lines, with liquid to provide electrical  
 17 conductance between said electrodes.  
 18 Q. Do you believe that is consistent with the Court's  
 19 construction?  
 20 A. I believe it is.  
 21 Q. We also saw this during Mr. Sparks' demonstration of  
 22 the equipment earlier today. You understood that this was  
 23 the electrically conductive fluid that was used in the  
 24 typical procedure?  
 25 A. Yes, I presume that's normal saline or lactated

1 THE COURT: Ladies and gentlemen, we will  
 2 recess for the evening. You will be getting the case  
 3 tomorrow at some point during the day. I will remind  
 4 you that during the evening recess you are not to talk  
 5 among yourselves or with anyone else, nor are you to  
 6 listen to anything touching on the case. Do not perform  
 7 any independent investigation.  
 8 Have a safe trip home, a pleasant evening.  
 9 And we will see you tomorrow morning at 9:30.  
 10 (At this point the jury then left the  
 11 courtroom, and the following occurred without the presence  
 12 of the jury.)  
 13 THE COURT: Leave E-mail addresses with John  
 14 here so that we can E-mail you our verdict form and final  
 15 proposed jury instructions.  
 16 We are going to have to meet tomorrow morning.  
 17 I have an 8:30 hearing, but it shouldn't take more than a  
 18 few minutes. Why don't you get here about 8:45, so we can  
 19 be sure to be ready to go at 9:30.  
 20 Thank you, counsel.  
 21 (Court recessed at 3:00 p.m., to reconvene on  
 22 Friday, May 9, 2003, at 8:45 a.m.)  
 23 ---  
 24  
 25

1 Ringer's.  
 2 MR. MARSDEN: May I approach, your Honor?  
 3 THE COURT: Yes.  
 4 BY MR. MARSDEN:  
 5 Q. Let me hand that up. I would ask you to look at the  
 6 labeling on the top. Can you tell me how it describes  
 7 that fluid?  
 8 A. Well, it says .9 percent sodium chloride irrigation.  
 9 Q. It says irrigation?  
 10 A. Irrigation.  
 11 Q. So it's calling that an irrigation fluid?  
 12 A. That's correct.  
 13 Q. Does it use the term electrically conducting fluid?  
 14 A. I don't see that anywhere on this label.  
 15 Q. Does the fact that it calls it irrigation fluid make  
 16 it not electrically conductive fluid?  
 17 A. No.  
 18 Q. That fluid, is that electrically conductive fluid?  
 19 A. Yes.  
 20 MR. MARSDEN: No further questions.  
 21 THE COURT: All right. You may step down.  
 22 Thank you very much.  
 23 THE WITNESS: Thank you, ma'am.  
 24 (Witness excused)  
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 2 INDEX  
 3  
 4 DEFENDANT'S TESTIMONY  
 5 CONTINUED DIRECT CROSS REDR RECR  
 6  
 7 Kenneth Taylor,  
 8 Resumed ----- 1288 1336 1455 ----  
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